

***United States Court of Appeals
for the
District of Columbia Circuit***



**TRANSCRIPT OF
RECORD**

BRIEF FOR APPELLANT AND JOINT APPENDIX

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 19,171

MONSANTO COMPANY, et al.

Appellants

v.

ERNST KAMP, et al.

Appellees

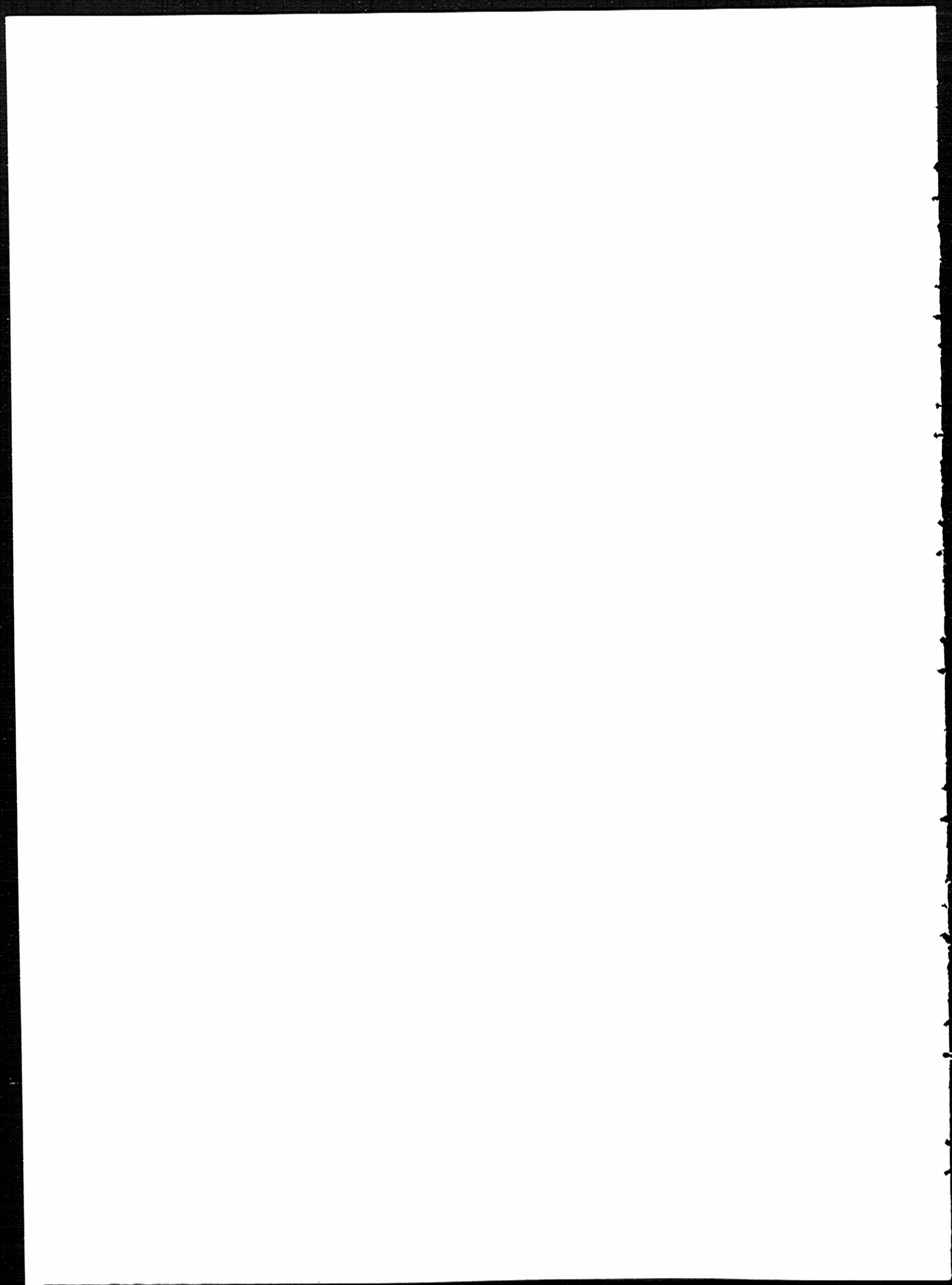
*Appeal From the United States District Court
For the District of Columbia*

United States Court of Appeals
for the District of Columbia Circuit

FILED MAR 11 1965

Of Counsel *Nathan Paulson*
James P. Burns, CLERK
Herbert B. Roberts
Peter H. Smolka

W. L. BENEDICT
BURNS, DOANE, BENEDICT,
SWECKER & MATHIS
850 Munsey Building
Washington 4, D. C.
Attorneys for Appellants

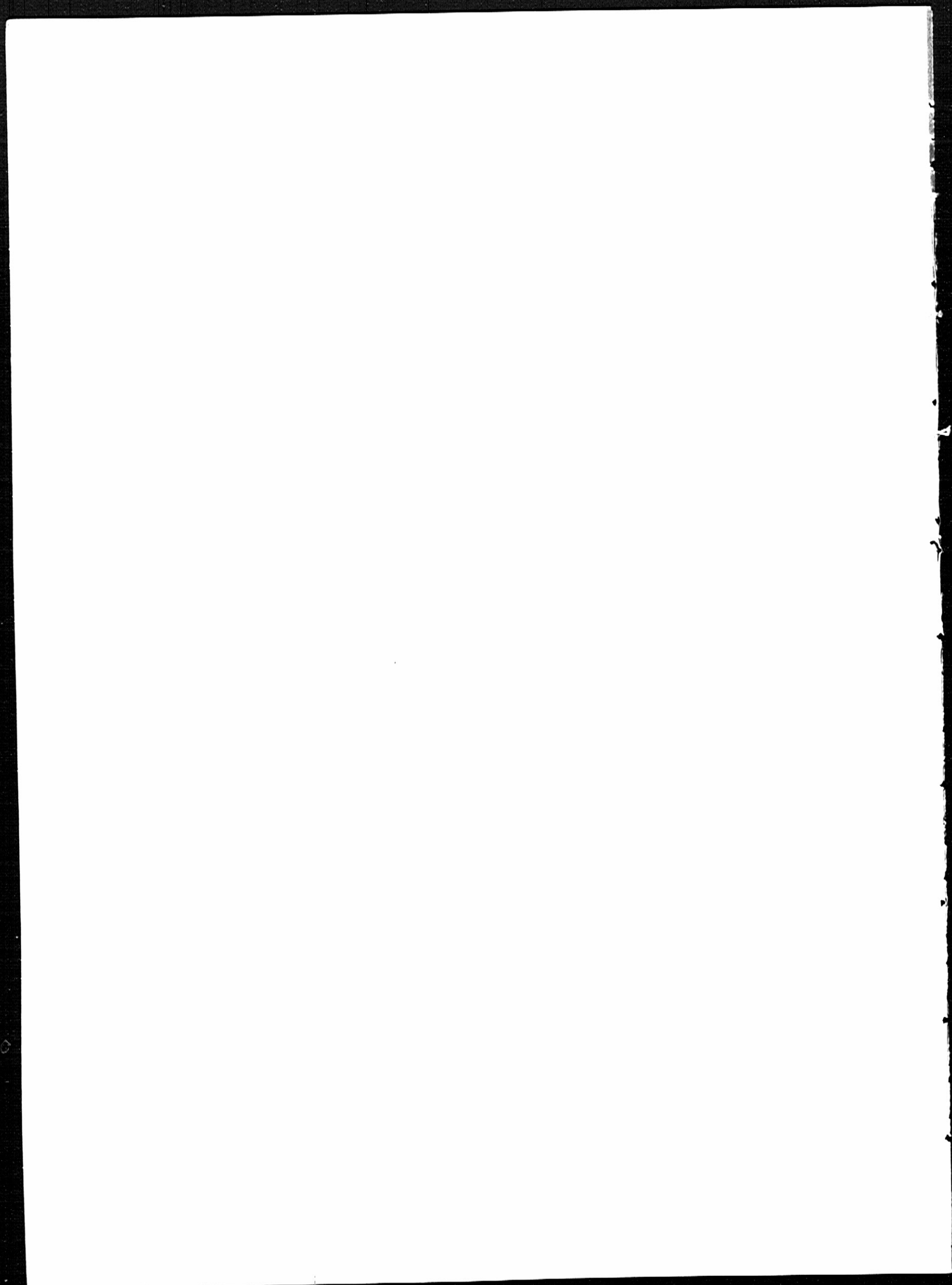


(i)

STATEMENT OF QUESTIONS PRESENTED

The questions presented are:

- (1) Did the Court below commit reversible error, as a matter of law, in denying Plaintiffs-Appellants' motions for preliminary injunction to restrain the Commissioner of Patents, a Defendant below, from issuing a patent to Defendants-Appellees Kamp et al (who were the winning parties in an interference in the Patent Office) containing claims 1 and 7 of Pinsky et al patent 2,830,721, pending a final determination of the interference issues presented by Appellants' action under 35 USC 146.
- (2) Did not the Court below commit reversible error in failing to find that the issuance of such a second patent pending such final determination, is without constitutional or statutory basis, is contrary to the public interest, would cause Appellants irreparable injury, and should therefore be enjoined.
- (3) Did not the Court below commit reversible error in applying the policy of *Monaco v. Watson*, 270 F.2d 335, 106 U.S. App. D.C. 142, a case in which two patent applications were involved, to the circumstances of the present case involving a patent and a patent application.



INDEX TO BRIEF

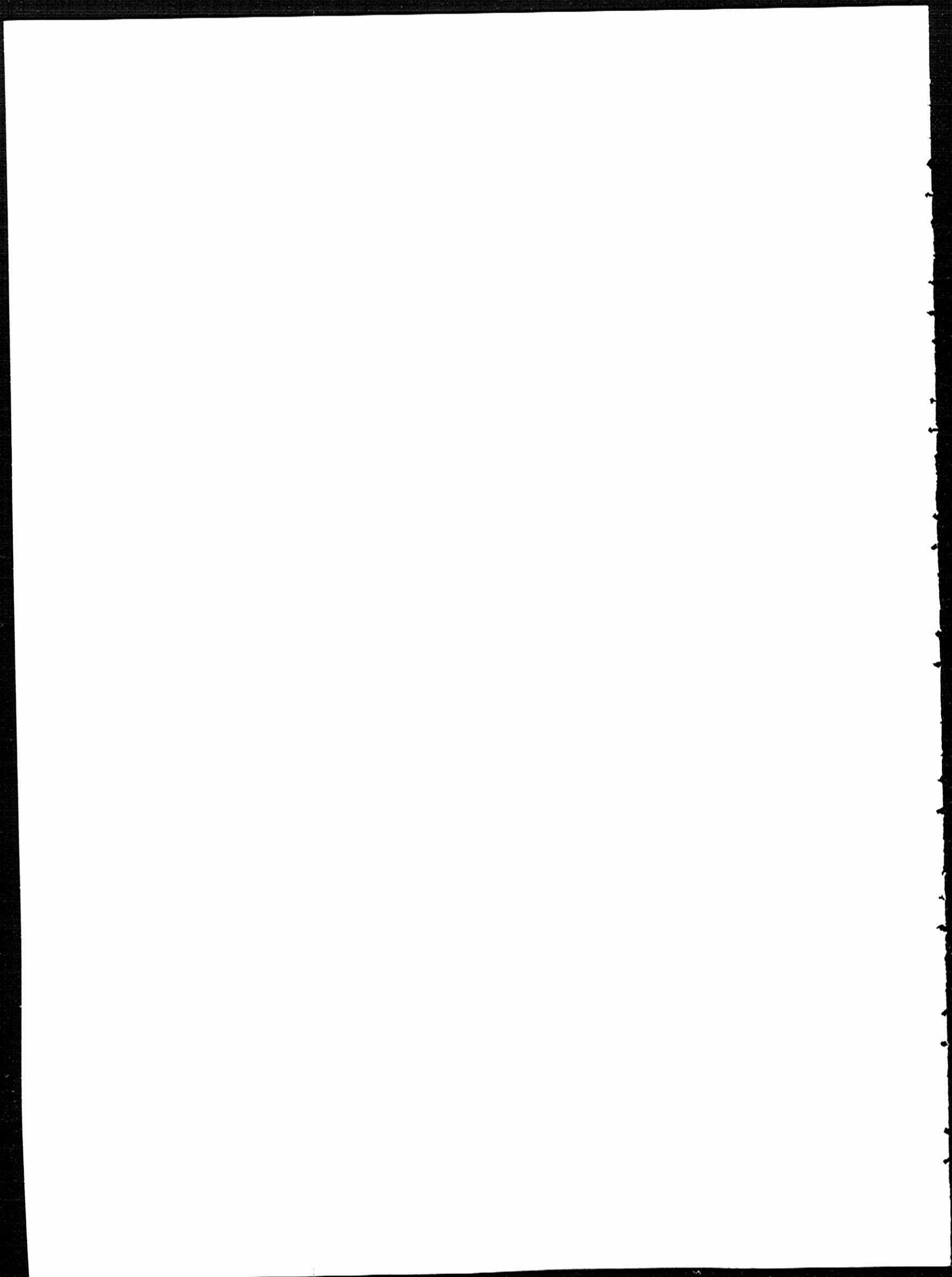
STATEMENT OF QUESTIONS PRESENTED	Flyleaf
JURISDICTIONAL STATEMENT	1
STATEMENT OF THE CASE	2
STATUTES AND CONSTITUTIONAL PROVISIONS INVOLVED	5
STATEMENT OF POINTS	6
SUMMARY OF ARGUMENT	7
ARGUMENT	9
CONCLUSION	13

TABLE OF AUTHORITIES CITED

In re Allen, 1940, 115 F.2d 936	8, 12
Amerio Contact Plate Freezers, Inc. v. Knowles (CA DC), 107 U.S. App. D.C. 81, 274 F.2d 590, 124 USPQ 91	12
Amerio Contact Plate Freezers, Inc. v. Belt-Ice Corporation, et al., (DC W Wash.), 130 USPQ 315	12
Amerio Contact Plate Freezers, Inc. v. Knowles (DC W Wash.), 130 USPQ 316	12
Crowell v. Benson, 285 U.S. 22, 62; 52 S.Ct. 285, 296; 76 L.Ed. 598 (1932)	11
General Foods Corporation v. Knowles (DC Dist. Col.), 120 USPQ 470	12
McCulloch v. Maryland, 4 Wheat. 316, 405; 4 L.Ed. 579 (1819)	8
Monaco et al. v. Watson, 270 F.2d 335, 106 U.S. App. D.C. 142	Flyleaf and 4, 5, 6, 8, 9, 12

STATUTES AND RULES

28 USC 1338, 2201, 2202, 1291 and 1292	1
35 USC 135, 141, 146 and 291	passim
Constitution of the United States, Article I, Section 8, Amendment V	6, 7, 9, 10
Federal Rules of Civil Procedure §§ 65(a) and (d)	4



United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 19,171

MONSANTO COMPANY, et al.

Appellants

v.

ERNST KAMP, et al.

Appellees

*Appeal From the United States District Court
For the District of Columbia*

BRIEF FOR APPELLANTS

JURISDICTIONAL STATEMENT

Jurisdiction for this Action and Appeal is founded upon 35 USC 146, 28 USC 1338, 2201, 2202, 1291 and 1292. Appellees Kamp et al are applicants for a United States patent containing claims copied from United States patent 2,830,721, Pinsky et al. Appellees prevailed in the Patent Office and elected to proceed in the District Court (JA 4-6).

The Commissioner of Patents, Appellee, was joined for the purpose of restraining issuance of a patent to Kamp et al., Appellees (JA 6-8). The Appeal is from an Order by the District Court denying Appellants' motions for temporary injunction restraining the Commissioner of Patents, Appellee, from issuing a patent to Appellees, Kamp et al. (JA 62, 63). Jurisdiction is not in dispute (JA 1, 60). The interference issues between Appellants and Kamp et al. have not been tried and are not before the Court at this time.

STATEMENT OF THE CASE

This is an appeal from an Order by the District Court (Jackson, Judge) denying motions by Plaintiffs-Appellants (Pinsky et al) for a preliminary injunction to restrain the Defendant Commissioner of Patents (Commissioner) from issuing a patent to the Defendants Kamp et al (Kamp et al) containing claims 1 and 7 of Pinsky et al Patent No. 2,830,721 pending a trial and final judgment on the merits of Pinsky et al's action under 35 USC 146. The purpose for joining the Commissioner was to seek to obtain the injunction. The propriety of the District Court's decision is the only issue before this Court.

The following statement is believed to set forth all of the facts necessary to a determination of the issues of this appeal.

Pinsky et al are the patentees named in United States Patent 2,830,721 issued April 15, 1958 (JA 10). The entire right, title and interest in and to the patent was assigned to Plax Corporation, a corporation of Delaware, which in turn assigned the patent to Appellant Monsanto Company, a corporation of Delaware.

Several years after issuance of the patent, Defendants-Appellees Kamp et al copied several of the fifteen claims of the Pinsky et al patent 2,830,721 in an application Serial No. 578,846, which was then and now is pending in the United States Patent Office. The Patent Office de-

clared interference No. 91,682 as to claims 1 and 7 of the patent, but refused to include the other claims of the patent in the interference on the ground that Kamp's disclosure did not support them. Claims 1 and 7 of the patent became Counts 1 and 2 of the interference. During the proceedings before the Patent Office Pinsky et al took testimony but Kamp et al took none. In addition to the counts of the interference Kamp et al have other claims pending in the application which may or may not be patentably distinct from Counts 1 and 2.

After a final hearing before the Board of Patent Interferences of the Patent Office, priority was awarded by the Board to Kamp et al on June 29, 1964. Prior to this award by the Board, Monsanto took a non-exclusive license under any United States patent which might eventuate from the Kamp et al application containing the Counts of the Interference (JA 29).

The Appellants here appealed the decision of the Board of Patent Interferences of the Patent Office to the Court of Customs and Patent Appeals on August 27, 1964, under the provisions of 35 USC 141. Appellees Kamp et al filed Notice on August 28, 1964 of an election to have all further proceedings conducted under 35 USC 146. The present action was filed in due course and the appeal to the C.C.P.A. was dismissed.

It has long been the practice in the Patent Office to refrain from issuing a patent to an applicant adjudged to be the prior inventor by the Board of Patent Interferences, during the pendency of an appeal to the Court of Customs and Patent Appeals. However, the Commissioner's practice is different when the review proceedings are under 35 USC 146. In this latter circumstance, the prosecution of the prevailing application is continued *ex parte* in the Patent Office, and the patent may and frequently does issue despite the fact that the review is still pending in the District Court.

On September 22, 1964, Pinsky et al petitioned the Commissioner of Patents (JA 13) to withhold the issuance of a patent to Kamp et al con-

The Commissioner of Patents, Appellee, was joined for the purpose of restraining issuance of a patent to Kamp et al., Appellees (JA 6-8). The Appeal is from an Order by the District Court denying Appellants' motions for temporary injunction restraining the Commissioner of Patents, Appellee, from issuing a patent to Appellees, Kamp et al. (JA 62, 63). Jurisdiction is not in dispute (JA 1, 60). The interference issues between Appellants and Kamp et al. have not been tried and are not before the Court at this time.

STATEMENT OF THE CASE

This is an appeal from an Order by the District Court (Jackson, Judge) denying motions by Plaintiffs-Appellants (Pinsky et al) for a preliminary injunction to restrain the Defendant Commissioner of Patents (Commissioner) from issuing a patent to the Defendants Kamp et al (Kamp et al) containing claims 1 and 7 of Pinsky et al Patent No. 2,830,721 pending a trial and final judgment on the merits of Pinsky et al's action under 35 USC 146. The purpose for joining the Commissioner was to seek to obtain the injunction. The propriety of the District Court's decision is the only issue before this Court.

The following statement is believed to set forth all of the facts necessary to a determination of the issues of this appeal.

Pinsky et al are the patentees named in United States Patent 2,830,721 issued April 15, 1958 (JA 10). The entire right, title and interest in and to the patent was assigned to Plax Corporation, a corporation of Delaware, which in turn assigned the patent to Appellant Monsanto Company, a corporation of Delaware.

Several years after issuance of the patent, Defendants-Appellees Kamp et al copied several of the fifteen claims of the Pinsky et al patent 2,830,721 in an application Serial No. 578,846, which was then and now is pending in the United States Patent Office. The Patent Office de-

clared interference No. 91,682 as to claims 1 and 7 of the patent, but refused to include the other claims of the patent in the interference on the ground that Kamp's disclosure did not support them. Claims 1 and 7 of the patent became Counts 1 and 2 of the interference. During the proceedings before the Patent Office Pinsky et al took testimony but Kamp et al took none. In addition to the counts of the interference Kamp et al have other claims pending in the application which may or may not be patentably distinct from Counts 1 and 2.

After a final hearing before the Board of Patent Interferences of the Patent Office, priority was awarded by the Board to Kamp et al on June 29, 1964. Prior to this award by the Board, Monsanto took a non-exclusive license under any United States patent which might eventuate from the Kamp et al application containing the Counts of the Interference (JA 29).

The Appellants here appealed the decision of the Board of Patent Interferences of the Patent Office to the Court of Customs and Patent Appeals on August 27, 1964, under the provisions of 35 USC 141. Appellees Kamp et al filed Notice on August 28, 1964 of an election to have all further proceedings conducted under 35 USC 146. The present action was filed in due course and the appeal to the C.C.P.A. was dismissed.

It has long been the practice in the Patent Office to refrain from issuing a patent to an applicant adjudged to be the prior inventor by the Board of Patent Interferences, during the pendency of an appeal to the Court of Customs and Patent Appeals. However, the Commissioner's practice is different when the review proceedings are under 35 USC 146. In this latter circumstance, the prosecution of the prevailing application is continued *ex parte* in the Patent Office, and the patent may and frequently does issue despite the fact that the review is still pending in the District Court.

On September 22, 1964, Pinsky et al petitioned the Commissioner of Patents (JA 13) to withhold the issuance of a patent to Kamp et al con-

taining the claims involved in the interference, pending a final judgment of the issues in the review of the interference proceedings in the District Court, and until such a time as there is a final judgment that Kamp et al are entitled to prevail in the issues there involved, and until, as a result of such final judgment, the Commissioner is authorized to issue a patent to Kamp et al in accordance with the law.

On September 25, 1964 the Plaintiffs filed a Bill of Complaint in the United States District Court for the District of Columbia, under 35 USC 146, Civil Action 2372/64, joining Appellees Kamp and Edward J. Brenner, Commissioner of Patents, as codefendants. The Commissioner was joined for the purpose of seeking the injunction referred to below (JA 2).

On the same day Plaintiffs filed a Motion for Preliminary Injunction under Rule 65(a) and (d) of the Federal Rules of Civil Procedure to restrain and enjoin Edward J. Brenner, Commissioner of Patents of the United States Patent Office from issuing a patent to Kamp et al based on application for United States patent, Serial No. 578,846 filed April 17, 1956 containing Counts 1 and 2 of Interference No. 91,682 which correspond to Claims 1 and 7 of Pinsky patent No. 2,830,721 (JA 11).

On September 28, 1964 the Commissioner, acting through First Assistant Commissioner, Edwin L. Reynolds, denied Appellants' Petition on the authority of *Monaco et al v. Watson*, 270 F.2d 335, 106 U.S. App. D.C. 142 (JA 15).

On September 30, 1964 Appellants filed in the District Court a Supplemental Motion for Preliminary Injunction against the Commissioner (JA 17). All Defendants have opposed the Plaintiffs' motions for preliminary injunction (JA 19, 22).

A hearing on these motions was duly held before Judge Joseph Jackson in the District Court for the District of Columbia, on October 16, 1964. In an Order dated December 8, 1964 Judge Jackson —

"ORDERED, that plaintiffs' motion for preliminary injunction, pursuant to the policy express in *Monaco v. Watson*, 106 U.S. App. D.C. 142, 270 F.2d 335 (1959), be, and hereby is, denied, . . ."

— Quoting from the Order, (JA 62)

It is from this portion of the Order that Pinsky appeals.

All of the Appellees have filed answers to Pinsky's Complaint as to the several issues raised thereby (JA 22, 60). The interference issues between Appellants and Kamp have not been tried and are pending in the District Court. They are not under consideration here.

On January 5, 1965, the Appellants filed Notice of Appeal to this Court (JA 63).

STATUTES AND CONSTITUTIONAL PROVISIONS INVOLVED

The issue here involved arises from the Commissioner's interpretation of the first paragraph of 35 USC 135 which reads as follows:

"§ 135. Interferences

Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the

patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office."

Article I, Section 8 of the Constitution of the United States reads in part as follows:

"SECTION 8. The Congress shall have Power . . .

"To promote the Progress of Science and useful Arts, by securing for limited Times to . . . Inventors the exclusive Right to their . . . Discoveries;"

Amendment V provides in part:

"No person shall be . . . deprived of . . . property, without due process of law; . . ."

STATEMENT OF POINTS

The points to be relied upon by Appellants are as follows:

- (1) The Court erred as a matter of law in applying the policy of *Monaco et al v. Watson*, 270 F.2d 335, 106 U.S. App. D.C. 142 to the present case.
- (2) The Court erred in failing to recognize that issuance of a patent prior to final determination of the interference issues to Appellees Kamp et al may irreparably damage Appellant, Monsanto.
- (3) The Court erred in failing to recognize that issuance of a second patent to Kamp et al containing identical claims to those in the Pinsky et al patent is adverse to the public interest, absent a final judgment that Kamp et al are entitled to prevail on the interference issues, and compliance otherwise with the law.
- (4) The Court erred in failing to find, as a matter of law, that there is no statutory basis for issuance of a second patent containing identical claims to those in the Pinsky et al patent, until and unless there is a final judgment that Kamp et al are entitled to prevail on the interference issues.

- (5) The Court erred in failing to find, as a matter of law, that if 35 USC 135 be construed as permitting the Commissioner of Patents to issue a second patent while the review under 35 USC 146 is pending, then 35 USC 135 is to that extent, unconstitutional.
- (6) The Court erred as a matter of law in failing to grant Plaintiffs-Appellants' motions for preliminary injunction.

SUMMARY OF ARGUMENT

The practice by the Commissioner of Patents of issuing a patent to an applicant who has received a favorable decision from the Board of Patent Interferences of the Patent Office, as to counts copied from an issued patent, without regard to the pendency of a Civil Action under 35 USC 146 for review of the Board's decision, is contrary to statutory and constitutional law. The issuance of a second patent containing identical claims prior to final adjudication of the interference issues would result in there being two subsisting presumptively valid patents of identical scope to which identical "exclusive" rights attach. If 35 USC 135 be construed to permit this practice it is unconstitutional under Article I, Section 8, and Amendment V of the Constitution. Section 135 is, however, susceptible of a construction which avoids such a conclusion but which would prevent issuance of a second patent in a case such as here presented.

If a patent issues to Kamp et al, it may well contain claims in addition to, but not patentably distinct from, the counts of the interference. Thus, even if Kamp et al were to lose in the action under 35 USC 146, only the claims corresponding to the counts of the interference would be cancelled under the provisions of 35 USC 135. Section 135 does not void the losing patent but merely serves to cancel the claims directly involved in the contest. As to other claims not cancelled by operation of the statute, the presumption of validity may be clouded but is not dispelled.

Even though Appellants were to prevail on the interference issues, the problems presented by the presence of other claims in a patent issued in the meantime to Kamp et al would not be resolved, thus remaining as a potential source of litigation, and therefore of concern to the public. As to Appellant Monsanto, as long as it remained a licensee it would be estopped to challenge the validity of the uncanceled claims. On the other hand, if Monsanto cancelled the license, it might be subject to suit for infringement. Thus Monsanto would be in the position of having to continue to pay royalty or risk litigation as an infringer.

These are matters of public as well as private concern which need not arise if the Commissioner is enjoined from issuing the patent until and unless the Court enters a final judgment in Kamp et al's favor on the interference issues. Appellants contend that the *Monaco* case, *supra*, differs on the facts and is not controlling here.

Appellant Monsanto also states that issuance of a patent to Kamp et al containing the counts of the interference will result in Monsanto's having to pay royalties which can never be recovered even though Appellants should ultimately prevail on the interference issues. This would represent irreparable damage to Monsanto.

It is Appellants' position that just as the Commissioner has no jurisdiction to issue a patent to a winning party in an interference proceeding during pendency of the loser's appeal to the Court of Customs and Patent Appeals (*In re Allen*, 1940, 115 F.2d 936), he likewise has no jurisdiction to issue a second patent pending the final termination of proceedings brought under 35 USC 146. Having issued one patent, the Commissioner has exhausted his power to issue a second patent on the same invention absent final authorization by the Court, and compliance otherwise with the law. If Section 135 be interpreted otherwise, it is clearly unconstitutional. *McCulloch v. Maryland*, 4 Wheat. 316, 405, 4 L. Ed. 579 (1819).

ARGUMENT

The gist of Appellants' position has been set forth under the Summary and the argument herein given will be addressed only to those points which may need elaboration.

Whatever may be said of the issuance of a patent at the discretion of the Commissioner to an applicant successful before the Board of Patent Interferences where two applications are involved, the situation is different here. The case of *Monaco v. Watson*, supra, by which the lower Court felt he was bound, involved two applications for patent but the present case involves an issued patent and a pending application. Issuance of a patent to Defendants Kamp et al would result in the intolerable situation in which there were two subsisting patents having identical claims and carrying with them identical rights, both of which are presumptively valid. It is not believed that Congress ever intended that such a situation should be brought about nor that Congress did or could, under the Constitution, delegate such authority to the discretion of the Commissioner of Patents.

Article I, Section 8 of the United States Constitution grants to Congress the power "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the *exclusive Right* to their respective Writings and Discoveries" (Emphasis added). If Title 35 USC 135 be construed as permitting the Commissioner to grant a second patent while the issue as to who is entitled to the claims in suit is still being litigated, it is unconstitutional since an exclusive right cannot be vested at the same time in both litigants. Any legislation by Congress which goes beyond the Constitutional grant of power should be declared unconstitutional. The granting of a second patent covering the identical subject matter as that of an already subsisting and presumptively valid patent prior to a final judicial determination of priority of invention is at variance with our Constitution. Such a second

grant cannot be considered to secure the exclusive right to the invention already vested in the initial patentee. On the contrary, to grant a second patent prior to a final judicial determination derogates from the exclusive rights granted to the initial patentee, and, in addition to causing untold confusion for the public at large and prospective licensees, deprives the Appellants of property rights without the due process of law as guaranteed by our Constitution in the Fifth Amendment.

Appellants contend that Title 35 USC 135, if properly construed does not contemplate the possible issuance of a second patent upon decision of the Board of Patent Interferences in favor of a successful applicant. Section 135 provides for different treatment in the case of interferences between two or more patent applications, and between an issued patent and a pending application.

"The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, *if adverse to the claim of an applicant*, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner *may* issue a patent to the *applicant* who is adjudged the prior inventor."

—Quoting 35 U.S.C. 135 [Emphasis Added Throughout]

The decision cannot constitute "the final refusal by the Patent Office of the claims involved" when, as in the present case, those claims have already been issued in a patent. While the first part of the sentence embraces all interferences, the last part refers solely to applicants. Thus, it is only when two or more applications are involved that the Commissioner may, at his discretion, issue a patent to the successful applicant in the Patent Office. Had Congress intended otherwise, it would have been a simple matter to have so stated.

Instead, in the very next sentence the statute refers to the case of an interference involving an issued patent:

"A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office."

—Quoting 35 USC 135

We submit that this was provided so there could not be two patentees claiming exclusive rights under identical claims.¹

Furthermore, Section 146 expressly provides the means by which applicants such as Kamp et al may obtain the issuance of the patent if they prevail.

"Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such a patent on the filing in the Patent Office of a certified copy of the judgment and on compliance with the requirements of law."

—Quoting 35 USC 146

We therefore contend that the Commissioner of Patents has no authority to issue a second patent until and unless Kamp et al are finally judged to be the prior inventors. Section 135 of Title 35 USC is susceptible of the interpretation here urged and thus avoids the constitutional question.

"When the validity of an act of the Congress is drawn in question, and even if a serious doubt of constitutionality is raised, it is a cardinal principle that this Court will first ascertain whether a construction of the statute is fairly possible by which the question may be avoided."

—Quoting *Crowell v. Benson*, 285 U.S. 22, 62;
52 S. Ct. 285, 296; 76 L. Ed. 598 (1932)

¹ Title 35 USC 291 provides for proceedings involving interfering patents. These are usually issued inadvertently.

It is further submitted that when the suit was filed under Section 146, The Commissioner lost jurisdiction over the subject matter. Section 141 provides for appeals to the Court of Customs and Patent Appeals. *In re Allen*, 115 F.2d 936 (1940) under a statute analogous in every material respect to present 35 USC 141, held that the Commissioner of Patents loses jurisdiction pending an appeal to the CCPA. As Judge Burger pointed out (JA 32, 33) in a dissenting opinion in the *Monaco* case, Sections 141 and 146 are mutually exclusive remedies with identical time limitations. Procedurally the routes are the same and should have the same effect upon the jurisdiction of the Commissioner pending review, particularly in cases such as this involving a patent and an application. The statutes clearly make no distinction between the routes for review and there appears to be no reason why any distinction should be made. Moreover, having once issued a patent the Commissioner has exhausted his power to issue another identical with it without the authorization of the Court.²

While Appellants have pointed to concrete instances of irreparable damage to Monsanto, it is impossible to predict what other harmful effects could or would result from the needless issuance of a second patent prior to a final decision on the interference issues.

² The complications that may arise when, pending review in the District Court, a second patent is issued to an applicant who has prevailed over a patentee before the Board of Interference Examiners, is to be found in the following cases involving the same subject matter: *General Foods Corporation v. Knowles* (DC Dist. Col.), 120 USPQ 470; *Amerio Contact Plate Freezers, Inc. v. Belt-Ice Corporation et al.* (DC W Wash.), 130 USPQ 315; *Amerio Contact Plate Freezers, Inc. v. Knowles* (DC W Wash.), 130 USPQ 316; and *Amerio Contact Plate Freezers, Inc. v. Belt-Ice Corporation et al.* (CA 9), 316 F.2d 459, 137 USPQ 282. There were a plurality of actions under several statutes including 35 USC 146, 35 USC 291 (Interfering Patents), the Declaratory Judgment Statutes, and Cross-Complaints for Infringement. The withholding of issuance of the second patent in those circumstances would have avoided the expensive and complicated litigation which followed.

CONCLUSION

Appellants therefore Pray that the District Court's denial of the motion for preliminary injunction be reversed and that the Court be directed to forthwith issue an Order enjoining and restraining Defendant Edward J. Brenner, Commissioner of Patents, from issuing a patent to Kamp et al based on application Serial No. 578,846 containing Claims 1 and 7 of the Pinsky et al patent 2,830,721 until and unless a final determination of the issues of this suit establish that Kamp et al are entitled to a judgment of priority in their favor and are otherwise entitled to a patent containing Claims 1 and 7 of said Pinsky et al patent.

Of Counsel

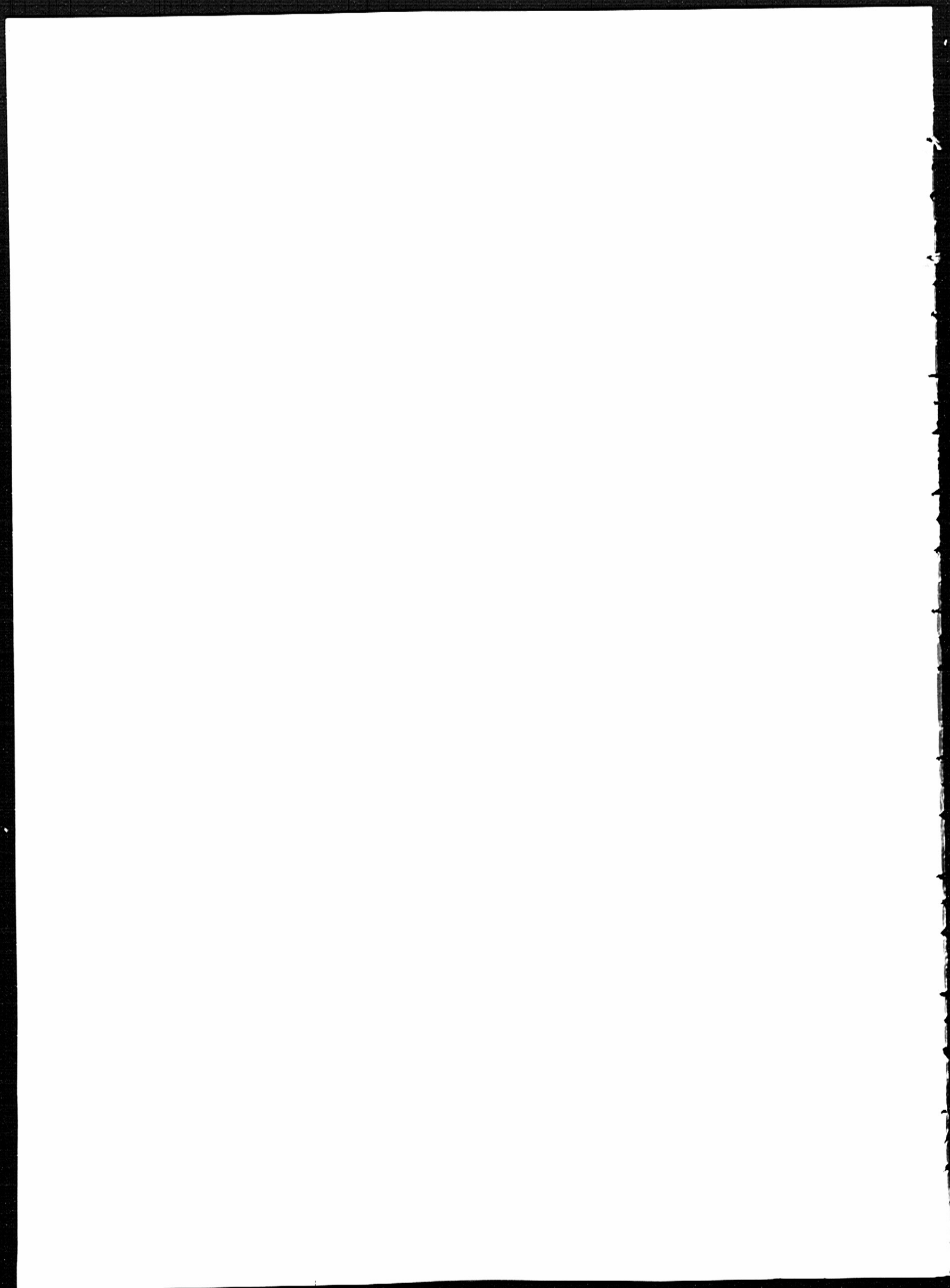
James P. Burns
Herbert B. Roberts
Peter H. Smolka

W. L. BENEDICT

BURNS, DOANE, BENEDICT,
SWECKER & MATHIS

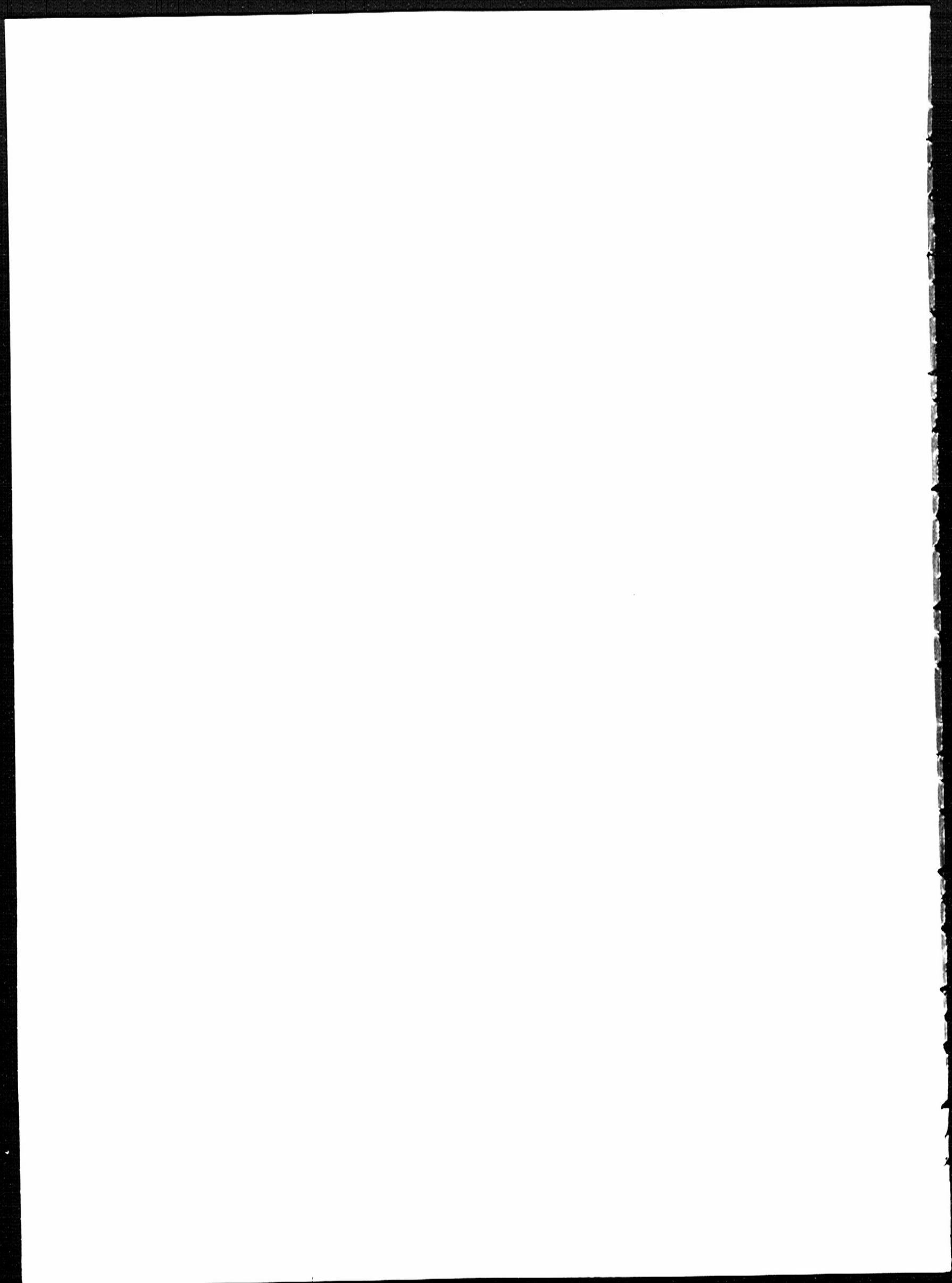
850 Munsey Building
Washington 4, D.C.

Attorneys for Appellants



CONTENTS OF JOINT APPENDIX

Bill of Complaint Under 35 U.S.C. 146, filed September 25, 1964	1
Plaintiffs' Motion for Preliminary Injunction, filed September 25, 1964	11
Affidavit Supporting Motion for Temporary Injunction	12
Petition to the Commissioner, Interference No. 9 1,682	13
Commissioner's Order denying Petition	15
Supplemental Motion for Preliminary Injunction, filed September 30, 1964	17
Opposition to "Plaintiffs' Motion for Preliminary Injunction" etc., by defendant Commissioner of Patents, filed October 6, 1964	19
Opposition to Plaintiffs' Motion for Preliminary Injunction, etc., by defendants Kamp and Jahn, filed October 7, 1964	22
Answer of defendants Kamp and Jahn, filed October 15, 1964	22
Defendants' Exhibit 1, Letter dated February 18, 1964, Monsanto Chemical Company to Paul M. Craig, Jr.	26
Defendants' Exhibit 2, Letter dated March 17, 1964, Monsanto Chemical Company to Paul M. Craig, Jr.	28
Defendants' Exhibit 3, Agreement of May 20, 1964	29
Memorandum in Support of Plaintiffs' Motion for Preliminary Injunction, filed October 15, 1964	34
Reply by Commissioner to "Memorandum in Support of Plaintiffs' Motion for Preliminary Injunction," filed October 26, 1964	39
USCA-DC, No. 7577, Radtke v. American Tri-Ergon Corp., pleading Re: Motion for Temporary Injunction Pending Appeal	43
Patent Interferences Board Decision No. 91,682	47
Answer to Complaint, by attorney for defendant Commissioner of Patents, filed November 5, 1964	60
Order, filed December 8, 1964, Jackson, J.	62
Notice of Appeal, filed January 5, 1965	63
Relevant Docket Entries	64
Clerk's Certificate	65



JOINT APPENDIX

IN THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF COLUMBIA

MONSANTO COMPANY (A Corporation)
Post Office Box 1531
Springfield, Massachusetts

JULES PINSKY,
ALBERT E. ADAKONIS, and
ALVIN R. NIELSEN
101 Granby Street
Bloomfield, Connecticut

Plaintiffs

v.

ERNST KAMP
101 Bucherstrasse, Nuernberg, Germany
KARL JAHN
90 Bucherstrasse, Nuernberg, Germany
Which parties have duly authorized
and appointed as agent and attorney:
Paul M. Craig, Jr.
Pennsylvania Building,
Washington 4, D. C., and

EDWARD J. BRENNER
Commissioner of Patents
Washington 25, D. C.

Defendants

CIVIL ACTION

NO. 2372-'64

[Filed September 25, 1964]

BILL OF COMPLAINT UNDER 35 U.S.C. 146

The plaintiffs herein allege and complain as follows:

1. That this action arises under the patent laws of the United States and more particularly under 35 U.S.C. 146, 35 U.S.C. 256, and under 28 U.S.C. 1338, 2201 and 2202.

2. Plaintiff, Monsanto Company (MONSANTO), a corporation of Delaware, is the owner by mesne assignments of the entire interest in and to United States patent 2,830,721, which assignments have been recorded in the United States Patent Office at reel 441, Frame 152 on December 18, 1957 to Plax Corporation, and at reel 1191, Frame 456 on October 10, 1962, to Monsanto Chemical Company, said Company having changed its name to Monsanto Company on April 1, 1964.
3. That on March 28, 1956, an application Serial No. 574,383 was filed on behalf of Plaintiffs Pinsky, Adakonis and Nielsen, citizens of the United States, and that the Commissioner of Patents duly and legally issued United States patent 2,830,721 on April 15, 1958. A copy of the patent is appended hereto as Exhibit A.
4. That on or about April 17, 1956 Defendants Kamp et al, citizens of and residing in West Germany, filed application for patent, Serial No. 578,846, claiming priority under German applications K 25605 III/33c, filed April 22, 1955; K 25812 VI/48b, filed May 13, 1955; and K 27597 VI/48b, filed December 14, 1955.
5. That Defendant Edward J. Brenner (Commissioner) is the Commissioner of Patents of the United States Patent Office whose official residence is within the District of Columbia.
6. That Defendant Kamp et al asserted Claims 1, 2, 4, 6, 7, 8, 10, 12 and 14 of the Pinsky et al patent on February 1, 1960, more than one year after issuance of the patent on April 15, 1958 and after having amended their application to incorporate, as new matter, a definition of an epoxy resin not contained in the United States application as filed nor in any of the German applications upon which Kamp et al rely for priority, all in violation of 35 U.S.C. 135. Claims 1 and 7 became counts of the interference. They later attempted by motion to add Claims 2, 4, 8 and 10 of the patent to the interference but were denied for lack of supporting disclosure.
7. That on or about January 27, 1961, the Commissioner declared an

interference, No. 91,682, between the Pinsky et al patent and the Kamp et al United States application as to claims 1 and 7 of the patent in suit, these corresponding to Kamp et al's claims 49 and 53, which are now Counts 1 and 2 respectively of the interference.

8. The two Counts of the interference are as follows:

"1. A synthetic resin article having a surface characterized by enhanced resistance to permeation by organic fluids, said surface having an adherent coating of a cured epoxy resin.

"2. A polyethylene container having a surface characterized by enhanced resistance to permeation by organic fluids, said surface having an adherent coating of a cured epoxy resin."

9. That Pinsky et al duly moved to dissolve the interference on the grounds that (a) the Kamp et al disclosure in the United States application was inadequate to support the counts of the interference, and (b) that the claims had not been timely copied and hence were barred under the final paragraph of 35 U.S.C. 135.
10. Notwithstanding this, the Commissioner erroneously denied Plaintiffs' motions to dissolve the interference and erroneously granted a Kamp et al motion to shift the burden of proof on the earliest date of the German applications, namely April 22, 1955 over Plaintiffs' opposition on the ground that the German applications were inadequate to support the counts.
11. During Counsel's preparation for taking testimony in the above interference, it was discovered that Albert E. Adakonis had been misjoined as a coinventor and appropriate steps were taken in the Patent Office to have him removed from the patent under 35 U.S.C. 256. This matter has not been decided. Hence, Plaintiffs, as part of the relief here sought, ask this Court to order the Commissioner to correct the patent by removing his name therefrom as provided by law.

12. Beginning in the spring or early summer of 1953 and at various intervals thereafter the invention was successfully reduced to practice in this country by Plaintiff Adakonis, by applying adherent cured epoxy resins to polyethylene containers and thereafter testing them for the intended purpose of enhancing resistance to permeation by organic fluids, and establishing that the so coated surfaces did enhance resistance to permeation by such fluids and possessed the requisite utility.
13. The Commissioner, through the Board of Interference Examiners, erroneously held that the acts set forth in Paragraph 12 did not constitute actual reduction to practice of the invention.
14. As a consequence, on June 29, 1964, the Commissioner, through the Board of Interference Examiners, erroneously held that Plaintiffs were confined to their United States filing date of March 28, 1956 and that Defendants Kamp et al were entitled to priority based on their April 22, 1955 filing date in Germany.
15. On August 27, 1964, Pinsky et al timely filed Notice of Appeal from the decision of June 29, 1964 in Interference No. 91,682, to the Court of Customs and Patent Appeals in accordance with 35 U.S.C. 141, giving reasons of appeal as provided by 35 U.S.C. 142, which reasons are made a part of this Complaint, as follows:

"Appeal is hereby made to the Court of Customs and Patent Appeals from the decision of the Board of Interference Examiners rendered in the above-entitled Interference on June 29, 1964 on the following grounds:

- "1. The Board of Interference Examiners erred in holding that the evidence was not adequate to establish a successful reduction to practice of the invention of the counts on behalf of Pinsky and Nielsen prior to the filing date of the Kamp et al German application of April 22, 1955;
- "2. The Board of Interference Examiners erred in failing to hold that the Pinsky and Nielsen proofs establish that a synthetic resin

article, and specifically a polyethylene container responding to the Counts, had been produced having an adherent cured epoxy resin coating which was shown to be capable of successful use for its intended purpose, prior to April 22, 1955;

- "3. The Board of Interference Examiners held in effect that up to May or June 1955 some bottles were lined, cured, flexible, and reduced permeability, but erred in failing to hold that these articles responded to the Counts and constituted a successful reduction to practice of the Pinsky and Nielsen invention;
- "4. The Board of Interference Examiners erred in holding that Kamp et al are entitled to rely on the filing date of their German application, namely April 22, 1955, and in failing to hold that as to the Kamp et al United States filing date of April 17, 1956, Pinsky et al are Senior Party and the prior inventors;
- "5. The Board of Interference Examiners erred in holding that Appellants' attack on the disclosure of the Kamp et al German application of April 22, 1955 as failing to disclose a means for producing an adherent coating of a cured epoxy resin was directed to operability of the Kamp et al German application and that since operability was not raised before the Primary Examiner during the motion period, Appellants are not entitled to be heard here on this aspect of the adequacy of disclosure;
- "6. The Board of Interference Examiners erred in using in effect the disclosure of the Pinsky et al patent as evidence that a person skilled in the art and having the Kamp et al German application before him would be enabled to produce a coated article responding to the Counts in interference;
- "7. The Board of Interference Examiners erred in failing to find the German application of Kamp et al fatally deficient as to disclosure of any means for producing an epoxy coated article responding to the Counts, and in further failing to hold that a constructive reduction to practice must be at least as complete and

meaningful as an actual reduction to practice of an invention for its intended use;

"8. The Board of Interference Examiners erred in failing to hold that Kamp et al were not entitled to an award of priority because of failure to copy the claims constituting the Counts of the interference in compliance with the Statute, 35 U.S.C. 135;

"9. The Board of Interference Examiners erred in awarding priority of the subject matter in issue to Kamp et al.

"10. The Board of Interference Examiners erred in failing to award priority to Pinsky and Nielsen."

16. Under date of August 28, 1964, Paul M. Craig, Jr., as attorney for Kamp et al, filed notice with the Commissioner of Patents of Kamp et al's election to proceed as provided in 35 U.S.C. 141 and as a consequence this Complaint, under 35 U.S.C. 146, is now filed. Summons should be served on attorney Craig or such other manner as the Honorable Court may direct.
17. Although the Commissioner will not issue a patent to a successful applicant during the pendency of a losing party's appeal to the Court of Customs and Patent Appeals, the practice is different with respect to actions under 35 U.S.C. 146. Despite the fact that the matter is still under review by the District Court and may well be determined adversely to the winner in the Patent Office, under Patent Office practice the ex parte prosecution of the winner's application continues forthwith after the appeal is dismissed in the Court of Customs and Patent Appeals, to the ultimate issuance of the patent. See 1109.01, Manual of Patent Examining Procedure, page 193, a copy of which is appended as Exhibit B. To like effect as to interferences between pending applications is Monaco et al v. Watson, 270 F(2d) 335.
18. Therefore on information and belief, Plaintiffs allege that unless restrained as hereinafter prayed, the Defendant Edward J. Brenner, Commissioner of Patents, will issue a patent to Kamp et al based

on Serial No. 578,846, containing as claims, the counts of the interference No. 91,682, which are claims 1 and 7 of the Pinsky et al patent, before the review by this Court shall have been finally adjudicated.

19. Issuance of a patent to Kamp et al containing the counts in suit would result in there being two subsisting and presumptively valid patents of identical scope containing identical claims and to which identical rights attach which may be independently exercised by the respective patentees since cancellation of claims 1 and 7 of the Pinsky et al patent under 35 U.S.C. 135 cannot take effect until and unless there is a final adjudication of this cause adverse to Plaintiffs. This is a matter of concern to the public as well as the parties hereto. The Monaco case, supra, relating to interference between pending applications, is not here controlling.
20. The Commissioner, having duly and legally issued the presumptively valid Pinsky et al patent, there exists no constitutional and statutory power to issue a second patent to Kamp et al containing claims 1 and 7 and, issuance of a second patent may not legally be authorized until such a time as there is a final judgment adverse to Plaintiffs from which no appeal or other review has been or can be taken or had, and until all other requirements of law have been met by Kamp et al.
21. Issuance of a second patent to Kamp et al pending final adjudication of this litigation would cause Plaintiffs' irreparable injury and damage, is contrary to sound public policy, and is without statutory or constitutional basis.
22. Plaintiffs have filed and have pending before the Commissioner of Patents a Petition to withhold the issuance of a patent to Kamp et al pending a final adjudication of this litigation.

Prayer

(1)

That Defendant Edward J. Brenner, Commissioner of Patents, be forthwith enjoined and restrained from issuing a patent to Kamp et al based on application Serial No. 578,846 and containing claims 1 and 7 of the Pinsky et al patent 2,830,721 until and unless a final determination of the issues in this suit establishes that Kamp et al are entitled to judgment of priority in their favor and are entitled to have a patent containing the claims 1 and 7 of said Pinsky et al patent issued to them.

(2)

That Pinsky and Nielsen be declared the first inventors of the counts of interference 91,682 and that priority be awarded to them as the first to conceive and the first to reduce the invention to practice in this country both actually and constructively.

(3)

That Kamp et al be declared not entitled to a patent containing the counts because they were not timely asserted under 35 U.S.C. 135.

(4)

For a judgment that Kamp et al failed to disclose in United States application Serial No. 578,846 the invention of the counts with the exactitude required by 35 U.S.C. 112, and hence are not entitled to a patent therefor under applicable law.

(5)

For a judgment that Kamp et al are not entitled to rely on any German filing date earlier than the April 17, 1956 filing date of their United States application and hence are not properly senior parties and are dis-entitled to priority over the Pinsky et al March 28, 1956 United States filing date.

(6)

That the Defendant Edward J. Brenner, Commissioner of Patents, be ordered to correct United States patent No. 2,830,712 by removing

the name of Albert E. Adakonis as a coinventor, pursuant to 35 U.S.C. 256.

(7)

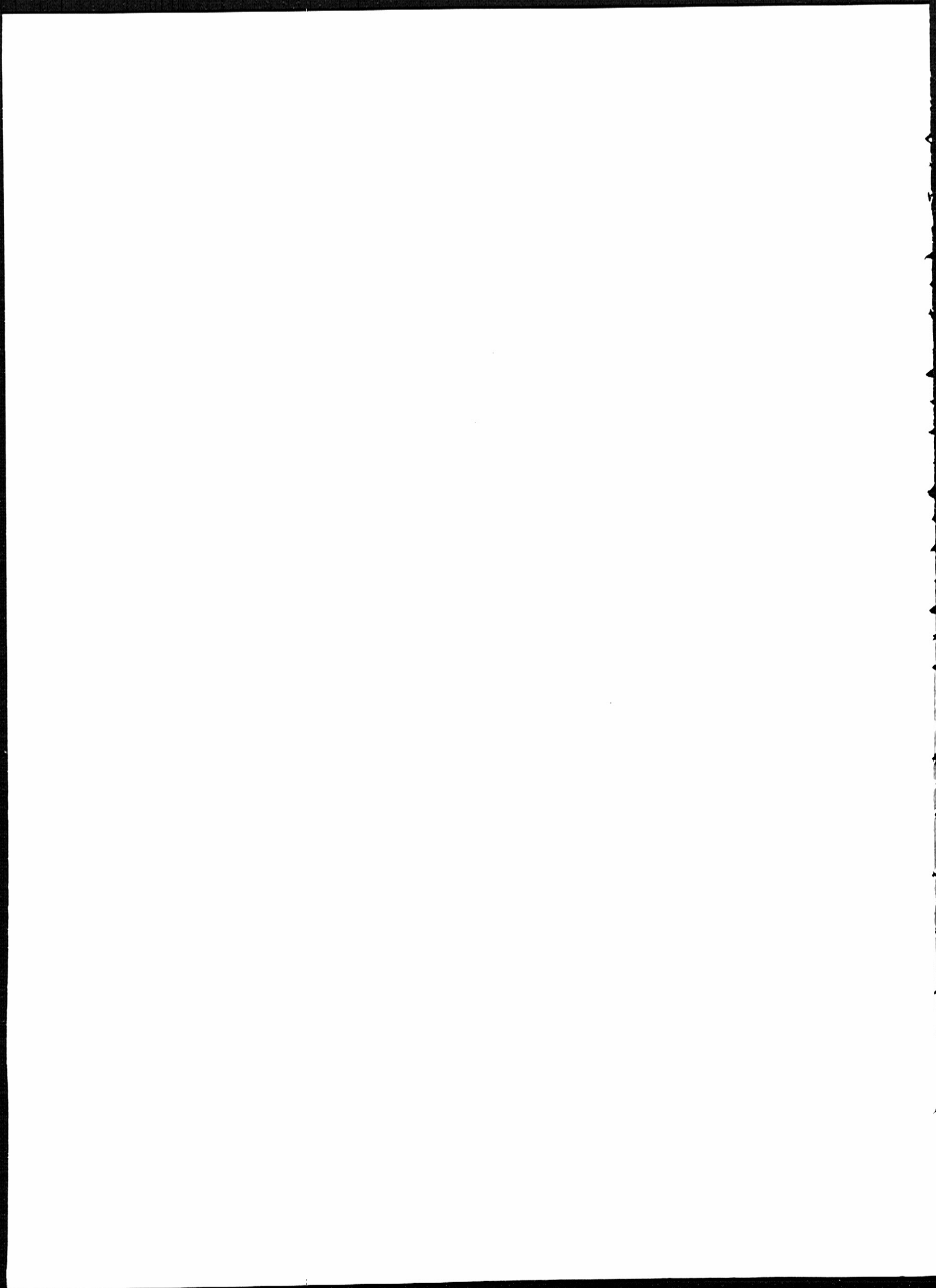
That such other and different relief be granted as the Court deems just and fair.

MONSANTO COMPANY
JULES PINSKY
ALBERT E. ADAKONIS
ALVIN R. NIELSEN

By /s/ Wayne L. Benedict
W. L. Benedict
Burns, Doane, Benedict, Swecker &
Mathis
Attorneys for Plaintiffs

Of Counsel
James P. Burns
Herbert B. Roberts
Peter H. Smolka

September 25, 1964



April 15, 1958

J. PINSKY ET AL
PLASTIC COATED ARTICLES
Filed March 28, 1956

2,830,721

Fig. 1.

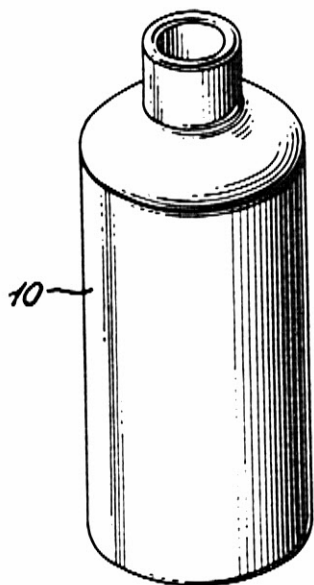


Fig. 2.

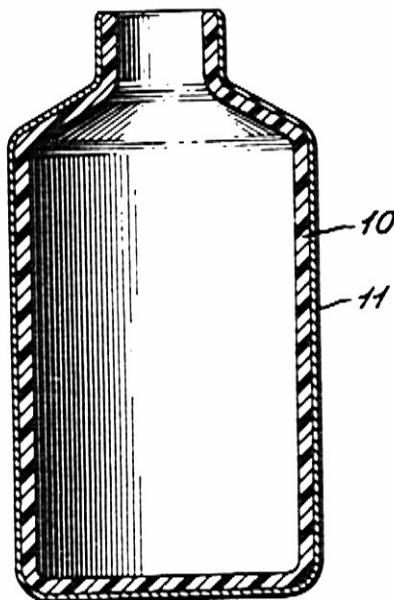


Fig. 3.

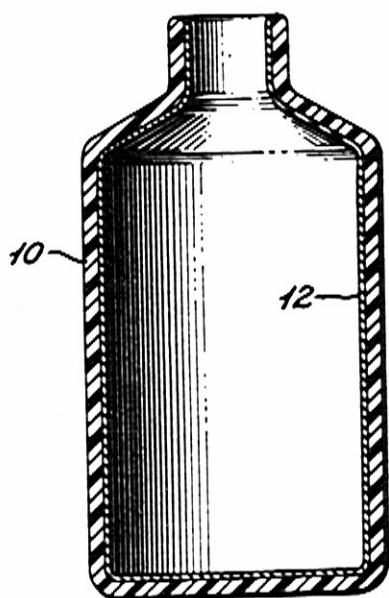
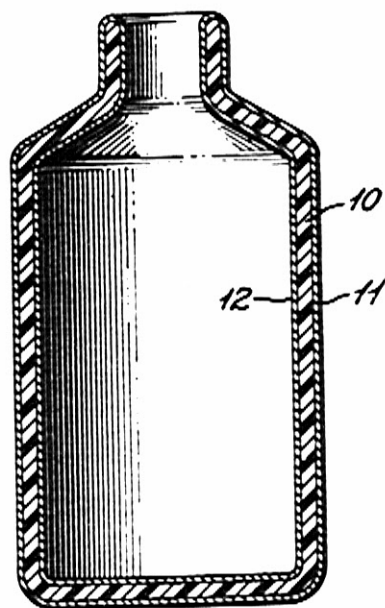


Fig. 4.

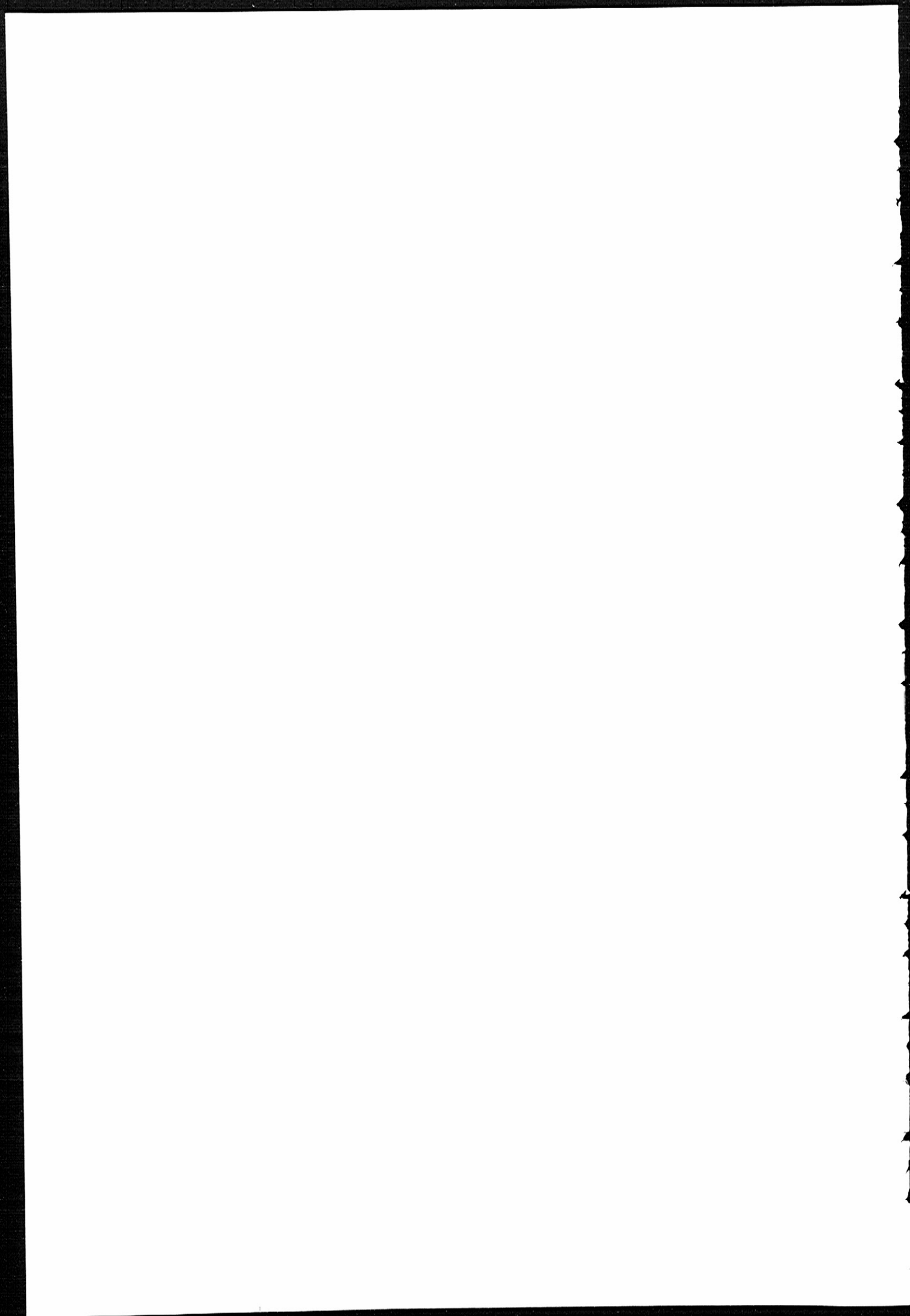


INVENTORS

JULES PINSKY,
ALBERT E. ADAKONIS
and ALVIN R. NIELSEN

BY

Burns, Doane, Benedict & Sons
ATTORNEYS



1

2,830,721

PLASTIC COATED ARTICLES

Jules Pinsky, West Hartford, Albert E. Adakonis, East Hartford, and Alvin R. Nielsen, Hartford, Conn., assignors to Plax Corporation, Bloomfield, Conn., a corporation of Delaware

Application March 28, 1956, Serial No. 574,383

15 Claims. (Cl. 215—1)

This invention relates generally to synthetic resin articles and more particularly to synthetic resin articles, such as sheets, bottles and containers, which have enhanced resistance to permeation by fluids. More specifically, the invention is directed to plastic articles, such as polyethylene containers and bottles, a surface of which is modified by application of an adherent coating thereto to prevent or reduce the rate of permeation of the synthetic resin material by many of the commonly encountered fluids, particularly organic liquids.

Synthetic resin containers and bottles as, for example, polyethylene bottles, have become widely popular as a packaging means for various liquids such as deodorants, hair preparations, cosmetic preparations, medicinal preparations, and the like. In particular, polyethylene has been and is widely used in the production of squeeze bottles for the distribution of such preparations in that it is relatively inert, has the necessary flexibility to function as a squeeze bottle, and can be easily fabricated in quantity at a reasonable cost. Unmodified polyethylene is entirely satisfactory for a wide variety of materials. However, polyethylene and other synthetic resins which are usable as containers are permeable to many organic liquids, including a large number of conventional organic solvents which are widely used in fluid preparations for which the polyethylene bottle or container is highly desirable. Representative chemicals, for example, which permeate with various degrees of rapidity through polyethylene at room temperature, include the straight chain hydrocarbons, the aromatic hydrocarbons, esters, ketones, and various other non-polar fluids. Consequently, because of this high permeability characteristic of polyethylene and other synthetic resin materials from which containers are desirably fabricated, the use of these materials has of necessity been restricted to those products to which the resin is substantially impermeable. The permeable characteristics of polyethylene with respect to certain of these chemicals has resulted in polyethylene bottles being rejected for use in applications where, due to its flexibility and ease of fabrication, it might otherwise be employed to greater advantage.

It has previously been suggested that polyethylene bottles be lined with such materials as polyvinyl alcohol, polyvinyl chloride and copolymers of polyvinyl chloride and polyvinyl acetate to obtain an oil resistant film which will resist permeation by oily materials. While such liners have been moderately successful, there is currently no known liner material which will form an adherent coating on a polyethylene surface and which will resist permeation by a wide variety of organic fluids such as toluene, hexane, carbon tetrachloride, ethyl acetate, and the like.

In view of the problems as above set forth relating to the use of synthetic resin containers and bottles, particularly those produced from polyethylene, it is a primary object of this invention to provide a plastic article which is characterized by enhanced resistance to permeation by a variety of fluids.

2

It is another object of this invention to provide a container or bottle formed from a synthetic resin, a surface of which carries an adherent coating which will prevent permeation of the resinous container structure by a variety of commonly employed organic fluids.

It is an additional object of this invention to provide a polyethylene bottle having an adherent resinous coating on the interior and/or exterior surface thereof which is characterized by substantial freedom from permeation by a variety of organic fluids, particularly the common hydrocarbon solvents.

It is a more specific object of the present invention to provide a polyethylene bottle having an adherent synthetic resin coating which is substantially impermeable to many organic fluids capable of substantially permeating the polyethylene bottle walls in the absence of such coating.

Generally described, the present invention comprises a plastic article having a surface characterized by enhanced resistance to permeation by fluids comprising a plastic surface having an adherent coating of a cured epoxy resin. In its more specific embodiments, the invention comprises a synthetic resinous container, a surface of which has an adherent coating of a cured epoxy resin. In its most preferred embodiment, the invention comprises a polyethylene bottle, the interior surface of which has an adherent coating of a cured epoxy resin.

An epoxy resin may be broadly defined as the complex polymeric reaction product of polyhydric phenols with poly-functional halohydrins. Usually the halohydrin is employed in proportions in excess of that equivalent to the polyhydric phenol and less than that which is twice the equivalent amount. The reaction is usually carried out in the presence of caustic alkali which is preferably employed in at least the quantity necessary to combine with the halogen liberated from the halohydrin and usually is employed in excess. The resulting products may contain terminal epoxy groups, or terminal epoxy groups and terminal primary hydroxyl groups. The terminal epoxy groups are usually in excess of the terminal primary hydroxyl groups.

Representative polyhydric phenols include resorcinol, hydroquinone, catechol, phloroglucinol, and various bisphenols resulting from the condensation of phenol with aldehydes and ketones, such as p,p'-dihydroxy diphenyl dimethyl methane (bis-phenol, A), p, p' dihydroxy 1, 1' dinaphthyl methane, polyhydroxy naphthalenes and anthracenes, o,o',p,p'-tetrahydroxy diphenyl dimethyl methane, p-hydroxy phenyl p-hydroxy m-(p-hydroxy phenyl) phenyl dimethyl methane, and the like. Epichlorohydrin is the preferred halohydrin.

The molecular weight of the epoxy resins may be controlled by the relative portions of the reactants as well as by the extent to which the reaction is carried out. Thus it is possible to produce resins varying from a viscous taffy-like material to a hard, horny solid. Moreover, variations of epoxy resins may be obtained by employing substituted polyhydric phenols or polyfunctional halohydrins as starting materials. All of the epoxy resins are soluble in solvents such as acetone, methyl ethyl ketone, methyl isobutyl ketone, diacetone alcohol, cyclohexanone, and the like.

The epoxy resins may be readily hardened or cured to an insoluble, infusible state by further reaction of the epoxy and hydroxyl groups with cross-linking agents including diamines or polyamines such as metaphenylene diamine, diethylene triamine, and the polyethylene polyamines; diisocyanates, such as methylene bis-(4 phenyl) isocyanate; dialdehydes, such as glyoxal; dimercaptans; amides and polyamides, such as those disclosed in U. S. 2,705,223. If desired, the epoxy resin may be modified by reaction with materials such as 2,3-epoxy-1-propanol

3

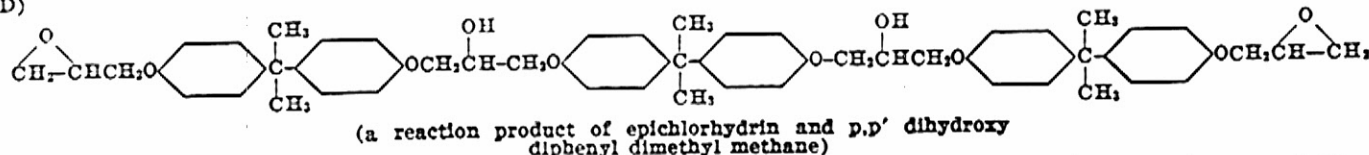
before adding the hardener. The coatings applied to the synthetic resin surfaces in accordance with this invention are the cured or hardened epoxy resins.

It is often desirable to pretreat the plastic substrate in order to promote enhanced adherence of the coating or lining material. In U. S. Reissue Patent 24,062 to Horton, it is disclosed that improved adherence of polar compounds to polyethylene may be effected by treating the surface to be printed, lined or coated with a solution of sulfuric acid and a dichromate. U. S. Patents 2,715,075, 2,715,076 and 2,715,077 to Wolinski disclose that desired surface modification may be obtained by treatment with ozone, nitrous oxide or mixtures of the two. Suitable surface modification also may be obtained by flame treating the surface to be printed, coated or lined, such as shown in U. S. Patents 2,632,921 and 2,704,382 to Kreidl. All of these treatments involve the oxidation of the plastic surface and, in many instances, the conversion of an initially hydrophobic surface to a hydrophilic surface.

The epoxy resin of the invention is preferably applied to the surface to be lined or coated in an uncured state, dissolved in a suitable solvent such as toluene, methyl

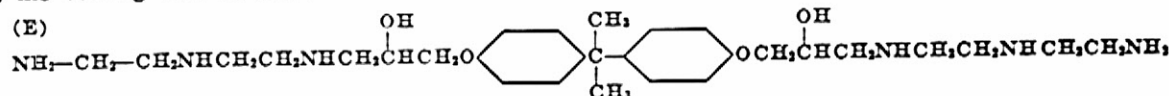
ethyl ketone, and the like. The coating may be applied by conventional techniques, such as by spraying, or manually by at least partially filling the bottle followed by suitable manipulative and draining steps to insure the application of an even coating to the interior surface. If the coating is applied to the exterior surface of the article, it need simply be immersed in a bath of the coating material and allowed to drain. Exterior coatings may, of course, be applied by spraying techniques. The cured coating or lining is then produced in situ by subjecting

(D)



the coated article to a curing temperature for a period of time necessary to produce the desired chemical reaction. Desirably, the coating will be cured at a tem-

(E)



perature of 190–220° F. for a period of at least a half hour. Shorter periods of time may obviously be employed with higher curing temperatures. The curing time and temperature will also be varied by the amount and type of catalyst or hardening agent employed. If desired, the lined or coated objects may be allowed to stand for an extended period, e. g., twenty-four to seventy-two hours at room temperature prior to being cured at higher temperature, thus reducing the time required for the advanced temperature curing operation. The softening point of the plastic being coated generally constitutes the upper limit of the curing temperature and for unmodified polyethylene this upper limit is about 220° F.

In the accompanying drawing illustrative embodiments of the invention are presented.

Fig. 1 is an elevational view of a conventional "Boston

4

round" polyethylene bottle 10 which has not been modified in accordance with the invention.

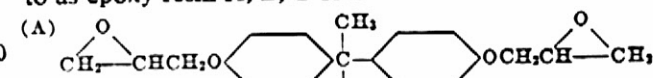
Fig. 2 is a sectional view of a similar polyethylene bottle 10 having a continuous external coating 11 of a cured epoxy resin.

Fig. 3 is a sectional view of a similar polyethylene bottle 10 having a continuous internal lining 12 of a cured epoxy resin.

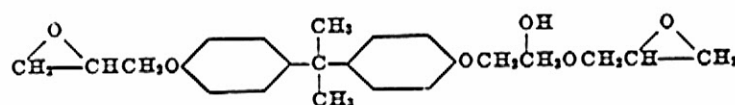
Fig. 4 is a sectional view of a similar polyethylene bottle 10 having both a continuous exterior coating 11 and a continuous interior lining 12 of a cured epoxy resin.

Having generally described the invention, the following examples are presented for purposes of illustrating various embodiments thereof.

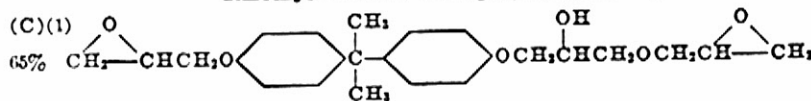
Unless otherwise identified, the following uncured epoxy resins were employed in the examples and will be referred to as epoxy resin A, B, C or D.



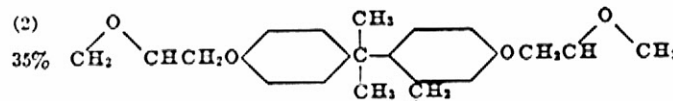
(a reaction product of epichlorohydrin and p,p' dihydroxy diphenyl dimethyl methane)



(a reaction product of epichlorohydrin, p,p' dihydroxy diphenyl dimethyl methane and epichlorohydrin alcohol)



65%



35%

40

(a reaction product of epichlorohydrin and dimethyl, p-hydroxy phenyl, p-hydroxy-o-(p-hydroxy benzyl) phenyl methane)

Unless otherwise identified, the following cross-linking (hardening) agent was employed in the examples and will be referred to as hardener E.

Example 1

Epoxy resin B and hardener E were mixed in a 3:2 ratio and thinned with methyl ethyl ketone to a solids content of 70%. The interior surfaces of four ounce Boston round polyethylene bottles were manually coated with this material. The liners were cured at 160° F. for sixty minutes. A portion of these bottles were recoated and cured for an additional twelve hours. The bottles were then filled with carbon tetrachloride and allowed to stand for eight days at room temperature. The single-lined bottles showed an average per day loss of 0.096 gram, while the double-lined bottle showed an average loss of 0.005 gram per day. Similar uncoated bottles showed a loss of 3.49 grams per day.

5

Example 2

Epoxy resin B and hardener E were admixed in a 4:1 ratio and thinned with methyl ethyl ketone to produce a coating "X" having a percent solids of 70%. Coating "Y" was prepared by admixing epoxy resin A with hardener E in a 4:1 ratio, and thinned with methyl ethyl ketone to 70% solids. Four ounce Boston round polyethylene bottles were interiorly lined with each of these coating mixtures and cured until an adherent coating was obtained. These bottles were filled with carbon tetrachloride and stored for eight days at room temperature. The bottles coated with the "X" mixture exhibited an average loss per day of from 0.022 to 0.296 gram per day, while the bottles coated with the "Y" mixture exhibited an average loss of 0.014 and 0.039 gram per day. The weights of the liners ranged between 0.616 to 2.445 grams. The uncoated bottles showed a loss of 3.49 grams per day.

Example 3

Four ounce Boston round polyethylene bottles were lined using a 3:1 ratio mixture of epoxy resin A and hardener E thinned with methyl ethyl ketones to 70% solids. The linings were cured at 140° F. for 12-14 hours. The bottles were filled with carbon tetrachloride and stored at 70° F. for thirty-six days. The lined bottles showed a loss of 0.012 to 0.015 gram per day as compared to a loss of 4.4 grams per day for the unlined bottles employed as a control. The liner weights ranged from 1.266 to 1.408 grams.

Example 4

Quart polyethylene bottles were lined with a mixture of epoxy resin A and hardener E admixed in a 3:1 ratio. Weights of the liners ranged from 10-11 grams. After the linings were cured for fourteen hours at 140° F., individual bottles from this group and unlined control bottles were filled with carbon tetrachloride, hexane and toluene. These bottles were stored for 153 days at 70° F. with the following results:

WEIGHT LOSSES IN GRAMS AFTER 153 DAYS AT 70° F.

	Lined Bottles		Control Bottles, Grams Per Day
	After 153 Days	Grams Per Day	
Carbon Tetrachloride.....	32	0.21	8.0
Hexane.....	22	0.15	5.06
Toluene.....	19	0.13	5.40

The test with the bottles containing toluene was continued for a total of 540 days, at which time the bottles showed no signs of collapse.

Example 5

In order to determine the effect of the concentration of the epoxy resin in the coating solution, the resin mixture of Example I was diluted with 25, 50 and 75% of its volume with methyl ethyl ketone. Four ounce Boston round polyethylene bottles were interiorly coated with these coating solutions and the coatings were cured for from 12 to 14 hours at 140° F. Bottles were tested for permeability at room temperature for forty days, with the organic solvents listed in the table below:

WEIGHT LOSSES PER DAY (GRAMS)

	25%	50%	75%	Unlined
Carbon Tetrachloride.....	0.026	0.017	0.224	3.49
Toluene.....	0.008	0.026	0.852	2.79
Hexane.....	0.006	0.054	0.020	1.00

It will be seen from the above table that while effective reduction in permeation was effected at all concentrations of epoxy resin, there was a general increase in permeation

6

as the concentration of epoxy resin was decreased in the coating solution.

Example 6

A coating composition was produced by admixing four parts of epoxy resin A and one part of meta-phenylene diamine. A portion of this composition was modified by addition of three parts of plasticizer (2,3-epoxy-1-propanol). Four ounce Boston round polyethylene bottles were interiorly coated with the unplasticized and plasticized compositions, and the coatings were cured until adherent linings were obtained. Bottles from each group were filled with toluene and hexane and stored at room temperature for eight days with the following results:

WEIGHT LOSS PER DAY (GRAMS)

	Non-Plasticized Liner	Plasticized Liner	Unlined Control
Toluene.....	0.0014	1.599	2.79
Hexane.....	0.002	1.04	1.00

From these data, it is apparent that while the plasticized liner does reduce permeability, it is not as effective as the unplasticized liner.

Example 7

A coating composition was prepared by admixing four parts of epoxy resin C and one part of hardener E. This mixture was diluted with methyl ethyl ketone to produce a composition containing 70% solids. The interior surfaces of four ounce Boston round polyethylene bottles were coated with this material and the coatings were cured at 140° F. for 12 hours. These bottles were tested for permeability by various organic solvents at 70° F. for the indicated number of days and with the results shown in the following table:

WEIGHT LOSS PER DAY (GRAMS)

	Weight of Liner	27 Days	56 Days	Unlined Control
Toluene.....	1.380	0.014	0.0144	2.79
Hexane.....	1.246	0.0098	0.0109	1.00
Acetone.....	1.234	0.0036	0.0144	0.039
Ethyl Acetate.....	1.419	0.0020	0.0013	0.095
Carbon Tetrachloride.....	1.490	0.0050	0.0151	3.49

Example 8

In order to determine the effect of a hardener upon the permeability of the cured epoxy resin coating, epoxy resin C and hardener E were admixed in ratios of 4:1, 6:1 and 8:1 and in each case the mixture was thinned with methyl ethyl ketone to obtain a solids concentration of 75%. Four ounce Boston round polyethylene bottles were interiorly coated with each composition. Curing times were varied as indicated in the table below:

	4-1 140° F.— 60 hrs. 65 days	6-1 160° F.— 12 hrs. 54 days	8-1 160° F.— 12 hrs. 65 days
Epoxy and hardener ratio.....			
Curing temperature time.....			
Length of Test—70° F.....			
Weight loss—Grams per day:			
Toluene.....	0.0024	0.0148	0.0058
Acetone.....	0.0059	0.0308	0.0302
Ethyl Acetate.....	0.0027	0.0012	0.0598
Carbon Tetrachloride.....	0.0043	0.0164	0.0162

These results indicate that, in general, permeability increases as the amount of hardener is decreased.

Example 9

A coating composition was produced by admixing nine parts of epoxy resin B, three parts of hardener E and twenty-one parts of urea-formaldehyde resin.¹ This

¹ An alcoholic type urea-formaldehyde resin in an intermediate stage of condensation in a 60% solution of xylol-butanol (1:1.5).

7

mixture was thinned with methyl ethyl ketone to a concentration of 80% solids and the interior surfaces of polyethylene bottles were coated. The coating was cured for twelve hours at 160° F. When these bottles were filled with benzene and tested for permeability at room temperature for a period of twelve days, an average loss per day of 0.004 grams was obtained. The cured liner was flexible and adapted for use in squeeze bottle-type containers.

Example 10

A coating mixture was prepared by admixing six parts of epoxy resin B and one part of a hardener which is the product of the reaction of 2 moles of acrylonitrile and 1 mole of diethylenetriamine. This mixture was diluted with methyl ethyl ketone to a solids concentration of 70%. This composition was kept at room temperature for twenty-four hours and interior surfaces of polyethylene bottles were then coated. The coatings were cured at 160° F. for one hour. The weight of the liners obtained ranged between 0.604 and 0.658 grams. The liners were tested for permeability at room temperature for twenty-six days with carbon tetrachloride, toluene and ethyl acetate with the following results:

	Weight loss per day (grams)
Carbon tetrachloride.....	0.0067
Toluene	0.0024
Ethyl acetate.....	0.0098

The results of this example indicate that the epoxy coating compositions are characterized both by long pot life and desirably short high temperature curing times.

Example 11

A coating composition was prepared by admixing 4.6 parts of epoxy resin B, 2.7 parts of a polyamide² and 1.0 part of hardener E. This mixture was thinned with methyl ethyl ketone to a solids content of 90% and the interior surfaces of polyethylene bottles were coated. Coatings were cured at 190° F. for one hour. A flexible liner of reduced permeability was obtained.

Example 12

Eight parts of epoxy resin C and one part of hardener E were admixed and the resinous mixture was thinned with varying amounts of toluene to obtain various liner weights in the cured product. The interior surfaces of four ounce, Boston round polyethylene bottles were coated with these mixtures and the coatings were initially cured for 16 to 18 hours at 120° F. The temperature was then raised to 190° F. for an additional 90 minutes. Permeability tests were made and the results are noted below:

GRAMS PER DAY WEIGHT LOSSES OF LINED BOTTLES AT 70° F.

	Control	Liner Weights—Grams		
		0.831-0.874	0.502-0.594	0.172-0.195
Toluene.....	2.79	0.87	1.31	2.68
Hexane.....	1.00	0.086	0.085	0.22
Carbon tetrachloride...	3.49	0.037	0.104	0.026

Example 13

A coating composition was prepared from four parts of epoxy resin C, one part of hardener E and one part of styrene oxide. The mixture was thinned with methyl ethyl ketone to a solids concentration of 70%. The interior surface of four ounce, Boston round polyethylene bottles were coated and the coatings were cured from two to seventeen hours at 160° F. A reduction in permeation of toluene and carbon tetrachloride was obtained. Moreover, the addition of the styrene oxide increased the flexibility of the cured liners.

² The reaction product of polymeric fat acids containing at least 2 carboxyl groups and diethylene triamine.

8

Example 14

Strips of polystyrene were dipped in the coating composition of Example 13 and allowed to dry and cure at room temperature overnight. The strips could be flexed without cracking the coating. The strips were immersed in ethyl acetate, acetone, carbon tetrachloride and toluene without visible effect on either the coating or the polystyrene. Uncoated polystyrene strips dissolve in the solvents employed.

Example 15

Two ounce polymethylene (Koppers' 6200 Super Dylan) bottles were blown and were lined as in Example 1. The bottles were filled with a perfume containing 96 parts of 95% 39C. alcohol and 4 parts of an essential oil (Dodge & Oleott—40-R-5291). The filled bottles were then fitted with aerosol caps and Freon (Du Pont F114 and F12 80/20) was introduced through the cap valve until a gauge pressure of 25 p. s. i. was obtained. The filled bottles were stored at 73° F. and 50% relative humidity for 30 days. An average daily weight loss of only .0014 gram was observed.

Example 16

A bottle lining solution was prepared by mixing 10 parts of epoxy resin B, 1 part of epoxy resin D and 1.1 parts of hardener E. The mixture was dissolved in methyl ethyl ketone and additional solvent was added until 35% by weight of the mixture was methyl ethyl ketone. Polyethylene bottles were lined and the linings were cured at 160° F. for one hour. Several bottles were filled with each of n-hexane, ethyl acetate, carbon tetrachloride and toluene. Weight losses per day during storage at 73° C. were as follows:

	Grams
n-Hexane	0.011
Ethyl acetate	0.003
Carbon tetrachloride	0.020
Toluene	0.008

From the foregoing examples, it is apparent that the coating of the surface or the lining of a container or bottle with a cured epoxy resin will result in greatly decreased permeation of the article or container by many of the commercially employed fluids. Moreover, the coated surfaces of the invention are additionally beneficial in preventing passage of gases, such as oxygen, through the plastic substrate. Consequently, synthetic resin, and particularly polyethylene, containers and bottles may be satisfactorily employed as containers for such materials or compositions containing these materials when the containers are lined with a cured epoxy resin in accordance with the present invention.

It is beneficial to irradiate the lining or coating solution during the curing procedure. Not only does irradiation accelerate the normal cross-linking reaction but often effects a graft polymerization whereby the epoxy and/or hardening agent is chemically combined with the substrate, thus greatly enhancing the adherence of the coating or lining to the substrate.

Although in the examples particular emphasis has been placed on the popular polyethylene bottle and, to a lesser extent, polystyrene containers or articles, it is intended that this invention also broadly include the application of a coating or lining of a cured epoxy resin to surfaces of other synthetic resinous articles which are permeable to organic fluids such as carbon tetrachloride, hexane, acetone, benzene, toluene, and the like. The invention is broadly applicable to plastic articles or containers fabricated from all types of thermo-plastic or thermo-setting resins. More specifically, the invention is applicable to articles or containers fabricated from such materials as polyethylene, including conventional polyethylene and the so-called new type low temperature polyethylene, such as Ziegler polyethylene, polymethylene or polyethylene

substantially free of branched chains, polyethylene terephthalate, polytetrafluorethylene, nylon, acetate copolymers, ethylene-polyvinyl acetate copolymers, coumarone resins; indene resins; acetylene polymers, including their halogenated derivatives; polymers of olefin hydrocarbons other than ethylene, including polymers of isoprene, butadiene and their homologues, and halogen-substituted derivatives thereof; olefin-sulfur dioxide resins; phenol-aldehyde resins; aldehyde resins; furfural resins; ketone resins; urea-formaldehyde, type resins; including thiourea-formaldehyde, melamine formaldehyde, and dicyandiamide-formaldehyde resins; amine-aldehyde resins; sulfonamide-aldehyde resins; nitro resins; resins from such nitrogen-containing materials as hydrazine and related substances, pyrazoles, pyridine, quinoline, pyrrole, indole and carbazole; condensation polyester resins, including resins obtained from polyhydric alcohols and polybasic acids, and from hydroxy acids; polyamide resins and derivatives thereof; mixed polyester-polyamide resins; polyether resins; polyvinyl ethers; polyvinyl alcohols; polyvinyl esters; rubber and its derivatives; cellulose esters and cellulose ethers. All of these plastic materials may be used with any of the usual modifying agents including plasticizers, pigments, fillers, dyes and materials which combine chemically with the polymer ingredients either during formation of the polymer or during an after treatment. Thus, surfaces and containers fabricated from copolymers, interpolymers and mixtures of polymers may be advantageously rendered less permeable to organic fluids by application of a coating or lining of a cured epoxy resin.

As indicated, containers or bottles may, in accordance with the invention, be coated or lined on either the interior or exterior surfaces or both. Where the problem involved is merely the prevention of moisture from entering the product to be packaged or to prevent gases from the atmosphere from contacting the contents of the container, an external impermeable coating is satisfactory. However, from the standpoint of the permeation of a liquid within a container outwardly through the container walls, it is greatly preferred to employ an interior lining or coating. Moreover, with an external coating, an ingredient of the fluid content may be essential, although quantitatively small, and consequently such ingredient may be lost by absorption in the container wall even though the ingredient does not escape from the bottle itself. This latter situation is especially important where the containers are employed for skin lotions, perfumes, and the like, in which the essential oil fraction governing the perfume odor is relatively small. Accordingly, despite the proportionally greater difficulty of applying a lining to the container's interior, the advantages of such an inner lining are such that it is preferred. In some instances it may be desirable to apply both an interior and exterior lining.

The mechanical method of applying the coating or lining to the container surfaces are well known to the art and do not constitute a part of the present invention. Specific details of the operation and functioning of spray coating units may be found in Paasche Patents 2,547,884, 2,059,706 and 2,069,844.

Since modifications of the disclosed invention will be apparent to those skilled in the art, it is intended that the invention be limited only by the scope of the appended claims.

We claim:

1. A synthetic resin article having a surface characterized by enhanced resistance to permeation by organic fluids, said surface having an adherent coating of a cured epoxy resin.

2. A synthetic resin article having a surface characterized by enhanced resistance to permeation by organic fluids, said surface having an adherent coating of the cured reaction product of a polyfunctional halohydrin and a polyhydric phenol.

3. A synthetic resin article having a surface characterized by enhanced resistance to permeation by organic fluids, said surface having an adherent coating of the reaction product of a polyfunctional halohydrin-polyhydric phenol condensate and a polyamine.

4. A synthetic resin article having a surface characterized by enhanced resistance to permeation by organic fluids, said surface having an adherent coating of the reaction product of a polyfunctional halohydrin-polyhydric phenol condensate and a polyamide.

5. A synthetic resin article having a surface characterized by enhanced resistance to permeation by organic fluids, said surface having an adherent coating of the reaction product of an epichlorhydrin bis-phenol condensate and a polyamine.

6. A synthetic resin article having a surface characterized by enhanced resistance to permeation by organic fluids, said surface having an adherent coating of the reaction product of an epichlorhydrin bis-phenol condensate and a polyamide.

7. A polyethylene container having a surface characterized by enhanced resistance to permeation by organic fluids, said surface having an adherent coating of a cured epoxy resin.

8. A polyethylene container having a surface characterized by enhanced resistance to permeation by organic fluids, said surface having an adherent coating of the cured reaction product of a polyfunctional halohydrin and a polyhydric phenol.

9. A polyethylene container having a surface characterized by enhanced resistance to permeation by organic fluids, said surface having an adherent coating of the reaction product of a polyfunctional halohydrin-polyhydric phenol condensate and a polyamine.

10. A polyethylene container having a surface characterized by enhanced resistance to permeation by organic fluids, said surface having an adherent coating of the reaction product of a polyfunctional halohydrin-polyhydric phenol condensate and a polyamide.

11. A polyethylene container having a surface characterized by enhanced resistance to permeation by organic fluids, said surface having an adherent coating of the reaction product of an epichlorhydrin bis-phenol condensate and a polyamine.

12. A polyethylene container having a surface characterized by enhanced resistance to permeation by organic fluids, said surface having an adherent coating of the reaction product of an epichlorhydrin bis-phenol condensate and a polyamide.

13. A polyethylene bottle of increased resistance to permeation by organic fluids, at least one surface thereof being pretreated to promote adhesion of polar compounds having a strongly adherent coating comprising a cured epoxy resin.

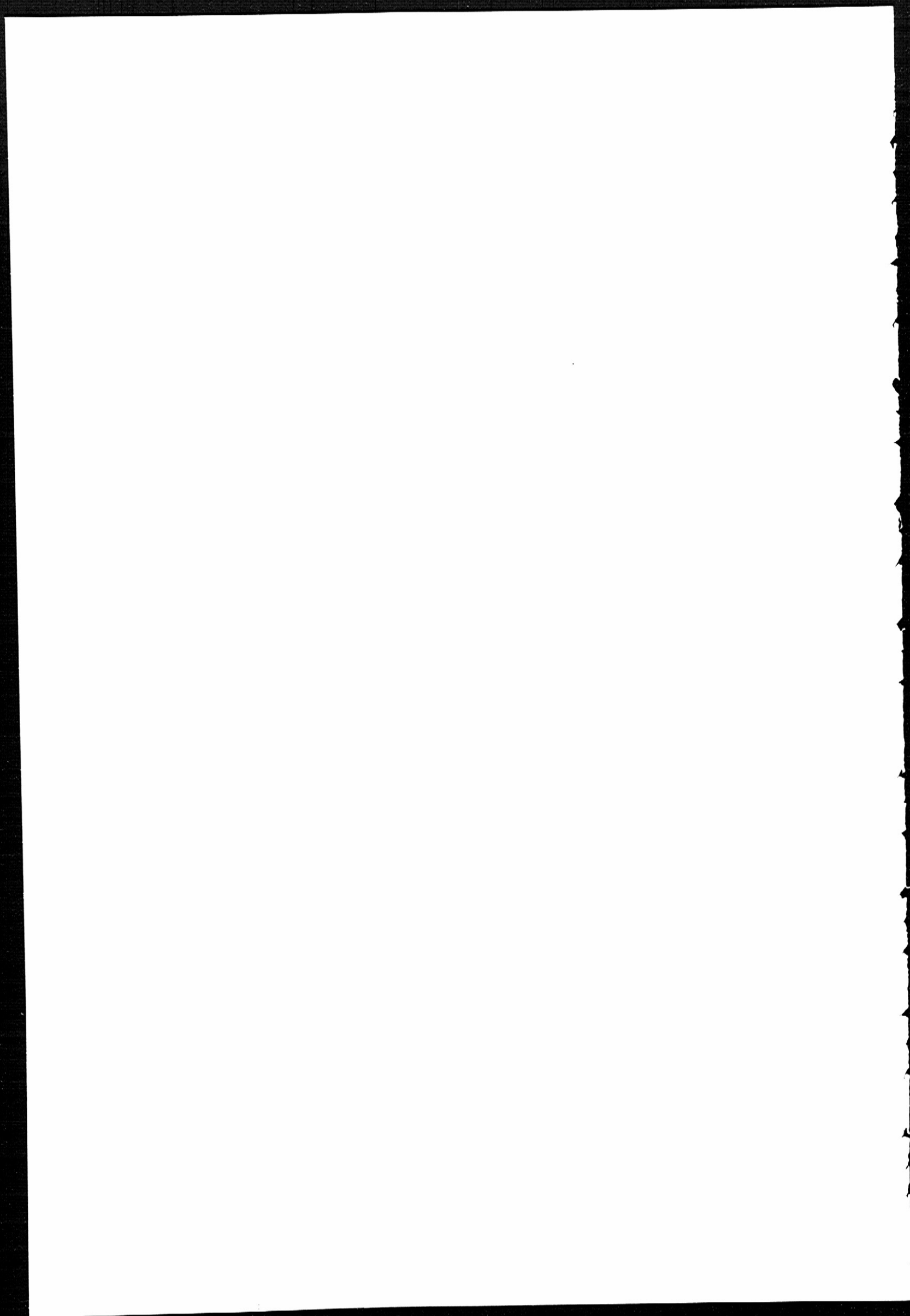
14. A polyethylene bottle of increased resistance to permeation by organic fluids, at least one surface thereof being hydrophilic and having a strongly adherent coating comprising the cured reaction product of a polyfunctional halohydrin and a polyhydric phenol.

15. A polyethylene bottle of increased resistance to permeation by organic fluids, at least one surface thereof being oxidized and having a strongly adherent coating comprising the reaction product of a polyfunctional halohydrin-polyhydric phenol condensate and a polyamine.

References Cited in the file of this patent

UNITED STATES PATENTS

70	739,514	Street	Sept. 22, 1903
	2,091,723	Sterino	Aug. 31, 1937
	2,324,483	Castan	July 20, 1943
	2,491,947	Bardash	Dec. 20, 1949
75	2,622,598	Rosenblum	Dec. 23, 1952



[Filed September 25, 1964]

**PLAINTIFFS' MOTION FOR
PRELIMINARY INJUNCTION**

The Plaintiffs herein move the Honorable Court for a temporary injunction under Rule 65(a) and (d) of the Federal Rules of Civil Procedure to restrain and enjoin Edward J. Brenner, Commissioner of Patents of the United States Patent Office from issuing a patent to Defendants Kamp et al based on their application for United States patent Serial No. 578,846, filed April 17, 1956 containing counts 1 and 2 of Interference No. 91,682 which correspond to claims 1 and 7 of Pinsky et al patent 2,830,721. As set forth in the accompanying affidavit by W. L. Benedict, it has been and is the practice of the Commissioner of Patents to issue patents on applications to a successful party in an interference before the Board of Interference Examiners despite the fact that the matter may be under review by this Court.

Plaintiffs request that the Court set this matter for hearing on such a day and at such an hour as the Court may appoint and in due course after such hearing Plaintiffs' motion be granted and an order restraining and enjoining the Commissioner of Patents in accordance with this motion be duly issued.

Respectfully submitted,

BURNS, DOANE, BENEDICT,
SWECKER & MATHIS

By /s/ Wayne L. Benedict

[Certificate of Service
25 September 1964]

**AFFIDAVIT SUPPORTING MOTION FOR
TEMPORARY INJUNCTION**

The undersigned, W. L. Benedict, states that he is an attorney for the Plaintiffs herein;

That the facts alleged in the Complaint filed September 25, 1964 are true to the best of his knowledge and belief.

That he has been informed by the Deputy Solicitor of the United States Patent Office that it is the practice of the Patent Office to continue the ex parte prosecution of an application for patent after the Board of Interference Examiners of the Patent Office has awarded priority in an interference to the applicant, and to issue a patent to said prevailing applicant regardless of the fact that the losing party has brought an action to review the decision of the Board under the provisions of 35 U.S.C. 146, as is here the case. Affiant was informed that this practice prevails whether the interference involves only pending applications, or involves a patent and a pending application for patent. Section 1109.01 of the Manual of Patent Examining Procedure, at page 193, a copy of which was appended as Exhibit B of the Plaintiffs' Complaint under 35 U.S.C. 146 supports this statement. As to the practice between pending applications, see the decision of the Court of Appeals for the District of Columbia, Monaco et al v. Watson, 270 F(2d) 335.

Pinsky et al, through the undersigned, has petitioned the Commissioner of Patents to withhold the issuance of a patent to Kamp et al pending a final adjudication in this litigation. No decision has been received. A copy of the Petition is appended hereto as Exhibit A.

/s/ Wayne L. Benedict

/t/ W. L. Benedict

DISTRICT OF COLUMBIA)
) ss
CITY OF WASHINGTON)

JA.13

SUBSCRIBED AND SWORN to this 25th day of September, 1964.

/s/ Frances C. Marcellin
Notary Public

(Seal)

My Commission Expires March 31, 1967

IN THE UNITED STATES PATENT OFFICE
BEFORE THE EXAMINER OF INTERFERENCES

PINSKY ET AL)	
)	
v.)	Interference No. 91,682
)	
KAMP ET AL)	

PETITION TO THE COMMISSIONER

Now comes the party Pinsky et al through the undersigned attorney and petitions the Honorable Commissioner of Patents to withhold the issuance of a patent containing the Counts 1 and 2 of the above identified interference, which are claims 1 and 7 of the Pinsky et al patent 2,830,731 pending a review thereof under 35 U.S.C. 146.

The above interference was declared and after final hearing before the Board of Interference Examiners the Defendants Kamp et al were awarded priority on the basis of a filing date in Germany of April 22, 1955 which was prior to the filing date by Pinsky et al. The decision of the Board was dated June 29, 1964.

On August 27, 1964 Pinsky et al timely filed notice of an appeal from the decision of June 29, 1964 to the Court of Customs and Patent Appeals in accordance with 35 U.S.C. 141 giving reasons of appeal as provided by 35 U.S.C. 142.

On August 28, 1964 Paul M. Craig, Jr. as attorney for Kamp et al filed notice with the Commissioner of Patents of Kamp et al's election to conduct all further proceedings under 35 U.S.C. 146.

To obtain a review of the adverse decision, Pinsky et al must now file a complaint in the United States District Court under the provisions of 35 U.S.C. 146 and such complaint has been or will be filed within the time allowed under the law.

While the practice in the Patent Office is to withhold issuance of a patent to a successful applicant pending a losing party's appeal to the Court of Customs and Patent Appeals, the practice is different with respect to actions under 35 U.S.C. 146.

Since the Commissioner has duly and legally issued the presumptively valid Pinsky et al patent, there exists no constitutional and statutory power to issue a second patent to Kamp et al containing claims 1 and 7 of the Pinsky et al patent (Counts 1 and 2 of the Interference) until such time as there is a final judgment adverse to Pinsky et al from which no appeal or other review has been or can be taken or had, and until all other requirements of the law have been met by Kamp et al. Issuance of a second patent to Kamp et al containing the counts of the interference would be premature and would result in there being two subsisting and presumptively valid patents of identical scope containing identical claims and to which identical rights attach which may be independently exercised by the respective patentees since cancellation of claims 1 and 7 of the Pinsky et al patent under 35 U.S.C. 135 cannot take place until final adjudication of this cause. This is a matter of concern to the public as well as to the parties hereto. The case of Monaco et al v. Watson, 270 F (2d) 335 involved two pending applications and is not here controlling.

The Petitioners therefore pray that the Commissioner withhold the issuance of a patent to Kamp et al based on application Serial No. 578,846 and containing claims 1 and 7 of the Pinsky et al patent 2,830,721 (Counts 1 and 2 of the Interference) until and unless a final determination of the

issues in the review of the interference proceedings establish that Kamp et al are entitled to judgment of priority in their favor and are entitled to have a patent containing said claims issued to them.

Respectfully submitted,

PINSKY ET AL

By /s/ Wayne L. Benedict
Attorney

September 22, 1964
Washington, D. C.

[Certificate of Service]

U.S. DEPARTMENT OF COMMERCE
PATENT OFFICE
WASHINGTON

September 28, 1964

Interference No. 91,682)	
)	
Pinsky et al)	Petition
v.)	
Kamp et al)	

This is a petition requesting that the issuance of a patent on the Kamp et al application here-involved be withheld pending final determination of an action under 35 U.S.C. 146 seeking a review of the decision of the Board of Patent Interferences.

As is recognized in the petition, it is not the practice of the Patent Office to withhold issuance of a patent under circumstances such as are here-involved, and this policy was sustained by the United States Court of appeals for the District of Columbia Circuit in the case of Monaco et

al v. Watson, 270 F.2d 335 referred to in the petition. It is the petitioners' contention that the fact that the unsuccessful party in this interference is a patentee deprives the Commissioner of statutory authority to issue a patent to the successful party. However, the authority for such issuance is clearly stated in 35 U.S.C. 135, and is in no way dependent on whether the unsuccessful party is a patentee. The reasons advanced in the petition have been carefully considered but are not found to be sufficient to justify an exception from the settled practice above referred to. It may be noted that any patent issued after a decision of the Board of Patent Interferences and prior to final determination of an action under 35 U.S.C. 146 may eventually turn out to be invalid and that this circumstance is independent of the status of the party successful before the Board whether he be an applicant or patentee.

The petition is denied.

EDWIN L. REYNOLDS
First Assistant Commissioner

Burns, Doane, Benedict,
Swecker & Mathis
850 Munsey Bldg.
Washington 4, D. C.

(for Pinsky et al)

Paul M. Craig, Jr.
915 Pennsylvania Bldg.
425 - 13th St., N. W.
Washington 4, D. C.

(for Kamp et al)

[Filed September 30, 1964]

SUPPLEMENTAL MOTION FOR
PRELIMINARY INJUNCTION

Attached hereto is a copy of a paper dated September 28, 1964 in which the Defendant, Commissioner of Patents, through his First Assistant has denied Plaintiffs' Petition to withhold issuance of a patent on the Kamp et al application pending final determination of this action under 35 U.S.C. 146.

The Commissioner refused to recognize any difference between the fact situation of the Monaco et al v. Watson decision, 270 F.2d 335, which involved two applications for patent, and the present situation wherein a patent has already issued to the Plaintiffs herein. The Defendant has failed to recognize that the simultaneous subsistence of patents containing identical claims during an indefinite period pending a final determination is a matter of public concern as well as of concern to the parties. Without going into the merits of the Monaco et al case, Plaintiffs invite the Court's attention to Judge Burger's dissenting opinion in that case which applies with compelling force to a situation involving a patent and an application in which the patentee has lost before the Patent Office. After stating that he could see no differences for purpose of interim jurisdiction between an appeal to the C.C.P.A. under 35 U.S.C. 141 and a suit for review in the District Court under 35 U.S.C. 146, Judge Burger stated as follows:

"The statute which the Commissioner contends compels him to issue the patent without delay, 35 U.S.C. § 135, had an exact counterpart in force when the CCPA decided In re Allen. Rev. Stat. § 4904, as amended 53 Stat. 1212 (1939). This statute clearly makes no distinction between the two routes for review, nor does reason suggest why any such distinction should be made."

—Quoting Monaco et al v. Watson
270 F.2d 335, 337

Plaintiffs urge that this should be the law of this case.

Plaintiffs sought relief by appeal to the CCPA but was forced by the Defendants Kamp et al to proceed under Section 146. Had Plaintiffs been permitted to stay in the CCPA, no patent would have issued. Having this recourse denied them, they are faced with immediate issuance of a patent to Kamp et al thereby, as is clearly brought forth in the pleadings, bringing about a situation in which there are two subsisting patents containing identical claims and to which identical rights attach until one or the other of them at some unforeseeable time in the future is finally adjudged the victor. This creates an intolerable situation. If the Commissioner of Patents is correct that Section 35 U.S.C. 135 is authority for issuing the patent and is in no way dependent on whether the unsuccessful party (in the Patent Office) is a patentee, then that portion of Section 135 authorizing such issuance is clearly unconstitutional and should be so declared under the general relief sought in the Bill of Complaint under 35 U.S.C. 146.

In any event, the Commissioner of Patents and, to any extent necessary, the other Defendants, should be restrained and enjoined from issuing a patent to Kamp et al containing the counts of the interference, claims 1 and 7 of the Pinsky et al patent, at least until there has been a final determination on Plaintiffs' Motion for a Preliminary Injunction and this Supplemental Motion.

Plaintiffs so move the Court and additionally pray that this Supplemental Motion be set for hearing together with Plaintiffs' original motion filed with the Complaint.

Respectfully submitted,

BURNS, DOANE, BENEDICT, SWECKER & MATHIS

By /s/ Wayne L. Benedict

[Certificate of Service
30 September 1964]

[Filed October 6, 1964]

OPPOSITION TO "PLAINTIFFS' MOTION FOR PRELIMINARY
INJUNCTION" AND THEIR "SUPPLEMENTAL
MOTION FOR PRELIMINARY INJUNCTION"

Now comes the defendant, Edward J. Brenner, Commissioner of Patents, and opposes plaintiffs' motion for a preliminary injunction identified with the above-entitled civil action and likewise their supplemental motion for preliminary injunction.

An oral hearing is requested.

Respectfully submitted,

/s/ C. W. Moore

Solicitor, United States Patent Office
Attorney for Defendant,
Edward J. Brenner,
Commissioner of Patents

October 5, 1964

POINTS AND AUTHORITIES

1. The grant of a preliminary injunction is never to be indulged in except in a clear case demanding it.

General Electric Company v. American Wholesale
Company (CA 7), 235 F.2d 606.

2. In the absence of a showing that plaintiffs will otherwise suffer irreparable injury, their motions for a preliminary injunction should be denied.

Sims v. Greene (CA 3), 161 F.2d 87.

Foundry Services, Inc. v. Bene-Flux Corporation
(CA 2), 206 F.2d 214.

Allen et al. v. Pyrene Mfg. Co. et al. (DC NJ),
111 F.Supp. 819.

3. In objecting to the issuance of a patent to defendants, Ernst Kamp and Karl Jahn, on their application, Serial No. 578,846, filed April 17, 1956, containing claims corresponding to counts 1 and 2 of Interference No. 91,682, and likewise corresponding to claims 1 and 7 of plaintiffs' patent, No. 2,830,721, plaintiffs proffer no showing that they will suffer irreparable injury from the issuance of such a patent.

4. The Commissioner's denial, by the First Assistant Commissioner, of plaintiffs' petition (Exhibit A to plaintiffs' initial motion), as shown in the photocopy attached to plaintiffs' supplemental motion, and his consequent refusal to withhold the issuance of such a patent, was made in the exercise of the discretion given to the Commissioner by 35 U.S.C. 135, and does not constitute any abuse of that discretion. Such a matter of discretion is not open to regulation or control by the Courts as by mandamus or injunction.

Moore v. United States ex rel. Chott, 40 App. D.C. 591.

Anderson v. Watson, 103 U.S. App. D.C. 99, 254 F.2d 956.

5. As stated in the opinion of the First Assistant Commissioner, the policy, of the Patent Office, not to withhold the issuance of a patent to the winning party to an interference when review is sought by the losing party under 35 U.S.C. 146 has the sanction of the United States Court of Appeals for the District of Columbia Circuit. The majority opinion in the cited case is, of course, "the law of this case.

Monaco et al. v. Watson, 106 U.S. App. D.C. 142,
270 F.2d 335, cert. den. 361 U.S. 924.

6. As ruled by the First Assistant Commissioner, the authority in 35 U.S.C. 135 for the issuance of a patent to the successful party to an interference is in no way dependent upon whether the unsuccessful party is a patentee. The cited section of the statute contemplates, in the first sentence, the declaration of an interference (1) between pending applications or (2) between a pending application and any unexpired patent. The cited section equally contemplates, in the second sentence, the possible issuance, upon decision by the Board of Patent Interfer-

ences in interference (1) or interference (2), of "a patent to the applicant who is adjudged the prior inventor."

7. The reported cases include at least one instance, represented in the several decisions cited below, in which the Commissioner issued a patent to the applicant adjudged the prior inventor in an applicant-patentee interference during the pendency of review proceedings under 35 U.S.C. 146, and where there was, hence, "the simultaneous subsistence of patents containing identical claims during an indefinite period pending a final determination." The interference was Interference No. 88,174, and it involved MacKenzie Patent No. 2,697,920 and the application for Knowles Patent No. 2,927,443, issued March 8, 1960. That date of grant is prior to the decision of July 20, 1961, in the proceedings under 35 U.S.C. 146, reported at 130 USPQ 316.

General Foods Corporation v. Knowles (DC Dist. Col.),
120 USPQ 470.

Amerio Contact Plate Freezers, Inc., v. Knowles
(CA DC), 107 U.S. App. D.C. 81, 274 F.2d 590,
124 USPQ 91.

Amerio Contact Plate Freezers, Inc. v. Belt-Ice
Corporation et al. (DC W Wash.), 130 USPQ 315.

Amerio Contact Plate Freezers, Inc. v. Knowles
(DC W Wash.), 130 USPQ 316.

Amerio Contact Plate Freezers, Inc. v. Belt-Ice
Corporation et al. (CA 9), 316 F.2d 459, 137 USPQ 282.

C. W. Moore
Solicitor, United States Patent Office
Attorney for Defendant,
Edward J. Brenner,
Commissioner of Patents

[Certificate of Service
October 5, 1964]

[Filed October 7, 1964]

OPPOSITION TO PLAINTIFFS' MOTION FOR
PRELIMINARY INJUNCTION AND
THEIR SUPPLEMENTAL MOTION FOR PRELIMINARY INJUNCTION

Now comes the defendants, Ernst Kamp and Karl Jahn, and oppose plaintiffs' motion for a preliminary injunction and plaintiffs' supplemental motion for preliminary injunction.

An oral hearing is respectfully requested.

Respectfully submitted,

Paul M. Craig, Jr.
Attorney for Kamp and Jahn

October 7, 1964

[Filed October 15, 1964]

ANSWER

1. Defendants Ernst Kamp and Karl Jahn admit the allegations of paragraphs 1, 4, 5, 7, 8 and 17 of the Complaint.

2. Defendants Kamp and Jahn allege that they are without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraphs 2 and 18 of the Complaint and therefore deny each and every allegation thereof.

3. Defendants Kamp and Jahn deny each and every allegation in paragraphs 3, 6, 9, 12, 13, 19, 20 and 21.

4. Defendants Kamp and Jahn admit the allegations of paragraph 10 of the Complaint that the Commissioner denied plaintiffs' motions to dissolve the interference and granted the motion to shift the burden of defendants Kamp et al but deny that such actions by the Commissioner were erroneous and further deny the other allegations of paragraph 10 of the Complaint.

5. Defendants Kamp et al allege that they are without knowledge or information sufficient to form a belief as to the truth of the allegation in paragraph 11 of the Complaint as regards the assertion of the discovery during Counsel's preparation for taking testimony, and deny

each and every other allegation in paragraph 11 of the Complaint.

6. Defendants Kamp et al admit the allegations of paragraph 14 of the Complaint that the Commissioner, through the Board of Interference Examiners, held plaintiffs confined to their filing date of March 28, 1956 and defendants Kamp et al entitled to priority based on defendants' filing date in Germany on April 22, 1955 but deny that such holding by the Commissioner was erroneous.

7. Defendants Kamp et al admit the allegations of paragraph 15 of the Complaint as regards the filing of Notice of Appeal to the Court of Customs and Patent Appeals but deny such filing was timely and/or in accordance with 35 U.S.C. 141 and/or 142, and further deny each and every other allegation of paragraph 15 of the Complaint.

8. Defendants Kamp et al admit the allegation of paragraph 16 of the Complaint as regards the filing by attorney for defendants of notice with the Commissioner on August 28, 1964 but deny that the Complaint was filed "as a consequence" of such notice. As regards the second sentence of paragraph 16 of the Complaint, defendants Kamp et al respectfully submit that the subject matter thereof is not a proper pleading and therefore requires no answer, but to the extent it is considered a proper pleading, defendant's Kamp et al deny the same.

9. Defendants Kamp et al admit the allegation of paragraph 22 of the Complaint as regards the filing of a petition by plaintiffs before the Commissioner but deny the pendency thereof.

Additionally, defendants Kamp et al state as follows:

10. The U.S. Patent 2,830,721 was previously assigned to the Plax Corporation.

11. On information and belief, the assets of the Plax Corporation including the U.S. Patent 2,830,721 were acquired by plaintiff MONSANTO.

12. Prior to the filing on March 28, 1956 of the application on which said U.S. Patent 2,830,721 is based, defendant Ernst Kamp visited in person the Plax Corporation, disclosed to officials and em-

ployees of the Plax Corporation his inventions and discoveries as regards coating of polyethylene bottles, supplied to the Plax Corporation samples of bottles coated in accordance with his inventions and coated polyethylene bottles shipped by the Plax Corporation to Germany at the latter's request.

13. Among the officials met during the activities set forth in paragraph 12 of this Answer, was a Mr. Fortner who, on information and belief, at that time was and still today is an official of Plax Corporation and MONSANTO, respectively.

14. Spurred into action by the information received from defendant Ernst Kamp as regards the existence of his inventions and discoveries and the pendency of certain patent applications based thereon, the Plax Corporation, predecessor of plaintiff MONSANTO, fraudulently caused the patent application Serial No. 574,383 to be filed and fraudulently caused the said U.S. Patent 2,830,721 to be issued thereon.

15. Plaintiff MONSANTO, alone and in combination with its Canadian affiliate, the Plax Corporation of Canada, have on the basis of said fraudulently obtained U.S. Patent 2,830,721 and a corresponding Canadian patent, attempted to monopolize and in fact have unlawfully monopolized the market involving coating of polyethylene bottles.

16. By reason of the monopolistic position thus unlawfully acquired by plaintiff MONSANTO, on information and belief, plaintiff MONSANTO would be the only infringer at present of the subject matter of counts 1 and 2 of the interference 91,682, if contained in a patent to issue on defendants' application Serial No. 578,846, involved in plaintiffs' motion for injunction. This also follows from the letters from plaintiff MONSANTO, dated February 18 and March 17, 1964, attached to this answer as defendants' exhibits 1 and 2.

17. On or about June 15, 1964, plaintiff MONSANTO, realizing the hopelessness of its situation, entered into a non-exclusive license agreement, a copy of which is attached hereto as defendants' exhibit 3.

18. Pursuant to paragraph 2.03 of this agreement, plaintiff MONSANTO is obligated to pay the specified royalties

. . . if and when Kamp et al is awarded a United States Patent based on the licensed application. . .

19. To delay the issuance of a patent to defendants Kamp et al to the greatest possible extent, plaintiff MONSANTO filed Notice of Appeal to the Court of Customs and Patent Appeals on the very last day of the statutory 60 day period.

20. To prevent the effects of plaintiffs' dilatory tactics on the license agreement with defendants Kamp et al, defendants promptly gave Notice under 35 U.S.C. 146.

21. Faced with the nullification of its dilatory tactics by the Notice mentioned in paragraph 20 of this Answer, plaintiff MONSANTO now seeks to achieve its aims of avoiding its contractual obligations by injunctive relief.

22. On information and belief, plaintiffs' original appeal to the Court of Customs and Patent Appeals and this action as well as the motion for injunctive relief are prompted principally, if not exclusively by the desire of plaintiff MONSANTO, to avoid, at least for a number of years, its obligation under said license agreement, notwithstanding the hopelessness of such appeal as known to plaintiffs.

23. On information and belief, plaintiff MONSANTO, at the time it entered into the license agreement with defendants Kamp et al, had already decided to appeal under all circumstances the interference decision by the Commissioner in case of a decision favorable to defendant Kamp et al.

24. On information and belief, this cause of action is brought by plaintiff MONSANTO only for dilatory purposes in its attempt to enlist the legal processes of this Court to modify plaintiffs' contractual obligations and to perpetuate its unlawfully acquired monopolistic position.

WHEREFORE, Defendants Pray:

* * *

II. That this Court decree defendants Kamp and Jahn to be the first inventors of the invention defined in counts 1 and 2 of the said interference.

III. That this Court decree defendants Kamp and Jahn entitled to an award of priority with respect to counts 1 and 2 of the said interference based on their right of priority of said German applications.

IV. That this Court decree defendants Kamp and Jahn to be entitled to a patent with claims corresponding to the subject matter on all counts.

V. That this Court deny each and every prayer of plaintiffs complaint.

VI. That defendants be awarded judgment for costs in the Suit, reasonable attorney fees and such further relief as may seem just and fair to this Court.

* * *

[Defendants' Exhibit 1]

MONSANTO CHEMICAL COMPANY

Plastics Division
Springfield 2, Massachusetts

February 18, 1964

Paul M. Craig, Jr., Esquire
Craig and Craig
425 Thirteenth Street, N.W.
Washington 4, D.C.

Re: Interference No. 91,682
Kamp et al v. Pinsky et al

Dear Paul,

As you know, I have been away from the office for some time. Therefore, I have been unable to respond timely to your letter of December 17, 1963. However, I have now had an opportunity to discuss your letter with representatives of Plax Canada and representatives of Monsanto management.

Plax Canada has determined that they have no present interest in acquiring a license under Mr. Kamp's Canadian patents, numbers 609,378 and 664,553. We have determined that Monsanto has no interest in acquiring rights to Mr. Kamp's applications and patents anywhere except in the United States and then only in connection with the subject matter of the interference.

After careful consideration, I am authorized to offer Mr. Kamp the sum of \$3000 for an option to acquire an exclusive license under any patent which issues to Mr. Kamp as a result of winning the interference.

If and when the option is exercised, the license agreement would provide for the following annual royalties: 2% for the first \$150,000 of sales, 1-1/2% for the next \$100,000 of sales, and 1% for all sales in excess of \$250,000, based on the selling price of the epoxy liners. The license would provide a guaranteed minimum royalty of \$3000 per year. Monsanto would have the right to grant sub-licenses. At the end of five years, Monsanto would have the option to convert the license to a non-exclusive license and drop the guaranteed minimums.

If the above meets with the approval of you and your client I will be pleased to prepare a formal agreement for execution.

With best regards,

H. B. Roberts
Senior Patent Attorney

HBR:cvl

[Defendant's Exhibit 2]

MONSANTO CHEMICAL COMPANY
Plastics Division
Springfield, 2, Massachusetts

March 17, 1964

Paul M. Craig, Jr., Esq.
Craig & Craig
425 Thirteenth Street, N.W.
Washington 4, D.C.

Re: Interference 91,682
Kamp et al v Pinsky et al

Dear Paul:

The two proposals discussed in our telephone conference of March 2, 1964 have been discussed with Monsanto management. Unfortunately, there are underlying principles which we believe make it impossible to accept either proposal. First, the \$10,000 down-payment is difficult to accept in view of the fact that the interference is still pending and the outcome is still uncertain. It is equally difficult to conclude that we should start paying royalties for rights under a patent application which is still in an interference. However, we can understand the motives which guided you in making these proposals and we appreciate your interest in working towards a satisfactory agreement.

Perhaps the real difficulty in achieving a mutually satisfactory understanding is our insistence on having exclusive rights under the Kamp et al application. The more we look at our competitive situation, the more it appears that exclusive rights are unnecessary. Why not resolve this matter on a non-exclusive basis?

I am authorized to propose that Mr. Kamp grant Monsanto a non-exclusive license under his pending application for a down-payment of \$3,000 and running royalties in accordance with the schedule set forth in my letter of February 18, 1964, running royalties to start if and when Kamp et al is granted a U.S. patent. Both parties would retain the right to appeal. Such a license agreement would contain typical

boiler plate such as a cancellation provision, a favored nation clause and no minimum royalties. This agreement would leave Mr. Kamp in a position to license anyone else but would not impair the further prosecution of the interference.

If you and your client agree to the above, I will be pleased to receive a draft of agreement from you.

I hope that you had a pleasant and rewarding vacation with your family.

With best regards,

H. B. Roberts
Senior Patent Attorney

HBR:cvl

[Defendants' Exhibit #3]

* * *

WITNESSETH:

WHEREAS, KAMP represents that it is the owner of the entire right, title and interest to United States patent application Serial Number 578,846, filed April 17, 1956 entitled "VESSELS FOR SUBSTANCES WITH VOLATILE COMPONENTS".

WHEREAS, KAMP represents that it is legally free to license the said application and is desirous of licensing MONSANTO thereunder, and

WHEREAS, MONSANTO is desirous of obtaining a non-exclusive license under the said application and any patent which may subsequently issue therefrom to make, use and sell lined plastic containers.

NOW, THEREFORE, in consideration of the mutual covenants and obligations assumed by the parties, it is agreed as follows:

ARTICLE I — LICENSE

1.01 KAMP hereby grants to MONSANTO a non-exclusive license under United States patent application Serial Number 578,846, filed April 17, 1956, entitled "VESSELS FOR SUBSTANCES WITH VOLATILE COMPONENTS" and under any United States patent which issues from the said United States application, or any division or continuation or continuation-in-part of said application, to make, use and sell lined plastic containers.

ARTICLE II — ROYALTIES

2.01 For the license herein granted, MONSANTO shall pay to KAMP the following sums:

- (a) Four thousand dollars (\$4000.00) within sixty (60) days following the complete execution of this agreement, and

- (b) Running Royalties according to the following schedule:

<u>Royalty</u>	<u>Calendar Yearly Net Sales of Lined Bottles</u>
1-1/2%	Up to Two Hundred and Fifty Thousand Dollars (\$250,000.00) of net sales of lined bottles.
1%	On the next Two Hundred and Fifty Thousand Dollars (\$250,000.00) of net sales of lined bottles.
1/2%	On all net sales of linings in excess of Five Hundred Thousand Dollars (\$500,000.00)

2.02 The term "net sales" as used herein shall mean the gross sales of linings on plastic containers made and used or sold by MONSANTO under this agreement and not returned as defective, less discounts actually allowed for quantity and any sales, purchase, use,

excise, or similar taxes or any duties on the linings included in or added to the said prices, but without any deductions of cash discounts, agents' commissions, or any other allowances. If MONSANTO should use lined plastic bottles for its own purposes, the net sales of linings shall be determined on the basis of the prices then in effect as of the date of conversion of said lined plastic bottles to MONSANTO's use.

2.03 The obligation to pay running royalties as set forth in subparagraph 2.01(b) of this Article II shall begin only if and when KAMP et al is awarded a United States patent based on the licensed application and containing claims which cover lined plastic containers made and used or sold by MONSANTO and shall continue only so long as any patent issued to KAMP et al from the licensed application has not been rendered ineffective by any appeal from any decision favorable to KAMP et al in interference number 91,682 or declared invalid by any court of competent jurisdiction.

2.04 Royalties due under sub-paragraph 2.01(b) of this Article II shall be computed quarterly as of the first day of April, July, October and January for the preceding quarter. Not later than sixty (60) days after the end of each quarter, MONSANTO shall report to KAMP the amount of royalty due and shall remit to KAMP the amount of royalty shown on the report to be due.

2.05 MONSANTO agrees to keep records of the bottles manufactured and sold under the license herein granted in sufficient detail to enable the royalties payable hereunder to be determined and shall permit its books and records to be inspected by an independent auditor or other person acceptable to MONSANTO, which acceptance shall not be unreasonably withheld.

ARTICLE III — DURATION

3.01 The Date of this Agreement shall be the date hereinabove first written.

3.02 The Agreement shall continue in effect, unless terminated as

herein provided, until the expiration of any patent which issues from the licensed application.

ARTICLE IV — TERMINATION

4.01 MONSANTO may cancel this Agreement at any time by giving KAMP sixty (60) days' prior notice in writing of MONSANTO's intention to do so.

4.02 If MONSANTO shall at any time fail to make any payment hereunder or submit any report, or fail to perform any of its obligations as herein provided, KAMP, in addition to all other rights and remedies it may have, may terminate all licenses and rights granted under this Agreement upon sixty (60) days' written notice to MONSANTO but if MONSANTO shall correct such default during the notice period, the notice shall be of no further force or effect.

4.03 In the event of cancellation by MONSANTO pursuant to subparagraph 4.01 of Article IV, the license granted to MONSANTO pursuant to this Agreement and all rights thereunder shall be deemed terminated, and KAMP shall have the right to enforce any patent rights it may possess against MONSANTO, including but not limited to bringing suit against MONSANTO based on infringement after the effective date of such cancellation, as if no license Agreement had existed with respect to such patent rights.

4.04 No termination of this Agreement, for any reason, shall prejudice KAMP's rights with respect to any obligations of MONSANTO which have accrued prior to the effective date of termination including, but not limited to, KAMP's rights hereunder to royalties for any period prior to the effective date of termination.

ARTICLE V — NOTICES

5.01 Any notice, report or payment required or permitted to be given under this Agreement by one of the parties to the other shall be deemed to have been sufficiently given for all purposes hereof if mailed by registered mail, postage prepaid, addressed to such party

at its address indicated above or to such other address as shall hereafter be furnished by such party by written notice. Any payments required under this Agreement shall be considered made only when received.

ARTICLE VI — BENEFITS

6.01 This Agreement shall be binding upon and inure to the benefit of KAMP and MONSANTO and their respective successors and assigns of substantially the entire business relating to the subject matter hereof.

ARTICLE VII — SUB-LICENSES

7.01 At any time during the term of this Agreement MONSANTO shall have the right to extend the rights and licenses granted by KAMP to MONSANTO under Article I hereof to any or all of its subsidiaries and/or customers. MONSANTO shall be obligated to pay to KAMP running royalties as set forth in sub-paragraph 2.01(b) of Article II on account of the operations of any subsidiary and/or customer to which said rights and licenses are extended under the provisions of this paragraph. For the purposes of this Agreement, a "Subsidiary" shall be deemed to mean a corporation, fifty percent (50%) or more of whose stock entitled to vote for election of directors, is owned directly or indirectly by MONSANTO.

ARTICLE VIII — LICENSES TO OTHERS

8.01 If a license shall hereafter be granted by KAMP under the licensed application or any patent or patents which issues therefrom for the manufacture, use and/or sale of lined plastic bottles at terms more favorable than those provided in Article II hereof, KAMP will promptly notify MONSANTO of the grant of such license and MONSANTO shall be entitled to the benefit of such more favorable terms in respect of its manufacture, use and/or sale of such products subsequent to such grant, but only for so long as and subject to the same conditions under which such more favorable terms shall be available to such other licensee.

ARTICLE IX — INTERFERENCE

9.01 Nothing contained in this Agreement shall in any way impair or restrict the right of either party to further contest interference number 91,682.

[Filed October 15, 1964]

MEMORANDUM IN SUPPORT OF PLAINTIFFS'
MOTION FOR PRELIMINARY INJUNCTION

Contrary to the position taken by the Defendants, the case of Monaco v. Watson, 270 F.2d 335 is not controlling here. That case involved two applications for patent while the present case involves an issued patent and a pending application. Issuance of a patent to Defendants Kamp et al would result in the intolerable situation in which there were two subsisting patents having identical claims and carrying with them identical rights, both of which are presumptively valid.

Contrary to the position taken by the Defendants and more particularly by the Solicitor in his memorandum in opposition to Plaintiffs' motion, Section 135 of Title 35 U.S.C. does not contemplate the possible issuance of a second patent upon decision by the Board of Interferences that an applicant is entitled to priority over a patentee.

Section 135 provides for different treatment in the case of interferences between patent applications and between an issued patent and a pending application.

"The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor."

— Quoting 35 U.S.C. 135
[Emphasis Added Throughout]

The decision cannot constitute "the final refusal by the Patent Office of the claims involved" when those claims have already issued in a patent. Thus, it is only when two applications are involved that the Commissioner may, at his discretion, issue a patent to the successful applicant in the Patent Office. Had Congress intended otherwise, it would have been a simple matter to have embraced patents by making this section read —

"... whose decision, if adverse to the claim of an applicant or a patentee . . ."

Instead, in the very next sentence the statute states what is to be done in the case of an interference involving an issued patent:

"A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office."

— Quoting 35 U.S.C. 135

Furthermore, Section 146 expressly provides the means by which an applicant, such as Kamp et al, may obtain the issuance of the patent if they prevail in this Court. The last sentence reads as follows:

"Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent Office of a certified copy of the judgment and on compliance with the requirements of law."

— Quoting 35 U.S.C. 146

We therefore contend that the Commissioner of Patents has no authority to issue a second patent until and unless Kamp et al are finally judged to be the prior inventors.

There is precedent for this in the case of Radtke et al. v. American Tri-Ergon Corporation et al, 114 F.2d 15, decided by the Court of Appeals for the District of Columbia. In that case an applicant, Radtke,

successful in the Patent Office, was issued a patent. The losing applicant, Vogt, took the case to the District Court under the then applicable statute RS 4915. The District Court awarded priority to Vogt and gave a final decree authorizing the Commissioner of Patents to issue a patent to Vogt. Radtke, filed Notice of Appeal in the Court of Appeals of the District of Columbia.

The Commissioner of Patents refused to issue a patent to Vogt. Vogt went back to the District Court and got an order directing the Commissioner of Patents to forthwith issue Vogt a patent.

Radtke moved for a temporary injunction in the Court of Appeals to restrain the Commissioner from issuing a patent to Vogt. In granting this the Court said:

"This cause coming on to be heard on appellants' motion filed on January 27, 1940, for temporary injunction to enjoin Commissioner of Patents from issuing a patent as directed by the order of the District Court entered in this cause on January 24, 1940, and it appearing that said order of January 24, 1940, was entered by the District Court after an appeal to this court in the cause had been taken and perfected and after this court had obtained exclusive jurisdiction of the cause: see *Lasier v. Lasier*, 47 App. D.C. 80; *Keyser v. Gar*, 105 U.S. 265; . . ."

Plaintiffs contend that under the circumstances of the present case the jurisdiction is exclusively in this court and that the Commissioner of Patents has no authority constitutional, statutory or otherwise, to issue a patent to Kamp et al until this action has been heard on the merits and until and unless a final judgment adverse to Pinsky et al from which no appeal or other review has been or can be taken or had, shall have become effective. Thereasoning in Judge Burger's dissenting opinion in the Monaco case applies with great force to the present situation.

"Burger, Circuit Judge (dissenting).

Under the holding of the Court of Customs and Patent Appeals in *In re Allen*, 1940, 115 F.2d 936, 28 CCPA 792, the Commissioner of Patents has no jurisdiction to issue a patent to a winning party in an interference proceeding during the pendency of the loser's appeal to the CCPA. It is not a matter of discretion, and so the Commissioner conceded in the District Court, although he argues to the contrary here.

For purposes of the Commissioner's interim jurisdiction I can see no difference between an appeal to the CCPA under 35 U.S.C. § 141 and a suit for review in a District Court under 35 U.S.C. § 146. Before *In re Allen* but subsequently to *Whipple v. Miner*, C.C.D. Mass. 1883, 15 F.117 (relied on here by the Commissioner), the Act of 1927 had amended an appeal to the CCPA and a Bill in equity in the District Court were mutually exclusive remedies with identical time limitations. 44 Stat. 1336 (1927). These are provisions analagous in every material respect to present 35 U.S.C. §§ 141 and 146. Thus, although there have historically been differences between these two methods for reviewing a decision in an interference proceeding, the two routes are now procedurally the same and should therefore have the same effect upon the jurisdiction of the Commissioner.

The statute which the Commissioner contends compels him to issue the patent without delay, 35 U.S.C. § 135, had an exact counterpart in force when the CCPA decided *In re Allen*. Rev. Stat. § 4904, as amended, 53 Stat. 1212 (1939). This statute clearly makes no distinction between the two routes for review, nor does reason suggest why any such distinction should be made.

I would therefore hold that the Commissioner of Patents does not have jurisdiction to issue a patent until after the termination of proceedings brought under 35 U.S.C. § 146. "

— Quoting Monaco v. Watson

The Public Interest As Well As The
Equities Point To The Issuance Of
The Injunction

The Defendants urge lack of equity and failure to show irreparable damage to the Plaintiffs as a result of the issuance of the Kamp et al patent prior to a final adjudication. This, however, is not true. The very license agreement appended to the Kamp et al memorandum establishes that the Plaintiffs will be required to pay a running royalty as soon as the Kamp et al patent issues. Moreover, Kamp et al can keep such royalty as it may receive irrespective of whether it is ultimately determined that Pinsky et al are the first inventors. If it is ultimately decided that Pinsky et al are the first inventors the payment of these running royalties in addition to the money Kamp et al have already received would be irreparable damage of a concrete sort.*

One cannot foresee every irreparable damage which might be brought about by the issuance of a patent to Kamp et al prior to final determination of this action. This would depend in part upon how Kamp et al chose to exploit the patent in the interim before final determination.

The Solicitor has cited a series of cases on the last page of his brief which illustrate the confusion brought about by the issuance of a second patent before a final adjudication. Those cases ultimately involved a plurality of actions under several statutes including 35 U.S.C. 146, 35 U.S.C. 291 (Interfering Patents), the Declaratory Judgment Statutes, and cross complaints for infringement.

*Kamp et al allege irreparable damage because of loss of royalty. However, Kamp et al can only collect royalty for a maximum of seventeen years from the date of issuance of a patent whether it issues now or later. The only effect on Kamp et al of the injunction here sought would be to postpone the right to collect royalty if the Court finally determines that Kamp et al have any valid patent rights to license. If they are not entitled to a patent, collection of such royalties would be unjust enrichment. Kamp et al have already received payment for entering into the agreement.

If these cases are any criteria of what might happen, the consequences become a matter not only of private but of public concern.

For the foregoing reasons the Plaintiffs' motion should be granted.

Respectfully,

Burns, Doane, Benedict, Swecker &
Mathis

By: W. L. Benedict

[Certificate of Service
October 15, 1964]

[Filed October 26, 1964]

REPLY BY COMMISSIONER TO
"MEMORANDUM IN SUPPORT OF
PLAINTIFFS' MOTION FOR
PRELIMINARY INJUNCTION"

This reply by the defendant, Edward J. Brenner, Commissioner of Patents, to the identified memorandum, which was served at midafternoon of the day before that set for the hearing on the identified motion, is being submitted pursuant to permission granted at said hearing.

The construction plaintiffs would, in the memorandum, give 35 U.S.C. 135, is not consistent with the construction given that same section of the patent statute in Monaco et al. v. Watson, 106 U.S. App. D.C. 142, 270 F.2d 335. In dealing with the second sentence of the section, the Court of Appeals gave no consideration to the clause of the sentence having reference to particular action by the Board of Patent Interferences and reading, "whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved." Rather, the Court of Appeals found, as significant in the decided case and likewise significant in the case at bar, that the "statute provides that the 'question of priority of invention shall be determined by a board of patent interferences * * * and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor.'"

In ignoring the quoted clause, the Court of Appeals acted in accord with the rules of grammar and with legislative history. As noted in House Report 1923, 82d Congress, 2d Session, page 21, and also in Senate Report No. 1979, 82d Congress, 2d Session, page 21, and repeated in the "Historical and Revision Notes" under 35 U.S.C.A. 135, page 315 of the volume containing sections 111 to 265, the first paragraph of section 135 "is based on Title 35, U.S.C., 1946 ed., § 52," "states the existing corresponding statute with a few changes in language," but adds an "explicit statement that the Office decision on priority constitutes a final refusal by the Office of the claims involved." From a grammatical standpoint, the Court of Appeals rightly ignored the quoted clause because it relates to a single matter subordinate to and not inclusive of all determinations of priority as between applicants and also as between applicants and patentees, and because it is disjunctively set off, by a comma, from the final clause: "and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor." From the standpoint of legislative history, the Court of Appeals rightly ignored the quoted clause because, respecting issuance of a patent to the prevailing party to an interference in the Patent Office, the "first paragraph states the existing [previous] corresponding statute with a few changes in language." So much is evident from a comparison of said first paragraph and 35 U.S.C. 52, 1946 ed. The latter reads as follows:

Whenever an application is made for a patent which, in the opinion of the commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention. And the commissioner may issue a patent to the party who is adjudged the prior inventor. (R. S. sec. 4904; Mar. 2, 1927, ch. 273, sec. 4, 44 Stat. 1336; Aug. 5, 1939, ch. 451, sec. 1, 53 Stat. 1212.)

The construction plaintiffs would give 35 U.S.C. 135 additionally runs counter to the policy of the section as delineated in the Monaco case. As pointed out by the Court of Appeals, the "decision of the board of patent interferences is presumably, though not conclusively, correct," and if the prevailing party in the Patent Office "gets the patent, he gets no more than is presumably his." The stated policy is particularly applicable in favor of the defendants, Ernst Kamp and Karl Jahn, and against the plaintiffs, in view of the fact that plaintiffs' patent was inadvertently issued. The application for plaintiffs' patent was filed on March 28, 1956, and the application of Kamp and Jahn, filed April 17, 1956, hence was copending therewith (see heading and page 2, Exhibit 2, attached to Kamp and Jahn's opposition to plaintiffs' motion). Also, as found by the Board of Patent Interferences (page 16, ibid.), Kamp and Jahn's original claims were directed to the subject matter claimed in plaintiffs' patent. Kamp and Jahn were, and probably still are, prejudiced by the improvident grant of the patent to the plaintiffs. It is entirely befitting, it is submitted, that such prejudice be brought to an end by the issuance of a patent to said defendants.

Plaintiffs (Memorandum, page 2) would have it that the quoted and final clauses of the second sentence of 35 U.S.C. 135 are coordinate. The coordinate clauses, however, are, as already indicated, the first and final clauses. The final sentence of the first paragraph is coordinate with none of the three clauses. What plaintiffs do, improperly, is to read "decision, if adverse to the claim of an applicant" as though it were merely "decision."

Plaintiffs (Memorandum, page 3) cite Radtke et al. v. American Tri-Ergon Corporation et al., 71 App. D.C. 375, 114 F.2d 15, to support their contention that the Commissioner has no authority to issue a (second) patent, to Kamp and Jahn, until and unless they "are finally judged to be the prior inventors." The cited case, however, stands for no more than this: When the Court of Appeals had obtained "exclusive jurisdiction" of a cause, an order of the District Court, thereafter, directing the

Commissioner to issue a patent, would be stayed "pending final determination of the appeal in this cause, or the further order of this court." The Commissioner did take a broader position with respect to the order of the District Court, as shown in the attached photocopy of a memorandum on his part, dated February 2, 1940. At that time, however, there was no provision, similar to the last sentence of the first paragraph of 35 U.S.C. 135, under which a "final judgment adverse to a patentee * * * shall constitute cancellation of the claims involved from the patent."

Plaintiffs do not, and could not contend that the second sentence of 35 U.S.C. 135 is susceptible of only one construction, their own. It has differently been construed by the Commissioner in his decision (attachment to plaintiffs' supplemental motion for preliminary injunction) on plaintiffs' petition (Exhibit A to plaintiffs' original motion). Only if that decision "lacked any basis in reason or common sense" (Commissariat A L'Energie Atomique v. Watson, 107 U.S. App. D.C. 85, 274 F.2d 594), thereby constituting an abuse of discretion by the Commissioner, should the Commissioner be enjoined from issuing a patent to Kamp and Jahn. The argument respecting the construction of 35 U.S.C. 135, so belatedly advanced before this Court by plaintiffs in their memorandum, has never been advanced before the Commissioner, according to plaintiffs' aforesaid petition. The Commissioner, it is submitted, should not be enjoined by reference to an argument he has never been afforded an opportunity to explore. The least this Court should do, it is further submitted, is to deny plaintiffs' motion without prejudice to the filing of a further petition to the Commissioner advancing plaintiffs' new argument.

For the reasons set forth above and in the Commissioner's opposition to plaintiffs' motion (or motions) for a preliminary injunction, that motion (or those motions) should be denied.

In line with the expressed desire of the Court that the defendants "collaborate" in responding to plaintiffs' memorandum, the defendants, Kamp and Jahn, seasonably were furnished with a draft copy of this re-

ply by the Commissioner, and thus were afforded an opportunity to accept or reject the several arguments made.

Respectfully submitted,

/s/ C. W. Moore
Solicitor, United States Patent Office,
Attorney for Defendant,
Edward J. Brenner,
Commissioner of Patents

[Proof of Service
October 23, 1964]

[Radtke, et al. v. American Tri-Ergon Corporation, et al.
No. 7577, United States Court of Appeals for the District
of Columbia Circuit]

RE: MOTION FOR TEMPORARY INJUNCTION
PENDING APPEAL.

The previous memorandum filed on behalf of the Commissioner of Patents sets forth the position consistently maintained by him, that he is not a proper party to the equity suit here involved. Notwithstanding his position of neutrality in the controversy between the parties, he is concerned with the character of the order issued by Mr. Justice Goldsborough on January 24, 1940, and requests that this Court give consideration to this additional memorandum.

The decree in the equity suit authorized the Commissioner to issue a patent to Vogt et al. and thus was worded in conformity with the statute (Section 4915 R. S., U.S.C., title 35, sec. 63) under which the suit was brought.

In the order issued by Mr. Justice Goldsborough on January 24, 1940, however, the Commissioner is not merely authorized but is directed forthwith to proceed to issue the patent. It is submitted that the issuance of such orders, if allowed to stand, would take from the Commissioner of Patents the discretion reposed in him by law in the matter of

issuing patents. It is noteworthy that the statute, Section 4915 R. S., does not give the Court the authority to direct the issuance of a patent.

The Court's decree in such an equity suit if not reversed on appeal is binding on the Commissioner as to the question of priority but other considerations and events arising later may make it improper to issue a patent. The exercise of discretion in the matter by the Commissioner should not be made impossible by order of the Court.

The forced issuance of a patent in accordance with the order of January 24, 1940, while an appeal to this Court in the equity suit is pending, would appear to constitute interference with judicial process to the extent of rendering moot the pending appeal.

The authority to issue a patent in this country is uniquely reposed in the Commissioner of Patents (Sec. 4893 R.S., U.S.C., title 35, sec. 36). This statute reads as follows:

Sec. 4893. (U.S.C., title 35, sec. 36.) On the filing of any such application and the payment of the fees required by law the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor.

Under this statute the Commissioner is not authorized to issue a patent until he examines the application, finds the applicant justly entitled to a patent under the law, and finds that the invention is sufficiently useful and important.

Another statute, Section 4904 R. S., (U.S.C., title 35, sec. 52), places a further duty on the Commissioner of exercising discretion before the issuance of a patent. This statute reads as follows:

Sec. 4904. (U.S.C., title 35, sec. 52.) Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending ap-

plication, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, within such time, not less than twenty days, as the Commissioner shall prescribe.

The Commissioner is not relieved of the duties placed on him by these statutes by the existence of a suit in equity or even a final adjudication therein. While the Commissioner is bound by a final adjudication of the Court, holding that one party to the suit is the prior inventor, certain events may transpire which would make the issuance of the patent to said party improper. For example, another interfering application may be discovered or a clear anticipation of the claimed invention may be discovered after the termination of the equity suit. In either case the Commissioner has the statutory duty to withhold the patent. These and other possibilities make it clear that the discretionary powers of the Commissioner should be preserved. The fact that this Court has many times ruled "that an award of priority does not necessarily entitle the party in whose favor the award is made to a patent" was alluded to by this Court in the case of *United States ex rel. Dunkley Company et al. v. Ewing, Commissioner of Patents*, 42 App. D.C. 176, citing cases.

This Court, in *Moore, Commissioner of Patents v. U. S. ex rel. Boyer*, 138 O. G. 530, 32 App. D.C. 243, has held that "The Commissioner of Patents is vested with full authority to control and regulate the course of proceedings in his office." The situation before the Court in that case was as follows: The Supreme Court of the District of Columbia had granted a preemptory writ of mandamus (1909 C. D. 253) commanding the Commissioner to grant Boyer access to certain patent applications following a decree of the Supreme Court of the State of New York ordering assignment of the applications to Boyer, and appeal from

this decree had been taken and was pending, but the Supreme Court of the District of Columbia in granting the writ pointed out that no superseas of the decree had been obtained and held that until reversed or modified the decree was conclusive as between the parties and was binding on the Commissioner of Patents.

On appeal by the Commissioner this Court said:

This is clearly an instance of judicial interference with the discretionary power of an executive officer of the Government.

* * *

What the Supreme Court of New York did was to direct the execution of an assignment of the Berger applications to appellee. The Commissioner has not questioned the validity of the action of the court or the assignment. He has merely suspended further action on the applications until the case in New York, now pending on appeal, is finally determined. This, in our opinion, was not only a due exercise of discretion, but it was prudent action on the part of the Commissioner.

The situation here is in principle the same. The Commissioner properly suspended action on the Vogt et al. application pending the outcome of the appeal. It is felt that under these circumstances an order directing the Commissioner of Patents to issue a patent, rather than an order which would "authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law" (Section 4915 R. S.) clearly might interfere with the statutory duty imposed upon the Commissioner of exercising his discretion as to the patent application "otherwise complying with the requirements of law."

JA.47

This last quoted obligation of the statute continues upon the Commissioner until the patent has actually been delivered and does not cease with the notification of allowance.

Conway P. Coe,
Commissioner of Patents,

By /s/ W. W. Cochran
Attorney

February 2, 1940.

[Certificate of Service]

[Exhibit 2 attached to Memorandum
of Defendants Kamp et al in Opposition
to Plaintiffs' Motion for Preliminary
Injunction, etc.]

[Mailed June 29, 1964, U.S. Patent Office]

IN THE UNITED STATES PATENT OFFICE

BEFORE THE BOARD OF PATENT INTERFERENCES

Patent Interferences No. 91,682

Pinsky, Adakonis and Nielson v. Kamp and Jahn

Plastic Coated Articles

Patent granted Jules Pinsky April 15, 1958, No. 2,830,721 on application filed March 28, 1956, No. 574,383

Application of Ernst Kamp filed April 17, 1956, No. 578,846

Messrs. Burns, Doane, Benedict, Sivecker and Mathis for Pinsky Adakonis and Nielsen

Mr. Paul M. Craig, Jr. for Kamp and Jahn

The interference in issue relates to a synthetic resin article coated with a cured epoxy resin to produce enhanced resistance to permeation of organic fluids. Count 1 is generic with respect to the synthetic resin article while count 2 is drawn to a specific embodiment thereof as follows:

Count 2

A polyethylene container having a surface characterized by enhanced resistance to permeation by organic fluids, said surface having an adherent coating of a cured epoxy resin.

The interference is between the application of Kamp et al, filed April 17, 1956, and a patent of Pinsky et al issued April 15, 1958, on an application filed March 28, 1956. Kamp et al are senior party by virtue of the decision of the Primary Examiner on October 23, 1962 (paper No. 29) granting the motion by Kamp et al to shift the burden of proof based on a prior German application filed on April 22, 1955. Pinsky et al, the junior party, are under the burden of establishing priority by a preponderance of the evidence.

The Pinsky et al patent is assigned to the Monsanto Chemical Company, while no assignee is indicated for the Kamp et al application.

Both parties filed briefs and appeared at the final hearing held on May 4, 1964. Only the junior party, Pinsky et al, took testimony and introduced documentary evidence and physical exhibits.

During the interlocutory stage of this proceeding Kamp et al brought motions to add counts and to shift the burden of proof, which motions were denied and granted, respectively. Pinsky et al brought a motion to dissolve as to Kamp et al on the grounds that Kamp et al failed to copy the patent claims within a year, that Kamp et al did not have the

right to make the counts in issue, that Kamp et al are estopped for unreasonable delay in seeking claims consonant in scope with the counts, and that there was error in declaring the interference (that is, Kamp et al did not claim the same invention as the patent within one year of granting of said patent). The motion was denied by the Primary Examiner in his decision on motions of July 2, 1962 and in the reconsideration of October 23, 1962.

The issue is one of priority of invention, and the case for Pinsky et al is based on an assertion of an actual reduction to practice prior to the filing date of the earliest German application of Kamp et al as well as assertion that Kamp et al have no right to make the claims corresponding to the counts in either their U.S. application or German application. Pinsky et al do not rely on diligence in their brief; therefore our consideration of their record involves only the issue of actual reduction to practice.

Pinsky et al contend that they have established by a preponderance of the evidence a successful reduction to practice prior to April 22, 1955, the filing date of the first filed German application of Kamp et al. The case for Pinsky et al. is essentially based on the testimony of one Albert E. Adakonis, a co-inventor herein. The party Pinsky et al has filed a petition in their involved issued patent under the provisions of 35 USC 256 and Rule 324 for the purpose of deleting Albert E. Adakonis as an inventor from said involved patent, action on which has been deferred by the Law Examiner pending the termination of the interference..

It is the position of Kamp et al that the case for a reduction to practice by Pinsky et al is deficient since, amongst other things, it lacks corroboration for the reason that the record does not establish that Adakonis is not in fact a co-inventor, the testimony of a co-inventor being insufficient for independent corroboration, *Minnesota Mining and Mfg. Co. v. General Electric Co.*, (D.C. - Dist. Col.) 167 F.Supp. 37, 119 USPQ 65. However, we do not find it necessary to consider the question of whether or not Adakonis is properly joined as a co-inventor

for the reason that even if he were not a co-inventor, his testimony as a corroborating witness would not be adequate to establish a successful reduction to practice on behalf of the inventors Pinsky and Nielsen.

According to the record submitted by Pinsky et al it would appear that Adakonis first began working on the lining of low density polyethylene bottles in 1953. Adakonis testified that he had reported to Jules Pinsky in the early part of June, 1953 and was referred to Alvin Nielsen. He further testified that Nielsen told him to work on linings and gave him a number of resins to evaluate as lining material for polyethylene bottles; note Pinsky et al record, pages 9 and 10 (all further references to the record will relate to the testimony of Albert E. Adakonis). Adakonis remembered, in particular, that Nielsen gave him two resins, VAGH, a vinylite, and BRR, an epoxide. The BRR resin was contained in a metal can labelled "Bakelite Epoxy Resin". Together with the resin he received from Nielsen he obtained a smaller can containing hardener and also literature which accompanied same relating to formulation thereof.

The record indicates that on June 3, 1953, Adakonis made up a solution of four parts BRR-18795 (epoxy resin) and one part BRR-18793 (hardener) and lined three bottles therewith. The lining was cured at 120° (the record as a whole would indicate that 120°F was intended). The solution was diluted with methyl ethyl ketone and three more bottles were lined and cured. The bottles were found to be lined with an adherent film of epoxy resin but were found to be brittle and cracked when flexed (record, pages 14 to 17, Exhibits 1, 2 and 2A).

Adakonis also testified that permeability tests were conducted on epoxy lined bottles on, June 22, 1953. On this point the record is not entirely clear but it indicates that the bottles tested may have been lined with a composition containing 60 parts of a polyamide and 40 parts of an epoxy resin on June 11, 1953 (record page 19, Q-56 and 57). The permeability data was recorded in Adakonis' notebook, a photocopy of which was introduced in evidence as Exhibit 3. On direct examination

Adakonis testified that in the coating in question "there was a slight modification here in formulation" (page 20 of record, Q-58).

The testimony of Adakonis indicates that on April 28, 1954 twelve bottles were coated with Bakelite resins, BRR-18795 (four parts) and BRR-18793 (one part) and cured at different temperatures. Other bottles were coated with a solution of BRR-18774 (three parts) and BRR-18793 (one part); record page 25, Exhibit 4. The bottles were tested for permeability with carbon tetrachloride and compared to an untreated control bottle; Exhibits 5, 6, 7 and 8. Although the exhibits refer to BRR-181795, Adakonis testified that the resins are the same as indicated in Exhibit 4 (record page 26). The BRR-18774 was identified as a Bakelite epoxy resin (record, page 30).

On May 27, 1954, a number of polyethylene bottles were treated by what is termed the explosion method. Adakonis indicated that the treatment consisted of exploding a mixture of gases within the bottles in order to form a better surface on which the epoxy resin was to adhere (record, page 34, Exhibit 13). The bottles were then coated with a solution of a standard mixture of BR-18795 and BR-18793 with 25%, 50% and 75% methyl ethyl ketone, the results of the permeability tests thereon being recorded in Adakonis notebook (Exhibits 14, 15 and 16) and compared with unlined bottles (Exhibit 17; SI and S2; record, pages 43 and 44).

On October 2, 1954, eight bottles were coated with a methyl ethyl ketone solution of 60 ml. BR-18794 and 15 ml BR-18793. After curing, one bottle was flexed and was found to be brittle. Said bottle was cut open and was found to have a clear, glassy lining with excellent adhesion (record, page 47; Exhibit 18). The permeability data were recorded in Adakonis' notebook; Exhibits 19 and 20.

Subsequently Adakonis began work on a Mennen Coating Program wherein bottles were lined with BR-18794 resin and BR-18793 hardener in ratios of 4:1 and 8:1 (record page 52, Exhibit 21). The permeability data were recorded in Adakonis' notebook (Exhibits 22 to 24).

Certain of the tested bottles containing baby oil were introduced in evidence as Exhibits 9, 10, 11, and 12, which exhibits correspond to bottle 20 of Exhibit 24, bottle 21 of Exhibit 24, bottle 19 of Exhibit 24, and bottle 3 of Exhibit 22, respectively. The testimony indicates that the marking on the bottles of "BR 4-1" means the bottles were lined with BRR resin of 4:1 epoxy resin to hardener (record, page 61). Adakonis also testified that the bottles were lined by the method described in Exhibit 21 (record, page 62). Adakonis lined the bottle identified as Exhibit 10 with BRR resin (BR-18794 and BR-18793, 4:1) in December of 1954 and made tests thereon on December 28, 1954 (record, pages 64 to 66). Exhibit 11 was lined in the same manner as Exhibits 9 and 10 (record, pages 67, 68). The control bottle (Exhibit 12) was unlined and was filled with baby oil on December 28, 1954. The testimony indicates that all the bottles that were lined were so lined with BR resins (Bakelite epoxy resins) in a ratio of 4:1 with the hardener and were diluted with methyl ethyl ketone (record, page 71).

Permeability tests, in general, were carried out by filling the treated bottles with volatile solvents such as toluene and carbon tetrachloride, as well as baby oil, and periodically making weighings ranging sometimes over a six month period to determine the weight loss as compared with that of an untreated bottle filled with the same substance. In most cases the weighings were made by Adakonis and recorded by him in his notebook. Otherwise the weighings were made and the results recorded by various assistants who testified to their respective acts.

It is our opinion that the above evidence submitted on behalf of Pinsky et al is not sufficient to establish a successful reduction to practice. It is apparent from a consideration of the entire record before us, including the patent specification of Pinsky et al, that Adakonis has not proved that he produced an epoxy lined bottle capable of being used for its intended purpose. Field v. Knowles, 37 CCPA 1211, 183

F2d 593, 640 O.G. 697, 86 USPQ 373; Elmore v. Schmitt, 47 CCPA 960, 278 F2d 510, 757 O.G. 288, 125 USPQ 653. The disclosure of Pinsky et al in their patent is directed to the production of an impermeable lining for a squeeze bottle, in particular a polyethylene bottle; for example, note column 1, lines 18 to 20 and 29 to 34. It is particularly apparent from the testimony of Adakonis that all the tests were performed on low density polyethylene bottles (record, pages 7, 10, 43; Q-8, 9, 19, 138). On cross-examination (record, page 165; XQ-641 et seq.) Adakonis indicated that all his work was on low density polyethylene bottles and that they were interested in squeeze bottles. As the record is not clear on whether or not Adakonis was ever successful in producing a polyethylene squeeze bottle with a sufficiently flexible epoxy liner to enable the bottle to be squeezed without cracking, it has not been established that an epoxy liner has been produced which is capable of being used for its intended purpose. In a recent case, Harding v. Steingiser et al, 51 CCPA ___, 318 F2d 748, 796 O.G. 18, 138 USPQ 32, the court of Customs and Patent Appeals (citing Elmore v. Schmitt, supra, and Blicke v. Treves, 44 CCPA 753, 241 F2d 718, 717 O.G. 215, 112 USPQ 472) held that even though no specific limitation with respect to utility or purpose appears in the counts, it must be considered with respect to the reduction to practice, and it must be shown that the invention worked as it was intended to work in its practical contemplated use.

The bottles lined in June of 1953 cracked when flexed (record, page 17). No indication is given as to whether or not the bottles lined in April and May of 1954 cracked; however, some of those lined in October of 1954 did crack. No information is given regarding the flexibility of the bottles involved in the Mennen program. When asked on cross-examination (record, page 167; XQ-647) whether he was able to consistently produce a flexible lined bottle at any time between 1953 and 1955, Adakonis was unable to say that he had. He indicated that he had

made bottles that did not crack when flexed, but had found others that did crack upon aging. When asked what periods of time were involved in aging, he could not give any definite time, but did indicate that aging could be from one day on (record, pages 159 and 168). The testimony in other instances indicated that when the lining did not crack said lining was tacky and consequently incompletely cured (record, page 136). While there is testimony to the effect that up to May or June of 1955 some bottles were lined and cured and were flexible, no evidence has been introduced with regard to the composition and preparation thereof (record, 159).

That the question of obtaining flexibility in the lined bottles was a major factor in the work of Adakonis was brought out by his testimony on cross-examination where he testified that a brittle liner would defeat their own purpose (record, pages 92, 123, 131; XQ-353, 495 et seq., 529). The testimony further indicated that cracking of the liner may affect the permeability rate (record, page 124 et seq.).

Whether or not the production of a flexible liner had ever been achieved, and if achieved, by what means and by whose direction, are questions the answers to which are not apparent from the consideration of record before us.

When asked on cross-examination if he had ever developed a liner that did not crack, Adakonis answered that Pinsky had suggested the use of a polyamide as an additive. However there has been introduced no supporting evidence which would establish the actual composition of the formulation or whether or not the use of polyamide was tried and found to be successful (record, pages 131 et seq., 223, 226; XQ-858 et seq., 868). Further if there was ever produced a flexible, cured liner, a fact which has not been established by the documentary evidence of record, there is nothing in the record to indicate that such a flexible, cured liner was produced under the direction and supervision or by the suggestion of either of the inventors, Pinsky or Nielsen. It is not clear

that Adakonis, having realized the problem of the lack of flexibility, communicated said problem to the inventors who in return suggested a solution thereto. There is further no indication in the record when the problem of flexibility, if ever, was solved. Thus on cross-examination, beginning on page 154 of the record there is an indication that flexible liners were eventually produced since such bottles were sold commercially in about 1957; however, 1957 is subsequent to the filing dates of the applications involved herein. The above testimony indicates that in 1957 machines were installed for the commercial production of the lined bottles; however, Adakonis was not aware of the formulation of the epoxy liner and indicated in his testimony (XQ-605 et seq.) that the formulation might have been modified slightly. There is a further indication in the testimony of Adakonis that certain modifications in the manner of mixing the resins produced results different from that obtained by following the procedure suggested by Pinsky and Nielsen (record, page 177 et seq.).

Referring to the Pinsky et al patent disclosure it is significant to note that only Examples 9, 11, 13 and 14 specifically indicate that a flexible lining is formed and in each of those examples the epoxy formulation has been modified to include a urea-formaldehyde resin or a polyamide or styrene oxide. All of the experiments performed by Adakonis which were introduced in evidence herein are limited to mixture of epoxy resin, hardener and solvent to produce results which were at most, not consistent. Therefore, the evidence introduced shows a series of bottles lined with various formulations of epoxy resins, hardener and solvent to form liners that may be brittle, flexible, tacky or flexible, becoming brittle with age. As held in the Harding v. Steingiser et al case, *supra*, the test results were inconclusive.

In view of the foregoing it is our opinion that when the inventors, Pinsky and Nielsen, assigned the task of lining polyethylene bottles with epoxy resin to Adakonis, they did not know nor did they communicate to Adakonis a means by which the task could be accomplished. (cf.

Land v. Dreyer, 33 CCPA 1108, 155 F2d 383, 590 O.G. 6, 69 USPQ 602 (605); Field v. Knowles, supra, 86 USPQ (388); Cislak v. Wagner, 42 CCPA 701, 215 F2d 275, 691 O.G. 6, 103 USPQ 39 (42); Bac v. Loomis, 45 CCPA 807, 252 F2d 571, 729 O.G. 727, 117 USPQ 29 (34).

Since the testimony adduced on behalf of Pinsky et al does not establish by a preponderance of the evidence a successful reduction to practice, they are restricted to their record date. Accordingly it now becomes necessary to consider the case for Kamp et al who have been accorded the benefit of the filing date of their German application K 2560 III/33c.

It is the contention of the party Pinsky et al that Kamp et al are not entitled to prevail in this proceeding for the reasons (1) that the aforementioned German application does not have either a sufficient disclosure of the subject matter of the counts or a means of producing same, (2) that Kamp et al did not copy either the Pinsky et al patent claims or claim substantially the same subject matter within the statutory period, and (3) that the disclosure of the involved U.S. application of Kamp et al is inadequate. The above contentions are primarily based on the argument that Kamp et al do not specifically disclose a cured epoxy resin and do not disclose the procedure essential for the adhesion of said cured epoxy resin to the container surface. It is further urged that the counts in issue are directed to a predominantly epoxy resin while Kamp et al disclose only compositions containing epoxy resins. Also Kamp et al are said to inadequately define or describe the exact nature or composition of the resin components.

Consideration of the translation of the German application reveals a clear teaching of a liner composition consisting of epoxy resins, urea resins, polyamides and chlorinated diphenyl (page 2, last paragraph). The counts in issue are drawn to an adherent coating of a cured epoxy resin. As the German application involves the lining of polyethylene bottles with an adherent plastic material to produce a pliable bottle

impermeable to volatile materials, it is considered that said German application has a disclosure adequate to meet all the limitations as set forth in the counts. It is our view that to a skilled polymer chemist, the teaching of the use of an epoxy resin implies a cured resin. We further consider that a reference to epoxy resins, urea resins, and polyamide resins has a definite meaning to the skilled polymer chemist. This fact is illustrated by the testimony of Adakonis where it was established that the industry supplied such resins to the consumer without specifically identifying the composition of same. Thus the testimony indicated that Adakonis received cans of epoxy resin identified only as Bakelite epoxy resin and by a code number such as BRR 18795. In the same manner Adakonis described the use of polyamide resins. Accordingly we deem the disclosure of the Kamp et al German application and involved U.S. application sufficient to enable one skilled in the polymer art to prepare an adherent, cured epoxy lined polyethylene bottle. In re Nelson et al, 47 CCPA 1033, 280 F2d 172, 758 O.G. 233, 126 USPQ 242; In re Johnson, 48 CCPA 733, 282 F2d 370, 760 O.G. 1041, 127 USPQ 216.

We find the argument of Pinsky et al that the counts are directed to a liner consisting essentially of an epoxy resin while the disclosure of Kamp et al is directed to a composition including polyamide, urea and chlorinated diphenyl is without merit. The courts have consistently held that in the absence of any ambiguity counts will be given the broadest interpretation which they will reasonably support, and that limitations not included in the counts cannot be subsequently read into them. Tansel v. Higonnet et al, 42 CCPA 732, 215 F2d 457, 690 O.G. 138, 103 USPQ 58; Loukomsky v. Gerlick, 46 CCPA 805, 264 F2d 907, 743 O.G. 256, 121 USPQ 213. Here, as in the Loukomsky v. Gerlick case, even if we look to the patent specification of Pinsky et al to interpret the counts, it becomes clear from Examples 9, 10, 11, 13 and 14, therein, that claims 1 and 7 (corresponding to the counts in interference) were

intended to read on compositions containing substances other than epoxy resins, such as urea resins and polyamide resins. To support their view that a disclosure of a composition consisting of epoxy resins, polyamide, urea resin and chlorinated diphenyl cannot support a count calling for an epoxy resin, *In re Moreton*, 50 CCPA 948, 312 F2d 954, 791 O.G. 613, 136 USPQ 479, is cited. In the *Moreton* case it was held that a composition consisting of three essential ingredients does not support a claim to a composition consisting of two essential ingredients; the case is therefore not in point since the counts herein are not limited to a liner consisting essentially of epoxy resin as we have indicated supra.

Regarding now Pinsky et al's argument that Kamp et al do not teach a means of forming an adherent coating, it is urged by Pinsky et al that they are not barred from consideration of such an argument because it is not directed to the question of operability, and that the issue was raised in their motion to dissolve which was denied by the Primary Examiner. Since Kamp et al indicate in their German and U.S. applications that they obtain an adherent coating and, in particular, further indicate that a particular effect is attainable in all cases for the adhesiveness "in that" chlorinated diphenyl is added (page 2, penultimate paragraph of translation of German application No. 25605), we feel that any argument based on the testimony adduced on behalf of Pinsky et al to the effect that a pretreatment of the polyethylene surface is a necessary prerequisite for the adhesion of an epoxy film thereto would be directed to the question of operability, and contrary to the statement by Pinsky et al in their brief, we have been unable to find where such a question had been raised before the Primary Examiner during the motion period. Pinsky et al, not having raised the question of operability of the Kamp et al disclosure before the Primary Examiner nor having set forth any sufficient reasons for not so raising the question, are not now entitled to be heard at final hearing on the matter. *Creed et al v. Potts*, 25 CCPA 1084, 96 F2d 317, 496 O.G. 9, 37

USPQ 512; Anderson v. Walch, 33 CCPA 774, 152 F2d 975, 584 O.G. 167, 68 USPQ 215; Land v. Dreyer, 33 CCPA 1108, 155 F2d 383, 590 O.G. 6, 69 USPQ 602. Furthermore, even if Pinsky et al had raised the issue of operability in their motion to dissolve, the evidence adduced relative thereto is not convincing. Such evidence consisted entirely of the testimony of Adakonis incident to his priority proofs, and therefore amounts to no more than an ex parte test which has been held to be inadequate to rebut the presumption of operability (cf. Cislak v. Wagner, *supra*; Field v. Knowles, *supra*). It is further noted that Pinsky et al in their patent specification do not indicate that pretreatment is necessary but rather only desirable (column 3, beginning line 4). Accordingly it is our holding that both German application No. 25,605 and the involved U.S. application of Kamp et al have a disclosure sufficient to enable one skilled in the art of polymer chemistry to enhance the resistance to permeation by organic fluids in polyethylene bottles by lining the surface of said bottles with an adherent coating of a cured epoxy resin. In re Nelson et al, *supra*; In re Johnson, *supra*.

Further, we consider that the original claims of the involved Kamp et al application clearly are directed to the same invention as is now in issue in this interference; note in particular original claim 8. Kamp et al are considered to have claimed substantially the same subject matter as that claimed by Pinsky et al within the statutory period and are therefore entitled to make two counts in issue.

As Kamp et al are entitled to rely on the filing date of their German application of April 22, 1955, a date which is prior to the record date of Pinsky et al, Kamp et al are entitled to prevail in this proceeding.

Priority of invention of the subject matter in issue is hereby awarded to Ernst Kamp and Karl Jahn, the senior party.

Warren H. Willner
Examiner of Interferences

Maurice A. Crews
Examiner of Interferences

James S. Bailey
Examiner of Interferences

BOARD OF PATENT INTERFERENCES

[Filed November 5, 1964]
Clarence W. Moore, Solicitor
United States Patent Office
Washington 25, D. C.
Attorney for Defendant

ANSWER TO COMPLAINT

To the Honorable the Judges of the United States District
Court for the District of Columbia

1. The defendant, Edward J. Brenner, Commissioner of Patents, admits that this action arises under the patent laws of the United States and more particularly under 35 U.S.C. 146 and 35 U.S.C. 256. He asserts that, otherwise, he is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 1 of the complaint.

2. He admits the allegations of paragraph 2 of the complaint.

3. He admits that on March 28, 1956, an application Serial No. 574,383 was filed on behalf of plaintiffs Pinsky, Adakonis, and Nielsen, citizens of the United States, and that the Commissioner of Patents issued United States patent 2,830,721 on April 15, 1958. Otherwise,

however, he denies the allegations of the first sentence of paragraph 3 of the complaint. He admits the allegations of the second sentence of said paragraph.

4, 5. He admits the allegations of paragraphs 4 and 5 of the complaint.

6. He denies the allegations of the first sentence of paragraph 6 of the complaint, but admits the allegations of the second and third sentences of that paragraph.

7, 8, 9. He admits the allegations of paragraphs 7, 8, and 9 of the complaint.

10. He denies the allegations of paragraph 10 of the complaint.

11. He admits that appropriate steps were taken in the Patent Office to have Albert E. Adakonis removed from patent No. 2,830,721 under 35 U.S.C. 256, but asserts that, otherwise, he is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 11 of the complaint. He admits the allegations of the second and third sentences of that paragraph.

12, 13, 14. He denies the allegations of paragraphs 12, 13, and 14 of the complaint.

15. He admits the allegations of paragraph 15 of the complaint.

16. He admits the allegations of the first sentence of paragraph 16 of the complaint. He asserts that he is without knowledge or information sufficient to form a belief as to the truth of the allegations of the second sentence of said paragraph.

17. He admits the allegations of paragraph 17 of the complaint.

18. He asserts that he is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 18 of the complaint.

19, 20. He denies the allegations of paragraphs 19 and 20 of the complaint.

21. He denies that issuance of a second patent to Kamp et al pending final adjudication of this litigation is contrary to sound public policy,

and is without statutory or constitutional basis. He asserts that, otherwise, he is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 21 of the complaint.

22. He admits that the plaintiffs have filed before the Commissioner of Patents a petition to withhold the issuance of a patent to Kamp et al pending a final adjudication of this litigation, but, otherwise, he denies the allegations of paragraph 22 of the complaint.

Respectfully submitted,

/s/ C. W. Moore
Solicitor, United States Patent Office
Attorney for Defendant

November 4, 1964
[Certificate of Service]

[Filed December 8, 1964]

ORDER

The Court having considered plaintiffs' motion for preliminary injunction, plaintiffs' motion to strike portions of the answer, and defendants' motion to dismiss for improper service and lack of jurisdiction over the persons of defendants; and the Court having considered the opposition to these motions, it is, this 8th day of December, 1964,

ORDERED, that plaintiffs' motion for preliminary injunction, pursuant to the policy express in Monaco v. Watson, 106 U.S. App. D.C. 142, 270 F.2d 335 (1959), be, and hereby is, denied, and

FURTHER ORDERED, that plaintiffs' motion to strike portions of the answer be, and hereby is, granted with respect to Prayer I, but denied as to the remainder, and

FURTHER ORDERED, that defendants' motion to dismiss for improper service and lack of jurisdiction over the person of defendants

be, and hereby is, denied, the service heretofore made being deemed by the Court, pursuant to 35 U.S.C. 146, as adequate under the circumstances of this case.

JOSEPH R. JACKSON
United States District Judge

[Filed January 5, 1965]

NOTICE OF APPEAL TO COURT OF APPEALS

Notice is hereby given that Monsanto Company, Jules Pinsky, Albert E. Adakonis and Alvin R. Nielsen, Plaintiffs above named, hereby appeal to the United States Court of Appeals for the District of Columbia Circuit from the order of the District Court of the District of Columbia denying Plaintiffs' motion for preliminary injunction, the order having been entered in this action on December 8, 1964.

Dated: January 5, 1965

BURNS, DOANE, BENEDICT, SWECKER & MATHIS

By/s/ Wayne L. Benedict
Attorneys for Appellants
Monsanto Company, Jules
Pinsky, Albert E. Adakonis
and Alvin R. Nielsen

RELEVANT DOCKET ENTRIES

1964

Sep. 25	Complaint, appearance, Exhibit A & B
Sep. 25	Motion of plaintiffs for preliminary injunction, Exhibit
Sep. 30	Supplemental Motion of plaintiffs for preliminary injunction, Exhibit
Oct. 6	Opposition of defendant #3 to motion for preliminary injunction and to the supplemental motion. Appearance C. W. Moore, Solicitor
Oct. 7	Opposition of defendant #1 and #2 to plaintiff's motion for preliminary injunction and supplemental motion for preliminary injunction; memorandum
Oct. 15	Memorandum of plaintiff in support of motion for preliminary injunction
Oct. 15	Motion of defendants #1 and #2 to dismiss
Oct. 15	Answer of defendants #1 and #2 to complaint, Exhibit 1, 2 and 3, Appearance of Paul M. Craig, Jr.
Oct. 21	Opposition of plaintiff to defendant's motion to dismiss
Oct. 23	Reply by defendants #1 and #2 to plaintiff's memorandum in support of plaintiff's motion for preliminary injunction; exhibits 1, 2 & 3
Oct. 26	Reply of defendants #1 and #2 to plaintiff's opposition to defendant's motion under rule 12.
Oct. 27	Reply by Commissioner of Patents to plaintiffs' memorandum in support of plaintiffs' motion for preliminary injunction; exhibit
Oct. 30	Reply of plaintiffs to replies by defendants to plaintiff's memo in support of plaintiff's motion for preliminary injunction
Nov. 3	Motion of plaintiffs to strike certain portions of defendants' answer and prayer
Nov. 5	Answer of defendant #3 to complaint
Nov. 5	Calendared
Nov. 12	Opposition of defendants #1 and #2 to motion to strike certain portions of defendants' answer and prayer
Dec. 8	Order denying motion of plaintiffs for preliminary injunction; granting motion of plaintiffs to strike Prayer I of answer of

JA.65

defendants #1 and #2 and denying motion of defendants #1 and #2 to dismiss, Jackson, J.

Dec. 24 Transcript of proceedings of Oct. 16, 1964
1965
Jan. 5 Notice of appeal of plaintiffs

CLERK'S CERTIFICATE

I, Harry M. Hull, Clerk of the United States District Court for the District of Columbia, do hereby certify the annexed to be the original pleadings, including Reporter's Transcripts of Proceedings (2) filed December 24, 1964 and January 25, 1965, and other papers on file in the above entitled cause, and a true and correct copy of the docket entries, as they appear of record in this office; said originals and copy being transmitted to the United States Court of Appeals for the District of Columbia Circuit, to constitute the Record on Appeal.

In Testimony Whereof, I hereunto subscribe my name and affix the seal of said Court, at the City of Washington, this 4th day of February, 1965.

Harry M. Hull, Clerk

BRIEF FOR APPELLEE, EDWARD J. BRENNER,
COMMISSIONER OF PATENTS

United States Court of Appeals
FOR THE DISTRICT OF COLUMBIA CIRCUIT

Appeal No. 19,171

MONSANTO COMPANY, ET AL., APPELLANTS

v.

ERNST KAMP, KARL JAHN, AND EDWARD J. BRENNER,
COMMISSIONER OF PATENTS, APPELLEES

Appeal from An Order of the United States
District Court for the District of Columbia

United States Court of Appeals
for the District of Columbia Circuit

FILED APR 1 1965

CLARENCE W. MOORE,
Solicitor, United States Patent Office
Attorney for Edward J. Brenner,
Commissioner of Patents, Appellee.

Nathan J. Paulson
CLERK

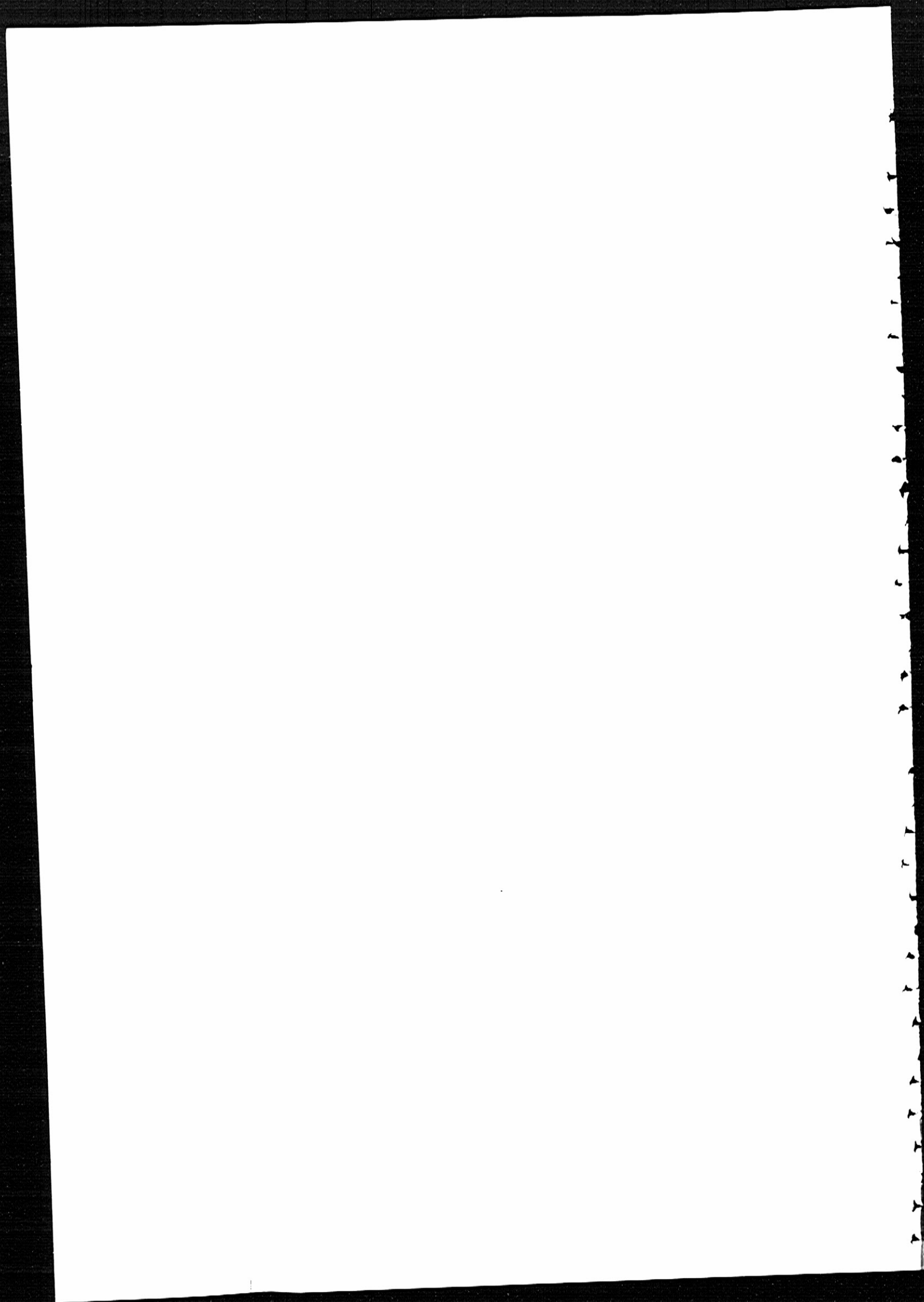
1. The first part of the document is a list of names and dates, which appears to be a record of some kind. The names are written in a cursive script, and the dates are in a more formal, printed style. The list is organized into two columns, with names on the left and dates on the right.

APPEAL NO. 19,171

STATEMENT OF QUESTION PRESENTED

In the opinion of the Commissioner of Patents, the single question presented is:

Did the District Court err in denying appellants' motion for a preliminary injunction to restrain the Commissioner, during the pendency of a civil action under 35 U.S.C. 146, from issuing a patent on the application of appellants' successful opponents in an interference, involving appellants' patent?



INDEX

	Page
Statement of Question Presented	I
Jurisdictional Statement	1
Summary of Argument	2
Argument	2
Conclusion	8

Authorities Cited

Cases:

Commissariat A L'Energie Atomique v. Watson, 107 U. S. App. D. C. 85, 274 F.2d 594	5
Kling v. Haring, 56 App. D. C. 153, 11 F.2d 202, cert. den. 271 U. S. 671	6
Monaco v. Watson, 106 U. S. App. D. C. 142, 270 F.2d 335	2, 3, 6
Owen v. Heimann, 56 App. D. C. 232, 12 F.2d 173, cert. den. 271 U.S. 685	7

Statutes:

28 U. S. C. 1292 (Act June 25, 1948, c. 646, § 1, 62 Stat. 869. As amended Oct. 31, 1951, c. 655, § 49, 65 Stat. 726; July 7, 1958, Pub. L. 85-508, § 12(e), 72 Stat. 348; Sept. 2, 1958, Pub. L. 85-919, 72 Stat. 1770)	1
35 U. S. C. 135	2, 3, 6
35 U. S. C. 146	3

.

United States Court of Appeals
FOR THE DISTRICT OF COLUMBIA CIRCUIT

Appeal No. 19,171

MONSANTO COMPANY, ET AL., APPELLANTS

v.

**ERNST KAMP, KARL JAHN, AND EDWARD J. BRENNER,
COMMISSIONER OF PATENTS, APPELLEES**

BRIEF FOR THE COMMISSIONER OF PATENTS

JURISDICTIONAL STATEMENT

Appellants (J.A. 11) would appear to have predicated jurisdiction in the United States District Court for the District of Columbia over their motion for preliminary injunction as originally brought, and as supplemented (J.A. 17), on Rule 65(a) and Rule 65(d) of the Federal Rules of Civil Procedure.

This Court has jurisdiction upon appeal to review the order (J.A. 62) of the District Court denying said motion by virtue of 28 U.S.C. 1292 (Act June 25, 1948, c. 646, § 1, 62 Stat. 869. As amended Oct. 31, 1951, c. 655, § 49, 65 Stat. 726; July 7, 1958, Pub. L.

85-508, § 12(e), 72 Stat. 348; Sept. 2, 1958, Pub. L. 85-919, 72 Stat. 1770).

SUMMARY OF ARGUMENT

1. The statute, 35 U.S.C. 135, called for the District Court to apply the policy of *Monaco v. Watson*, 106 U.S. App. D.C. 142, 270 F.2d 335, to the present case, and it does apply.

2. Appellants have not shown irreparable damage from the prompt issuance of a patent to their opponents in interference.

3. It is up to the Commissioner to determine whether or not a (second) patent should so issue, and his determination must stand absent the showing of any abuse of discretion.

4. The statute, 35 U.S.C. 135, allows issuance of such a second patent.

5. Issuance of such a patent would not be unconstitutional.

ARGUMENT

The order of the District Court denying appellants' motion for preliminary injunction is not assailable by reason of any point raised by appellants in their "Statement of Points" (Brief, page 6).

The statute, 35 U.S.C. 135, called for the District Court to apply the policy of *Monaco v. Watson*, 106 U.S. App. D.C. 142, 270 F.2d 335, to the present case. Here, as in the cited case, the losing party to a patent interference in the Patent Office seeks to restrain the Commissioner of Patents from issuing a

patent to the winning party while there pends a suit under 35 U.S.C. 146 to review the award of priority. As this Court recognized in the cited case, the statute provides that the "question of priority of invention shall be determined by a board of patent interferences * * * and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor"; and it "means just what it says". The operative words of the statute (quoted by this Court), respecting issuance of a patent to the winning party, draw no distinction as to whether the losing party is an applicant, as in the cited case, or the losing party is a patentee, as in the present case. The Commissioner so found (J.A. 16, second sentence) in denying appellants' petition (J.A. 13) to withhold issuance of a patent to their opponents. The operative and quoted words are properly general respecting issuance of the patent, in that they follow the provisions, set forth in the first sentence of 35 U.S.C. 135, for the declaration of (1) an interference of "an application * * * for a patent" with "any pending application", or (2) an interference of "an application * * * for a patent" with "any unexpired patent", and for the giving of notice "to the applicants, or applicant and patentee, as the case may be".

In the *Monaco* case, this Court stated that the policy of 35 U.S.C. 135 is clear. The explanation, there, of the policy applies equally to the present case. In fact, this Court's very language fits exactly the situation here with the change, as indicated below, of a single word:

"The decision of the board of patent interferences is presumably, though not conclusively, correct. If Hoffman, to whom the board awarded priority, gets the patent, he gets no more than is presumably his. To withhold the patent from him for the benefit of applicants [others] who presumably are not entitled to it would serve no useful purpose. If the appellants win their suit under § 146 their rights will be protected, even if the Commissioner has issued the patent to Hoffman in the meantime, for § 135 provides that a 'final judgment adverse to a patentee * * * shall constitute cancellation of * * * the patent'."

In their motion for a preliminary injunction, as brought and as supplemented, appellants proffered no showing that they will suffer irreparable injury from the prompt issuance of a patent to their opponents. (Note J.A. 20, paragraph 3). Even now they are content to charge (Brief, page 6, Point (2)) that such issuance "may irreparably damage Appellant, Monsanto". Appellants do now suggest (Brief, page 7, final paragraph; page 8, first paragraph) that should the patent issued to their opponents continue to "contain claims in addition to, but not patentably distinct from, the counts of the interference", presumed cancelled, Monsanto, in view of its license from the opponents (see Brief, page 3, first paragraph; J.A. 29) and the accompanying estoppel, "would be in the position of having to continue to pay royalty or risk litigation as an infringer". The quandary appellants thus would concoct is too fine spun for the practical world of patents. Appellants concede (Brief, page 3, third sentence) that the claims pending in the

application of their opponents "may or may not be patentably distinct" from the counts of the interference. The license agreement, also, specifies (J.A. 31, paragraph 2.03) that the "obligation to pay running royalties * * * shall continue only so long as any patent issued to KAMP et al from the licensed application has not been rendered ineffective by any appeal from any decision favorable to KAMP et al in interference Number 91,682 * * *." Again, the premise that the additional claims are "not patentably distinct" assumes their invalidity. And, finally, the position Monsanto says it would be in, is of its own doing, arising from its negotiation of the license agreement and not from the issuance of a patent to the opponents by the Patent Office. Plainly, it was incumbent upon Monsanto to protect itself, by proper provision in the license agreement, from "having to pay royalties which can never be recovered even though Appellants should ultimately prevail on the interference issues" (see Brief for Appellants, page 8, third paragraph).

The Commissioner, rather than the appellants, is charged with the duty of determining whether prompt issuance of a patent to appellants' opponents would be "adverse to the public interest", and that duty is exclusive with the Commissioner. It, accordingly, does not suffice for appellants to conjure up effects, so adverse. They must show that the effects are so great and so manifest that issuance of the patent would amount to abuse of discretion, as lacking "any basis in reason or common sense" *Commissariat A L'Energie*

Atomique v. Watson, 107 U.S. App. D.C. 85, 274 F.2d 594.

The question of whether the statute, 35 U.S.C. 135, allows issuance now of the patent to appellants' opponents was fully briefed by the Commissioner in his reply (J.A. 39, see J.A. 40 and 41) to appellants' memorandum in support of their motion for preliminary injunction (J.A. 34 to 39). Accordingly, reference merely is made to this reply. The negative answer appellants would give the question, it is there shown, would lack accord with the rules of grammar, with legislative history, and with the policy delineations of the *Monaco* case.

Appellants contend (Brief, page 10, first sentence) that to grant a second patent, to their opponents, prior to a final judicial determination of priority of invention, derogates from the exclusive rights granted to them, and "deprives" them "of property rights without the due process of law as guaranteed by our Constitution in the Fifth Amendment". The answer to this contention is, of course, to be found in the fact that patents are creatures of statute. In *Kling v. Haring*, 56 App. D.C. 153, 11 F.2d 202, cert. den. 271 U.S. 671, this Court said:

"The right to a patent is purely statutory, and it was clearly within the constitutional power of Congress to prescribe to whom a patent should issue, upon what terms and conditions a patent should issue, and the proceeding to be taken after its issuance. That exercise of power by the Congress, far from being a violation of section 8 of article 1 of the Constitution, is in strict accord-

ance with it, inasmuch as such terms, conditions, and proceedings are designed to secure to the real inventor the exclusive right to his discovery or invention.

Neither can it be successfully contended that the exercise of the powers conferred by Congress and the taking of the proceedings prescribed by law constitute a violation of the Fifth Amendment. The powers granted and the proceedings provided for deprive no person of his property, in view of the fact that they are designed to accomplish, and accomplish, nothing more than the determination of the right to the invention, and the right to enjoy its benefits for the limited period prescribed."

In *Owen v. Heimann*, 56 App. D.C. 232, 12 F.2d 173, cert. den. 271 U.S. 685, this Court further said:

"The issuance to Owen of a patent by the Patent Office vested in him no property right, of which he could not be deprived by the interference proceedings provided for by section 4904 of the Revised Statutes (Comp. St. § 9449), or by the suit in equity contemplated by section 4915 of the Revised Statutes (Comp. St. § 9460). The right to a patent is purely statutory and Congress has full power to prescribe to whom and upon what terms and conditions a patent shall issue. Every patentee takes his patent with full knowledge that his claim to priority of invention may be attacked in the manner provided by law and that if it be successfully assailed, his patent is rendered worthless without leaving any ground for complaint that his constitutional rights have been invaded."

Appellants' contention (Brief, page 12, first paragraph) that the Commissioner lacks jurisdiction now to issue a second patent was disposed of in the *Monaco* case.

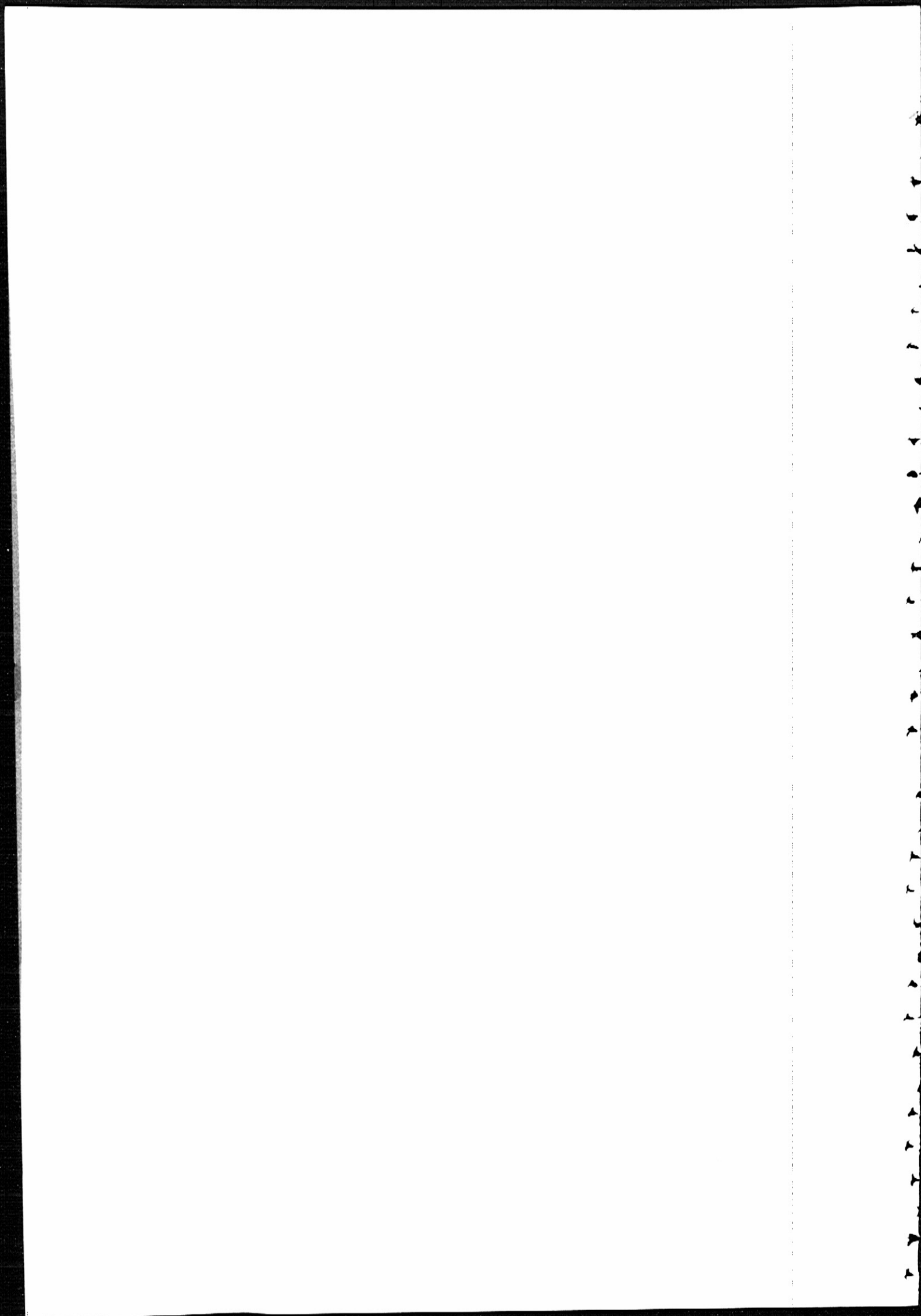
CONCLUSION

The District Court, it is submitted, correctly denied appellants' motion for a preliminary injunction. Affirmance of the order entered below, therefore, is requested.

Respectfully submitted,

CLARENCE W. MOORE,
Solicitor, United States Patent Office
Attorney for Edward J. Brenner,
Commissioner of Patents, Appellee.

April 1965



BRIEF FOR APPELLEES ERNST KAMP AND KARL JAHN

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 19,171

MONSANTO COMPANY,
JULES PINSKY,
ALBERT E. ADAKONIS, and
ALVIN R. NIELSEN,
Appellants,

v.

ERNST KAMP,
KARL JAHN,
and
EDWARD J. BRENNER,
Commissioner of Patents
Appellees

*Appeal from the United States District Court
for the District of Columbia*

United States Court of Appeals
for the District of Columbia Circuit

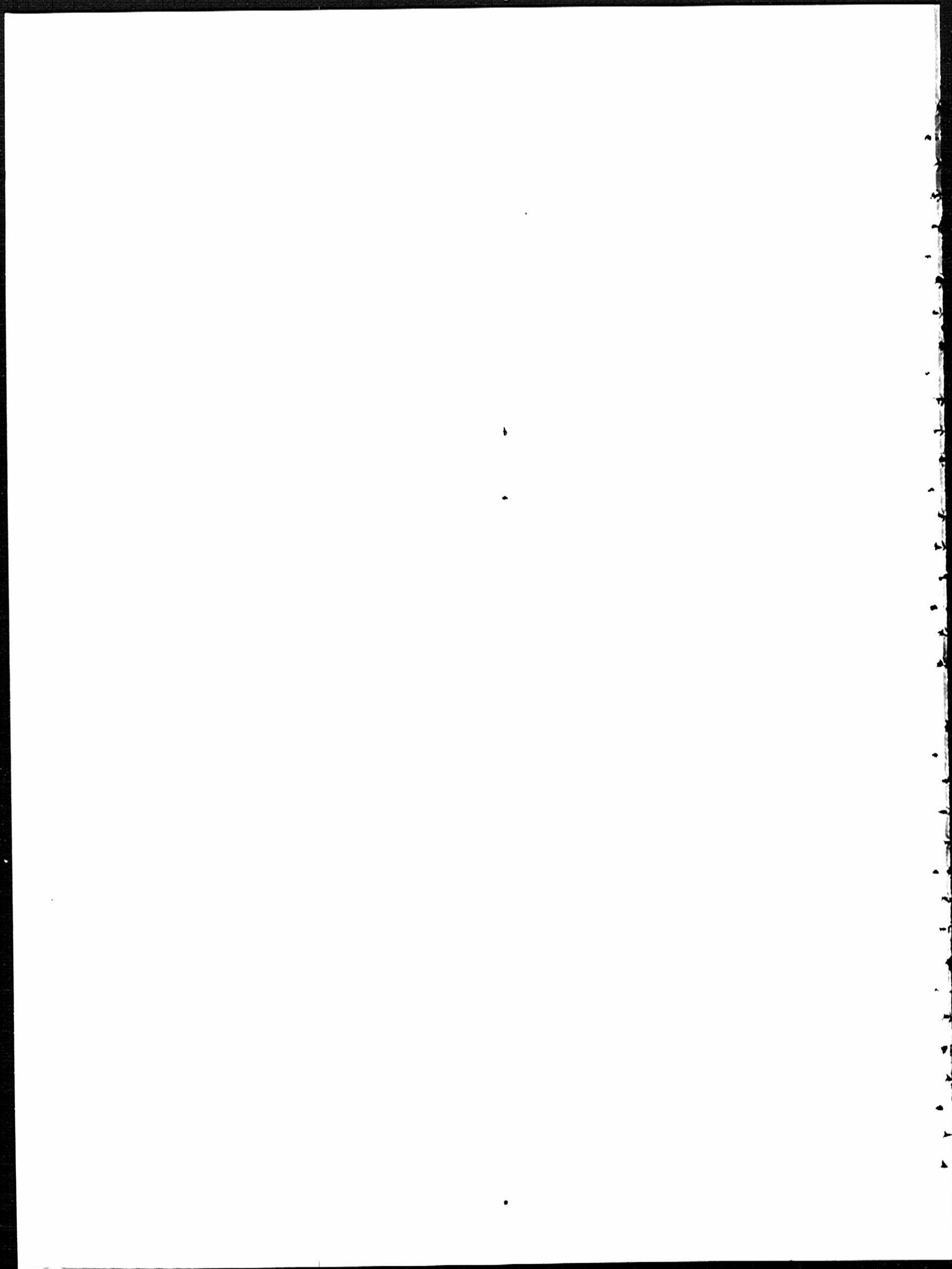
FILED APR 14 1965

Nathan J. Paulson
CLERK

PAUL M. CRAIG, JR.

Pennsylvania Building
Washington, D. C. 20004

Attorney for Kamp and Jahn

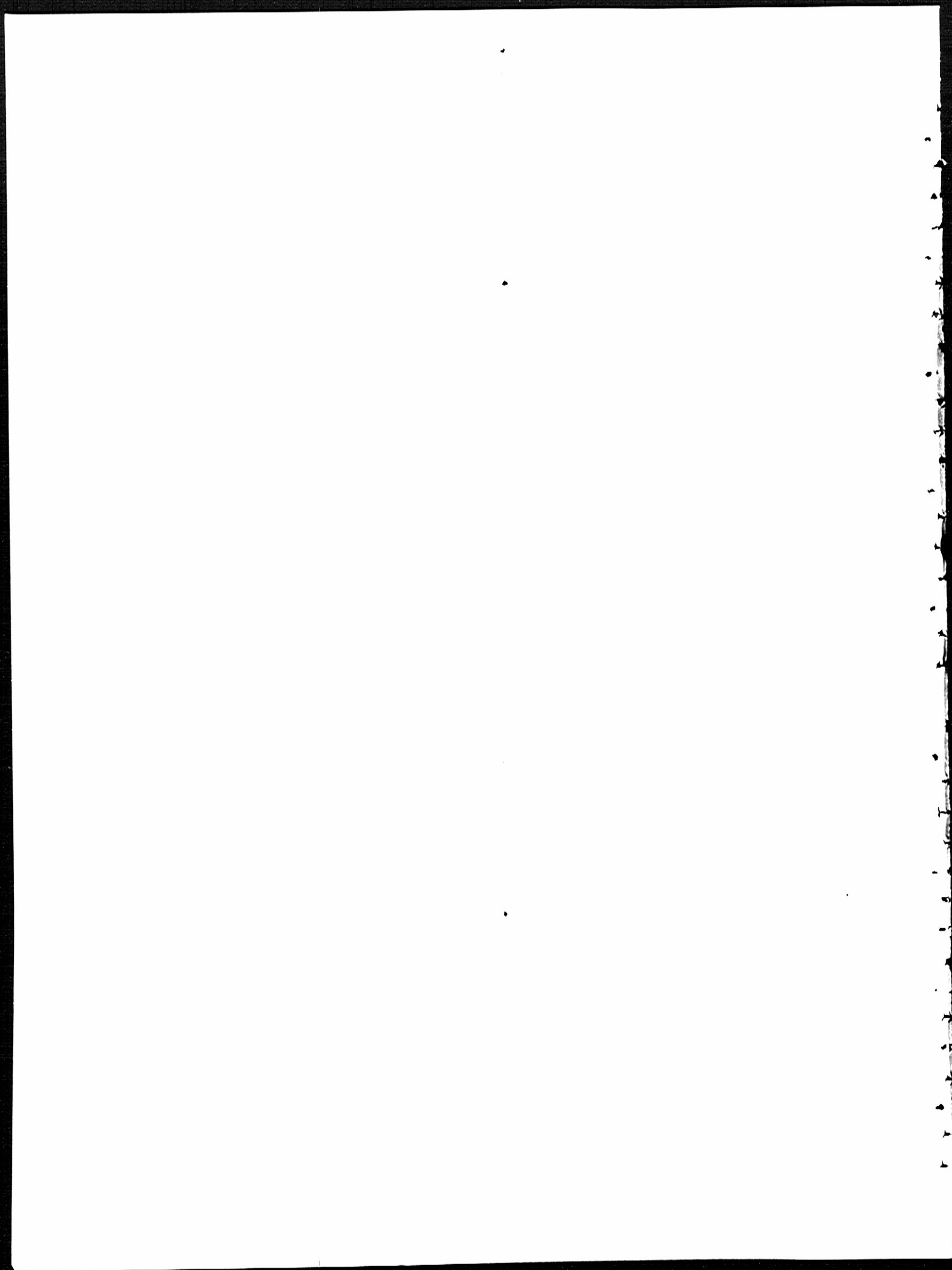


(i)

STATEMENT OF QUESTION PRESENTED

In the opinion of appellees, Kamp et al, the single question presented is:

Did the District Court err in denying appellant's motion for a preliminary injunction to restrain the Commissioner, during the pendency of Civil Action under 35 U.S.C. 146, from issuing a patent on appellees' Kamp et al application to whom priority was awarded in an Interference before the U. S. Patent Office.



(iii)

INDEX TO BRIEF

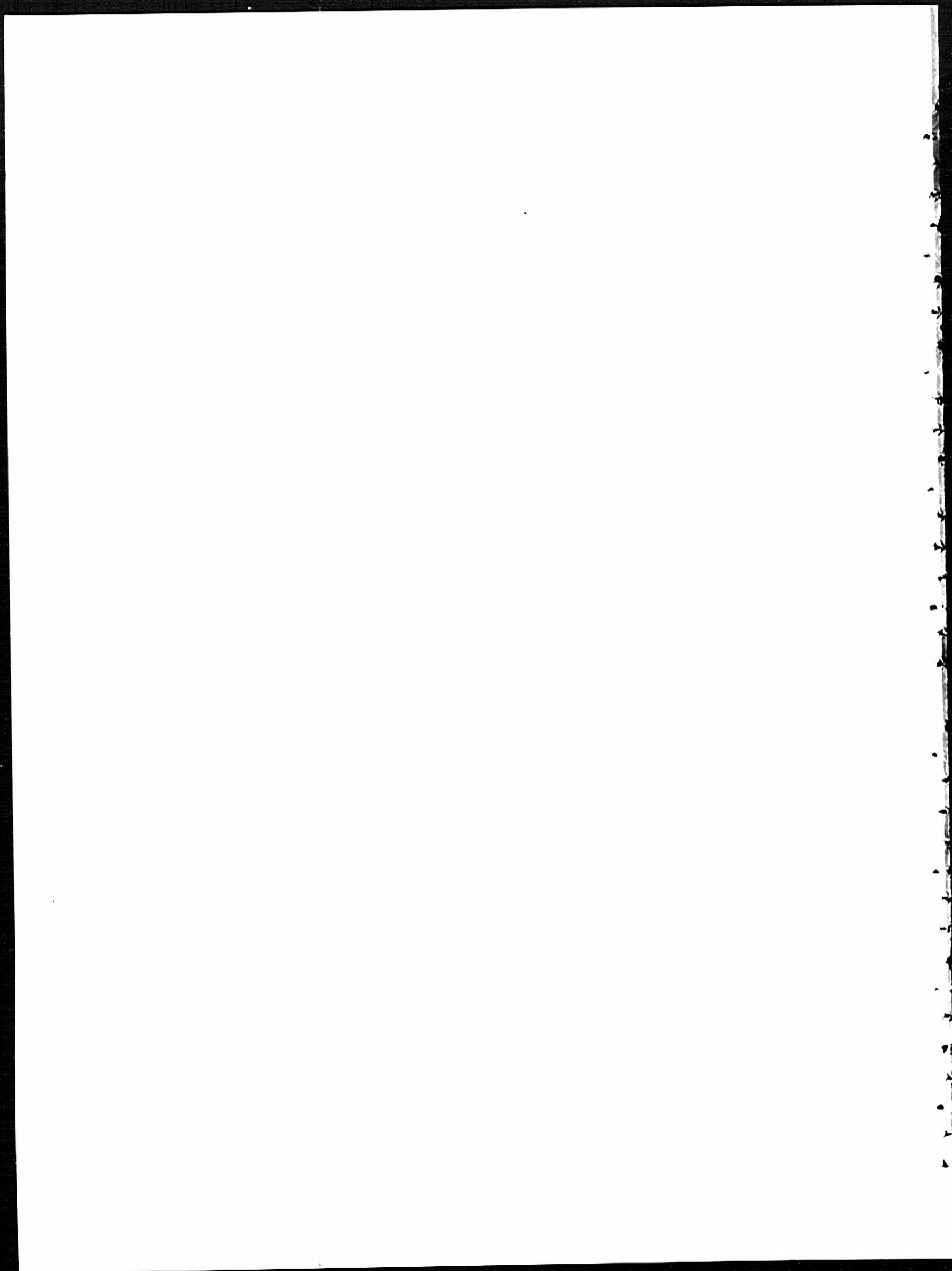
STATEMENT OF QUESTION PRESENTED	i
STATUTES	1
SUMMARY OF ARGUMENT	3
ARGUMENTS	4
CONCLUSIONS	6

TABLE OF AUTHORITIES CITED

Childers Foods, Inc. v. Rockingham Poultry Marketing Co-op, Inc. et al, 203 F. Supp. 794, 133 USPQ 648	4
Cover v. Schwartz, 30 F.Supp. 261, 44 USPQ 67	4
Dubil v. Rayford Clamp and Co., CCA-9, 184 F.2d 899	6
Heston v. Kuhlke, 81 F.Supp. 913, affirmed 179 F.2d 222	6
Park-In Theater v. Perkins, CCA-9, 190 F.2d 137	6
Smalley v. The International Nickel Co., Inc., 114 USPQ 140	4

STATUTES

35 U.S.C. 282	2
35 U.S.C. 285	2
35 U.S.C. 287	3



United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 19,171

MONSANTO COMPANY,
JULES PINSKY,
ALBERT E. ADAKONIS, and
ALVIN R. NIELSEN,

Appellants,

v.

ERNST KAMP,
KARL JAHN,
and
EDWARD J. BRENNER,
Commissioner of Patents

Appellees

*Appeal from the United States District Court
for the District of Columbia*

BRIEF FOR APPELLEES ERNST KAMP AND KARL JAHN

STATUTES INVOLVED

The following statutes are believed pertinent to the issue raised in this appeal:

35 U.S.C. 282, Presumption of validity; defenses

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(1) Noninfringement, absence of liability for infringement or unenforceability,

(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,

(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title,

(4) Any other fact or act made a defense by this title.

In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipation of the patent in suit or, except in actions in the United States Court of Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires. July 19, 1952, c. 950, § 1, 66 Stat. 812.

35 U.S.C. 285, Attorney fees

The court in exceptional cases may award reasonable attorney fees to the prevailing party. July 19, 1952, c. 950, § 1, 66 Stat. 813.

35 U.S.C. 287, Limitation on damages; marking and notice

Patentees, and persons making or selling any patented article for or under them, may give notice to the public that the same is patented, either by fixing thereon the word "patent" or the abbreviation "pat.", together with the number of the patent, or when, from the character of the article, this cannot be done, by fixing to it, or to the package wherein one or more of them is contained, a label containing a like notice. In the event of failure so to mark, no damages shall be recovered by the patentee in any action for infringement except on proof that the infringer was notified of the infringement and continued to infringe thereafter, in which event damages may be recovered only for infringement occurring after such notice. Filing of an action for infringement shall constitute such notice. July 19, 1952, c. 950, § 1, 66 Stat. 813.

SUMMARY OF ARGUMENT

Appellants argue in this appeal in support of their motion (a) public interest and (b) private interest allegedly warranting an injunction under the circumstances of the present appeal.

As to the (a) public interest, the issuance of a patent to appellees Kamp et al on their application involved in the Interference in question at the earliest possible is in the interest of the public as the 17-year term of such patent starts to run from the date of issuance of such patent and in effect lengthens the more the total period, a valid claim exists to the subject matter involved in the Interference the later such patent issues.

As to the (b) private interest, the original draft of the agreement (J.A. 30-34) was prepared by appellants including Section 2.03 thereof, and appellants should not be heard to complain of the effects of such agreement voluntarily sought and entered into between appellants and appellees Kamp et al.

ARGUMENTS

Appellees Kamp et al agree with the arguments presented by the Commissioner of Patents in the latter's brief. However, contrary to the arguments made by appellants, it is in the public interest if a patent issues to Kamp et al as soon as possible. The Pinsky et al patent 2,830,721 (J.A. 10) issued on April 15, 1958. Thus, if no Interference had been declared, the public would be free to use the inventions described and claimed in this patent after April 15, 1975. Any second patent, to issue to appellees Kamp et al to the same invention as contained in claims 1 and 7 of the Pinsky et al patent 2,830,721, also having a term of seventeen years, would in effect extend against the public the 17-year monopoly by the length of time between the issuance of the Pinsky et al patent and that of any Kamp et al patent, i.e., would the more extend such monopoly against the public the greater the delay of the issuance of the patent to Kamp et al. Since the decision of the Board of Interference Examiners (J.A. 47-60) awarded priority to appellees Kamp et al, finding at the same time against appellants on numerous grounds, there is at least substantial probability that appellees Kamp et al will also be successful in the action now before the District Court. Hence, the public interest, if anything, requires the earliest possible issuance of any patent to Kamp et al that is to be ultimately issued in all probability.

As to any possible infringement action to be brought on a patent to be issued to Kamp et al, the procedure followed by many Courts under analogous situations, staying entry of a final decision pending final adjudication of the question of priority would negate possible injury or inconvenience to the public. *Childers Foods, Inc. v. Rockingham Poultry Marketing Co op, Inc., et al*, 203 F. Supp. 794, 133 USPQ 648; *Cover v. Schwartz*, 30 F. Supp. 261, 44 USPQ 67; *Smalley v. The International Nickel Co., Inc.*, 114 USPQ 140.

The Court's attention is also respectfully directed to paragraphs 15 and 16 of appellees answer (J.A. 24) setting forth that at present, in the belief of appellees, no other infringers, other than appellant Monsanto, exist of the invention defined by claims 1 and 7 of the Pinsky et al patent 2,830,721.

Appellants also complain that under the license agreement, voluntarily entered into by appellants, they would have to pay royalties under the agreement during the pendency of this action once a patent to appellees Kamp et al issues. Appellees Kamp et al clearly foresaw such possibility and therefore accepted the proposed agreement (J.A. 29 through 34) including the low royalty rates of Section 2.01 (J.A. 30) and Section 9.01 (J.A. 34) of this agreement. Lack of foresight on the part of appellants, however, is respectfully submitted to be legally insufficient to warrant a rewriting of such private agreements between the parties, the more so as no irreparable injury can be shown to exist for appellants while irreparable injury would arise to appellees Kamp et al from such effective modification of the license agreement. Since appellants have the right under Article IV of the license agreement (J.A. 32) to cancel the agreement at any time as provided in Section 4.09, and since 35 U.S.C. 282 provides for any defenses that can be raised in any subsequent infringement action, no irreparable injury would arise to appellants. On the other hand, in view of the limitations on the recovery of damages under 35 U.S.C. 287, irreparable injury to appellees Kamp et al would result from a granting of the injunction as the non-issuance of the patent would prevent appellees Kamp et al from giving notice to appellants in case the latter should now decide to cancel the agreement.

CONCLUSION

It is respectfully submitted that the Court below correctly refused to grant the motion for preliminary injunction, and the order refusing to grant such motion should therefore be affirmed.

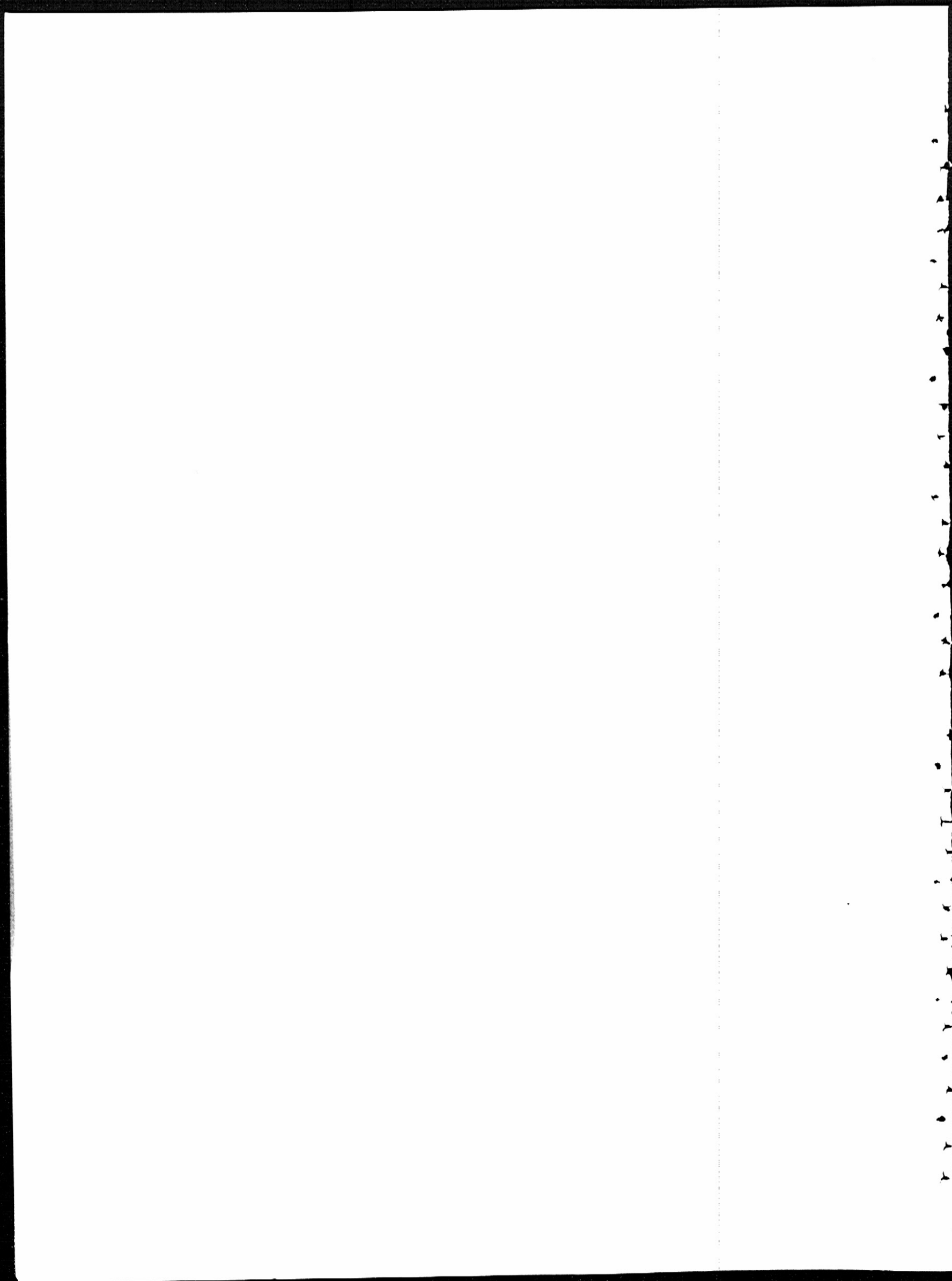
Since this appeal is obviously presented only to prevent the taking effect of the license, i.e., is interposed to modify the existing license agreement and/or for dilatory purposes, appellees respectfully pray for costs and attorneys' fees in accordance with the decisions in *Park In Theater v. Perkins*, CCA-9, 190 F.2d 137; *Dubil v. Rayford Clamp and Co.*, CCA-9, 184 F.2d 899; *Heston v. Kuhlke*, 81 F. Supp. 913, affirmed 179 F.2d 222.

Respectfully submitted,

PAUL M. CRAIG, JR.

Pennsylvania Building
Washington, D. C. 20004

Attorney for Kamp and Jahn



REPLY BRIEF FOR APPELLANTS

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 19,171

MONSANTO COMPANY, *et al.*,

Appellants,

v.

ERNST KAMP,

KARL JAHN,

and

EDWARD J. BRENNER,

Commissioner of Patents,

Appellees.

*Appeal From the United States District Court
for the District of Columbia*

United States Court of Appeals
for the District of Columbia Circuit

FILED APR 16 1965

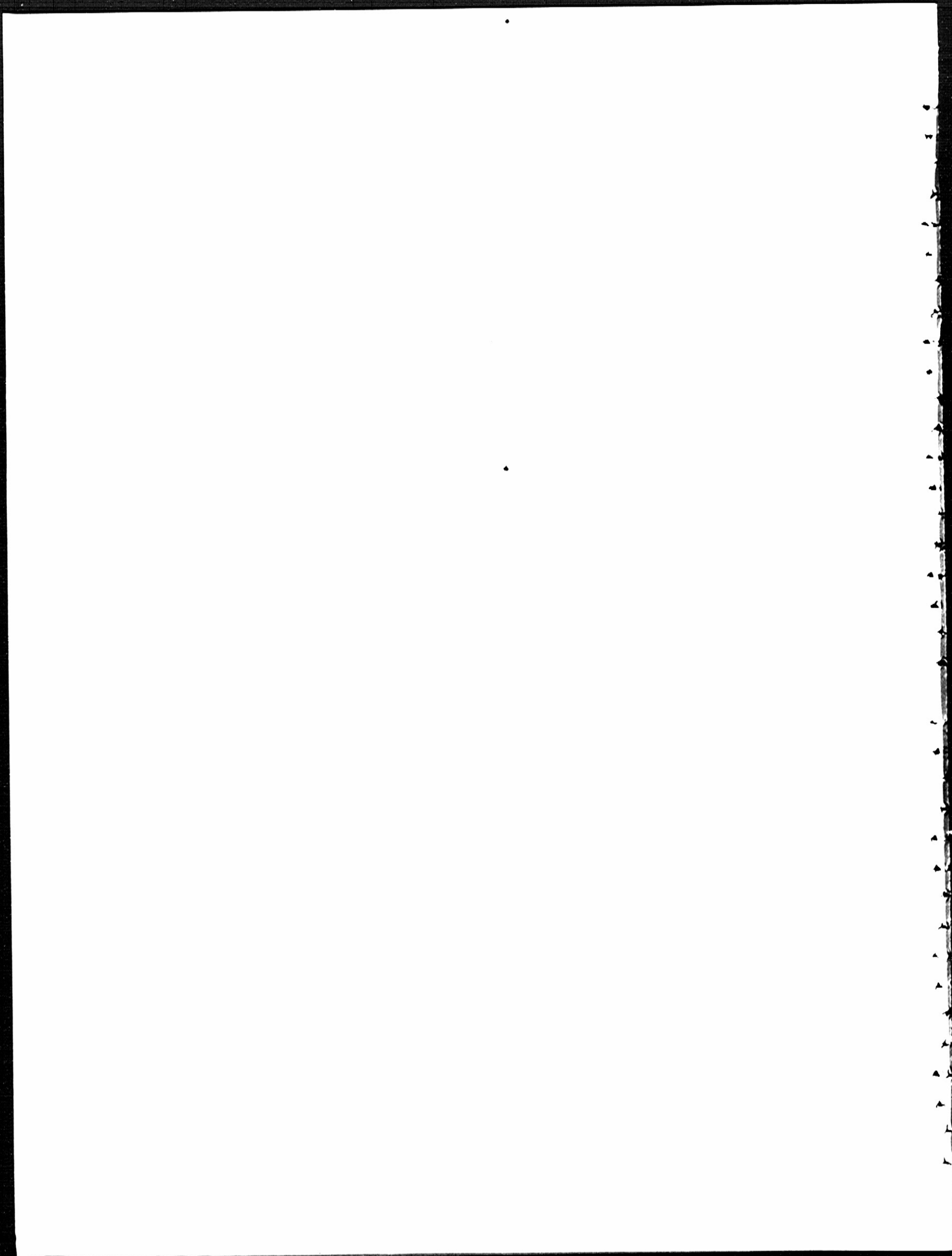
Of Counsel *Nathan J. Paulson*
CLERK

James P. Burns
Herbert B. Roberts
Peter H. Smolka

W. L. BENEDICT

Burns, Doane, Benedict,
Swecker & Mathis
850 Munsey Building
Washington 4, D. C.

Attorneys for Appellants



United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 19,171

MONSANTO COMPANY, *et al.*,

Appellants,

v.

ERNST KAMP,

KARL JAHN,

and

EDWARD J. BRENNER,
Commissioner of Patents,

Appellees.

*Appeal From the United States District Court
for the District of Columbia*

REPLY BRIEF FOR APPELLANTS

It is apparently the Commissioner's position that a final judgment adverse to a patentee constitutes cancellation of the patent. We do not believe that the *Monaco* case stands for that proposition since the Statute states that a

"final judgment adverse to a patentee . . . shall constitute
cancellation of the claims involved from the patent."

— Quoting 35 USC 135

Section 135 is silent as to the effect of an adverse decision on claims not involved in the interference whether they may or may not be patentably distinct from the count of the interference.

In a District Court case of *Sunbeam Corporation v. S. W. Farber, Inc.*, 145 USPQ 36, decided March 25, 1965 subsequent to the filing of this appeal, the Court was faced with some of the problems which did arise by virtue of the precipitous issuance of a patent to a successful applicant, during the pendency of a review by the District Court under Section 146. In that case, after the unsuccessful applicant had brought the action under 146 in the District Court for the Southern District of New York the *ex parte* prosecution of the winning application was resumed in the Patent Office. The successful applicant, Foster, Defendant in the Section 146 action, amended the claims in the application and cancelled the claim involved in the interference. The Commissioner issued the patent, whereupon the Defendant moved for summary judgment to dismiss the action in the District Court on the ground that the issue of priority was now moot.

The Plaintiff, in resisting the motion asserted that some eight of the claims in the Foster patent were directed to common patentable subject matter. The Plaintiff argued that since this was true, he should be permitted to continue to contest priority. The Court agreed with the Plaintiff that the matter was not one to be disposed of on a motion for summary judgment, stating as follows:

"The material issue thus to be decided prior to the issue of priority is the relationship between the claims submitted by the respective parties, the patent subsequently issued, the British Patent No. 603,191,¹ and the count in the interference proceeding.

* * *

¹ This patent was cited for the first time after the prosecution of the Foster application was resumed.

"Accordingly, I am of the view that the issue presented herein, to wit, the scope of the patent issued as compared with the applications and disclosures therein of the respective parties, the count in the interference and the British Patent No. 603,191, is not one to be disposed of summarily and the motion for summary judgment is thus denied."

— Quoting *Sunbeam Corp. v. S. W. Farber, Inc.*
145 USPQ 43, 44

The dilemma presented by this situation is apparent. Once a patent has issued there is a grave question as to whether the District Court acquires jurisdiction under Section 146 to make a determination of the matters (other than priority) enumerated in the *Sunbeam* case.

Section 146 deals only with an action brought by a party to an interference who is dissatisfied with a decision of the Board of Patent Interferences on the question of priority. The subject matter of the action is defined by and confined to the count of the interference which was dealt with by the Board of Patent Interferences. It does not deal with claims directed to common subject matter or with claims which are different from the count of the interference but which might or might not be patentably distinct therefrom.

If this were an appeal to the Court of Customs and Patent Appeals, no patent would have issued, and after the case was decided jurisdiction over the applications involved would be returned to the Commissioner of Patents who would then pass judgment (subject to review) upon what constituted common subject matter, and on what claims in the losers' application were patentably distinct.

But what happens if the Plaintiff in *Sunbeam* should ultimately prevail as to the count immediately involved. Does the Commissioner have the power to issue a second patent with a batch of claims to common subject matter, and if so what is the effect on similar claims in the first issued patent. How, short of litigation, can the issues ever be resolved.

This situation, like those involved in the cases cited in Footnote 2, page 12, of Appellants' Main Brief, are not something "conjured up" by Appellants. The problems become even more severe where two patents are involved.

This is a matter of concern to the public as well as to the parties to the interference. Had the Commissioner refused to issue the patent until after final judgment as to which party is entitled to the count, the intricate and puzzling problems of the *Sunbeam* case could have been avoided. These and other problems discussed in our main brief can be avoided by enjoining issuance of a patent to Kamp.²

The Constitutionality Issue

The Commissioner's Brief at pages 6 and 7 seeks to answer Appellants' position that the granting of a second patent to Kamp et al prior to a final judicial determination of the issues in this case derogates from the exclusive rights issued to them and deprives them of property rights without the due process of law as amended by our Constitution in the Fifth Amendment. He says that:

"The answer to this contention is, of course, to be found in the fact that patents are creatures of statute."

This begs the question as to whether the Congress ever had the power to enact Section 135 if it is to be interpreted as the Appellees contend. The two cases cited by the Commissioner involved foreign patent applications claiming the benefits of the Nolan Act following World War I. The Nolan Act provided that foreign applicants could claim the benefit of an application filed within their countries during the War, if the United States case were filed within a grace period following the pass-

² The Solicitor's Brief argues that Kamp et al were and probably still are prejudiced by the "improvident grant of the patent to the Plaintiffs," and urge that this be brought to an end by issuing Kamp et al a patent before the contest has been decided.

age of the Act. The right to claim the priority of the foreign application depended in part upon reciprocal rights being given to United States citizens by the country of origin.

These two cases only stand for the proposition that the Nolan Act was constitutional, and that the mere issuance of a patent does not conclusively and finally determine the rights under the patent. This, of course, is self-evident. The cases in no way stand for the proposition that the Commissioner of Patents can, as stakeholder, turn over the fruits of the contest to the winner of the first round and during the period when the fight over the stakes is being vigorously contested under Section 146.

Respectfully submitted,

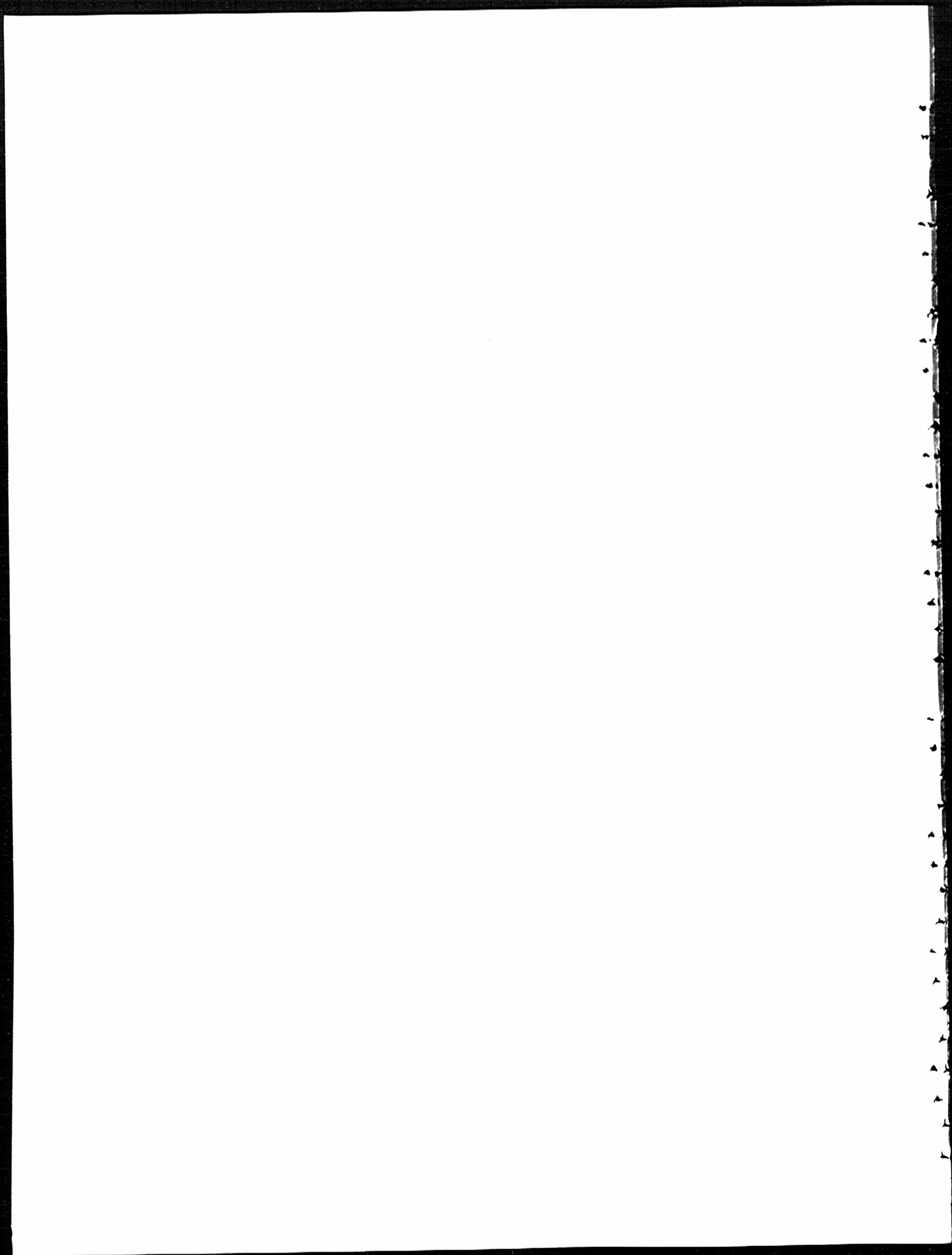
W. L. BENEDICT

Burns, Doane, Benedict,
Swecker & Mathis
850 Munsey Building
Washington 4, D. C.

Attorneys for Appellants

Of Counsel

James P. Burns
Herbert B. Roberts
Peter H. Smolka



United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT *United States Court of Appeals
for the District of Columbia Circuit*

FILED AUG 6 1965

MONSANTO COMPANY ET AL

Appellants,

v.

ERNST KAMP, KARL JAHN, and
EDWARD J. BRENNER,
COMMISSIONER OF PATENTS

Appellees

Nathan J. Paulson
APPEAL NO. 19,171

*To The Honorable Judges of the United States Court of Appeals
for the District of Columbia Circuit:*

PETITION FOR REHEARING

Kamp et al, the defendants-appellees above-named, respectfully submit this petition for a rehearing in the above-entitled cause for the following reasons:

I.

The Court, in its opinion of reversal of the lower court, has clearly failed to apply the principles of equity normally applicable to the granting of preliminary injunctions.

II.

The Court, in its opinion of reversal, has clearly misconceived the basic underlying facts of the instant situation.

III.

The Court, in its opinion of reversal, has clearly misconstrued the statutory provisions applicable to the instant situation and has evolved tests and standards, different from the sole test of abuse of

discretion used heretofore, in determining the propriety of exercise of discretionary authority granted by Congress to the Commissioner of Patents.

ARGUMENTS

I.

It is basic to all injunctive relief, founded on principles of equity, that such relief will be granted only in unusual circumstances which would result in irreparable injury to a party or where such relief is permitted by express authority in the applicable statutes.

(a) Appellants have never alleged irreparable injury nor submitted any facts from which such injury would necessarily follow if a patent were granted now to appellees Kamp et al (aside from the possible payment of royalties on the basis of an obligation sought after and voluntarily entered into by appellant Monsanto).

(b) To the contrary, if the injunction is granted, appellees Kamp et al will suffer irreparable injury from at least the loss of royalty payments as provided by the license agreement (JA. 29-33). Nor would the issuance of a patent to appellees Kamp et al, after years of litigation and appeals, as might be expected in the light of the actions of appellant Monsanto to date to prevent the issuance of a patent to Kamp et al in order to escape royalty payments as provided by the license agreement, have the same value as if it were granted today. Technology does not stand still and appellant Monsanto has admitted of its present crash program in an effort to find a solution circumventing the invention as defined by those claims with respect to which priority was awarded appellees Kamp et al as the first inventors.

Since the statutory provisions¹ preclude damages except on proof of notification of the infringement, appellee Kamp et al would be pre-

¹ 35 U. S. C. § 287 (1958 ed.)

cluded from recovering for any infringement by either appellant Monsanto or third parties except after termination of years of possible dilatory litigation by appellant Monsanto to permit use of the invention without interference by appellees Kamp et al, presumably the first inventors. The gross iniquity in the treatment afforded to the opposing parties in this litigation under the decision of this Court becomes obvious at once when considering that all such rights and privileges would continue to exist until final judgment for appellant Monsanto with respect to its patent, though presumably invalid as a result of the decision of the Board of Patent Interferences of the Patent Office, even if the final judgment is adverse to Monsanto and a second patent were issued to Kamp et al, presumably the first inventors. Developing these thoughts to the unlikely possibility that the decision of the Board of Patent Interferences of the Patent Office is reversed, appellant Monsanto would not be prejudiced in any way by the existence of the second patent to be now issued to appellees Kamp et al because such final judgment would constitute automatic cancellation of the claims involved from the Kamp et al patent pursuant to the express statutory language.²

Appellant Monsanto has argued that in the event of reversal of the decision of the Board of Patent Interferences of the U. S. Patent Office awarding priority to appellees Kamp et al, a patent to be granted to appellees Kamp et al might contain claims which differ from the claims involved in the interference and thus would not be cancelled automatically by operation of law, yet might be unpatentable over the invention of the claims in the interference. Such arguments are obviously invalid to sustain the injunctive relief since the reverse situation would also be true, namely that of the additional thirteen claims of the Pinsky et al patent 2,830,721, assigned to appellant Monsanto, in addition to the two claims involved in the interference, some claims might be invalid over the invention defined by the two claims involved in the interference yet

² 35 U. S. C. § 135 (1958 ed.)

would not be automatically cancelled by operation of law even if the decision of the Board of Patent Interferences were finally sustained. It is respectfully submitted that equity requires at least equal treatment of both parties to this litigation particularly when appellees Kamp et al are presumably the first inventors as a result of the decision by the experts in the U. S. Patent Office.

(c) Since the public is always a silent party to any proceedings involving matters of patent rights, a brief review of the effects of the granting or non-granting of the injunctive relief on its interests is believed appropriate.

The Pinsky et al patent 2,830,721, assigned to appellant Monsanto, was granted on April 15, 1958, and thus would normally expire on April 15, 1975. Were it not for the interference, the public would know that after April 15, 1975, it is completely free to make and use the invention disclosed in this patent. A patent to be granted to Kamp et al expires seventeen years from the date of its granting regardless of the expiration date of Monsanto's patent. This means, assuming the patent to Kamp et al were granted today, it would expire only on August 7, 1982. Assuming further that the decision of the Board of Patent Interferences of the U. S. Patent Office is sustained in the instant litigation, this would mean that the public would be barred at best a total period of twenty-four years from using the invention defined by the counts of the interference, i.e., the seven years barred to date by the existing exclusivity under the Monsanto patent plus the additional seventeen years the Kamp et al patent would run were it granted today. This twenty-four year period of exclusivity is already the minimum period under law during which, under the present circumstances owing to an error by the Patent Office, the public would be barred from using the invention defined by the counts of the interference even if the Kamp et al patent were issued today and irrespective of the date of final decision in this litigation. However, if the issuance of the patent to appellees

Kamp et al is delayed by the injunction, the total period during which the public would be barred from using the invention defined by the counts of the interference would be extended commensurately, still assuming of course that the final judgment will sustain the decision of the Board of Patent Interferences. For example, if the injunction is granted, and if a final judgment sustaining the decision of the Board of Patent Interferences is rendered three years from this date, the total period during which the public would be barred from using the invention would be twenty-seven years. This is so as the exclusive rights under the patent inadvertently granted to appellant Monsanto would continue until final judgment, the statutory provisions³ permitting recovery for up to six years of past infringement prior to the actual filing of an infringement action, provided proper statutory Notice of Infringement⁴ is given (appellant Monsanto being in no way precluded from giving such notice at this time regardless of the outcome of this litigation); the public would indeed be hesitant under such threat of possible liability to use the invention pending the outcome of the final judgment.

On the other hand, assuming that the final judgment reverses the decision of the Board of Patent Interferences, no serious harm would be done to the interests of the public from the granting of the patent to appellees Kamp et al already at this time since the claims involved would be cancelled automatically by operation of law.⁵

Accordingly, it is respectfully submitted that the injunctive relief should be denied if equitable principles are applied to the instant situation.

³ 35 U. S. C. § 286 (1958 ed.)

⁴ 35 U. S. C. § 287 (1958 ed.)

⁵ 35 U. S. C. § 135 (1958 ed.)

II.

In the decision of the majority of the Court, the Court appears to have clearly misconceived the facts underlying the present situation when it stated on page 6

A patent has been issued and was running for some years before Kamp appeared on the scene (Emphasis added).

Monsanto's patent application on which the patent in question was issued, was filed in the Patent Office on March 28, 1956. The application of Kamp et al was filed in the Patent Office about the same time on April 17, 1956, (JA. 11 and 47), i. e., less than a month after the filing of the patent application of the Monsanto patent and was thus copending with the Pinsky et al application from April 17, 1956, until April 15, 1958, when Monsanto's patent was inadvertently issued. The Board of Patent Interferences also held (JA. 59) in that connection

...that the original claims of the involved Kamp et al application clearly are directed to the same invention as is now in issue in this interference; note in particular original claim 8. Kamp et al are considered to have claimed substantially the same subject matter as that claimed by Pinsky et al within the statutory period and are therefore entitled to make two counts in issue (Emphasis added).

Thus, appellees Kamp et al did not appear "on the scene after Monsanto's patent had been issued and was running for some years" as found in the Court's decision but both parties filed an application for the same invention at about the same time, totally unknown to each other in view of the complete secrecy surrounding pending applications in the U. S. Patent Office.⁶

⁶ 35 U. S. C. App. §1.14, 37 C. F. R. § 1.14

As a matter of fact, except for the oversight on the part of the U. S. Patent Office, the statutory provisions⁷ as well as the Rules of Practice⁸ would have normally required the declaration of the interference while both applications were still pending before the Patent Office. The granting of the patent to Pinsky et al was admittedly inadvertent and an oversight on the part of the U. S. Patent Office, as admitted, for instance, in the Reply by Commissioner to "Memorandum in Support of Plaintiffs' Motion for Preliminary Injunction" (J.A. 41, lines 6 through 9) and as again admitted at the time of the oral argument by the Solicitor of the U. S. Patent Office.

Thus, if an interference had been declared between the two applications while still copending, as it should have been except for the oversight by the Examiner in the Patent Office, appellees Kamp et al would now be entitled to the issuance of a patent under the doctrine of the Monaco case⁹. Certainly, appellees Kamp et al should not be penalized for an error on the part of the Patent Office over which they had no control whatsoever, when appellees Kamp et al complied with all statutory requirements and continuously claimed the same invention as claimed in the Monsanto patent from about the same time the Monsanto patent application was filed.

It is respectfully submitted that the granting of the injunctive relief under those circumstances would be to penalize appellees Kamp et al for a mistake and error made by the Patent Office. Clearly, the discretionary authority accorded to the Commissioner of Patents should not be interfered with to correct an error and inadvertence on the part of the Patent Office to the detriment of the appellees Kamp et al merely to assist appellant Monsanto from escaping the obligations under its

⁷ 35 U. S. C. § 135 (1958 ed.)

⁸ 35 U. S. C. App. § 1.201, 37 C. F. R. § 1.201

⁹ Monaco v. Watson, 106 U. S. App. D. C. 142, 270 F2d 335 (1959).

license agreement it had voluntarily sought and undertaken, especially when no injury to the public would follow from the refusal to grant the injunctive relief.

The misconception of underlying facts pointed out above may be possibly due to the absence at oral argument of the Honorable Senior Circuit Judge, who wrote the opinion for the majority of the Court. Hence, a rehearing including an oral re-argument is believed warranted to establish the correct facts of the instant situation.

III.

The decision of the majority of the Court on pages 6 and 7 clearly acknowledges that the statute granted certain discretionary authority to the Commissioner of Patents and that such discretionary authority was the intention of Congress. As a matter of fact, the Court also acknowledges that in "unusual" cases, the Commissioner might have power to grant a second patent by stating:

The reference is apt when applied to a case of two applicants, and perhaps in unusual cases, but is a far cry from a declaration of power in the Commissioner in any and all cases; (Emphasis added).

Nowhere is there any express reference in the statutory language that the authority granted to the Commissioner of Patents is applicable only to situations involving interferences of two applications nor does the statute set forth any standards or tests to be applied in determining the reasonableness of the exercise of such authority. Furthermore, no such standards can be inferred from the legislative history of the statutory provision¹⁰ which would prescribe in what cases the Commissioner has discretionary authority and in what cases such discretionary authority does not exist. Under these circumstances and in the absence of a clear legislative intent to the contrary, it is not a question of whe-

¹⁰35 U. S. C. § 135 (1958 ed.)

ther in the eyes of the Court, a complete stay of all proceeding in the Patent Office pending final adjudication may be preferable or more desirable, but only a question of whether there is any clear abuse of the discretion. Commissariat A L-Energie Atomique v. Watson, 107 U.S. App. D. C. 85, 274 F2d 594.

There has been no finding in the Court's opinion that there has been such abuse of discretion on the part of the Commissioner of Patents in the instant situation as would warrant the granting of the injunctive relief. Indeed, the foregoing analysis clearly indicates that the action that might be taken by the Commissioner of Patents in the absence of the injunction, is reasonable and fair as well as in the interest of the public.

The holding of the Court in the majority opinion on page 7

that, since the Commissioner of Patents has issued a patent valid on its face, he is not free to take action adverse to the validity of that patent while its validity is being litigated in the U. S. Courts. (Emphasis added)

is also clearly erroneous since the patent inadvertently granted to Monsanto by the Commissioner of Patents is now presumably invalid as a result of the decision by the Board of Patent Interferences *Monaco v. Watson*.¹¹ It is noted in that connection that interference files involving a patent are public,¹² not to mention the availability of records involving this cause of action in the District Court below.

It is respectfully submitted that the Court has clearly misconstrued the statutory provisions of 35 U. S. C. § 135, since the statute nowhere contains language, either explicit or to be inferred, which would support

¹¹ *Monaco v. Watson*, 106 U. S. App. D. C. 142, 270 F2d 335 (1959)

¹² 35 U. S. C. App. § 1.11, 37 C. F. R. § 1.11

the restriction of the discretion of authority on the part of the Commissioner of Patents that the majority's opinion now seeks to impose.

The first sentence of Section 135, Title 35 U. S. Code merely acknowledges that, in addition to the normal situation of an interference between two applications, an interference may be declared between an application and a patent in order to provide for an adjudication of the question of priority in the extraordinary situation as in the instant case, where the Patent Office overlooks the interference and issues one of the interfering applications inadvertently as a patent. This opening clause does not emphasize the difference but merely is remedial to make certain that interferences are not limited to situations involving only applications but will also be instituted in the extraordinary situations where the patent is inadvertently granted.

If the second sentence speaks of the authority on the part of the Commissioner to

issue a patent to the applicant who is adjudged the
prior inventor

no inference of differentiation can be deduced from this passage between interferences involving only applications and interferences involving a patent since an authority to grant a patent must of necessity be restricted to an applicant. Certainly, no inference of differentiation should be drawn from statutory language merely by its failure to mention an absurdity, namely the granting of a patent to a party to whom a patent has already been granted.

The final sentence of the first paragraph of Section 135, Title 35, U. S. Code, merely specifies the mandatory effect of a final judgment with respect to the claims of an inadvertently issued patent which were involved in interference proceedings, and sets forth procedures to give notice to the public of such effect. In the absence of this clause, the claims in a patent to an inventor, held not to be the first inventor,

would continue to exist, leaving it to pure chance that a third party might stray across the decision involving the patent in question.

On page 4 of its decision, the majority of the Court indicated that the existence of two patents

is a contradiction to the whole basis of patent issuance.

Admittedly, the Section 102, Title 35, U. S. Code instructs the Commissioner of Patents to issue only one valid patent on any one invention. However, the possibility of issuance of a second patent, either inadvertently or to correct an oversight, inadvertence or error on the part of the Patent Office was clearly contemplated also by other statutory provisions,¹³ setting forth procedures for precisely such situations where two patents were inadvertently issued by the Patent Office for the same invention.

An attempt is made in the decision to distinguish the instant case from the *Monaco* case.¹⁴ While some facts are different from the *Monaco* case in that the instant situation involves an inadvertently issued patent, the same basic issues are again involved in this litigation; namely, whether the discretionary authority bestowed upon the Commissioner of Patents by Congress should be interfered with at the behest of a private party. The prior *Monaco* case¹⁵ clearly held, interpreting Section 135, that Congress intended a departure from the usual effect of staying all procedures below when an action is brought in the District Court under Section 146 for review from the Board of Interferences of the U. S. Patent Office. There are no logical reasons, insofar as the ultimate effect, the public interest and orderly procedure are

¹³35 U. S. C. § 291 (1958 ed.)

¹⁴*Monaco v. Watson*, 106 U. S. App. D. C. 142, 270 F2d 335 (1959)

¹⁵*ibid* 14

concerned in distinguishing the instant situation from the *Monaco*¹⁶ case. In both situations, the only question is whether the Commissioner of Patents should be enjoined from issuing a patent to the presumably first inventor under the authority granted by the statute. Since the Court admitted in its opinion herein that no Congressional intent can be found to distinguish between such situations, and since the statutory language makes no such differentiation, it is respectfully submitted that the statutory interpretation of the majority decision is not only erroneous but in clear conflict with the *Monaco* case.

In the dissenting opinion of the *Monaco* case, the Circuit Judge, now joining the majority of the Court, clearly expressed his complete dissatisfaction with the results as to procedure stemming from the statutory grant of discretionary authority to the Commissioner of Patents by holding that

the Commissioner of Patents does not have jurisdiction to issue a patent until after the termination of proceedings brought under 135 U. S. C. 146.

This view has in effect been adopted now by the majority of the Court in its opinion, even if the decision attempts to differentiate from the prior case of *Monaco v. Watson*.¹⁶ As a matter of fact, any attempt to differentiate the instant situation from the *Monaco* case¹⁶ would result in penalizing appellees Kamp et al for an error on the part of the Patent Office in inadvertently granting the patent to Monsanto because, under the decision of the *Monaco* case,¹⁶ the appellees Kamp et al would now be entitled to their patent had the interference been declared, as it should, between the two copending applications during their co-pendency in the U. S. Patent Office.

It is respectfully submitted that the Court's interpretation of Section 135 must be clearly contrary to the Congressional intent as it is

¹⁶ibid 14

hardly likely that Congress intended to penalize a person for errors by the Patent Office.

The gross injustice to appellees Kamp et al under the decision should be obvious when further considering that the application of appellees Kamp et al was "in effect" filed in the U. S. Patent Office almost one year prior to the Monsanto application, i.e., on April 22, 1955, by virtue of the mandatory language of the statutory provisions¹⁷ relating to the benefits of the right of priority based on appellees' first filed German application to which appellees Kamp et al are entitled (J.A. 56, 57, 59). Notwithstanding such considerably effective earlier filing date of the application of Kamp et al, the Patent Office in an attempt to correct the inadvertent granting of Monsanto's patent, compelled appellees Kamp et al in an office action of December 28, 1959, to copy Claim 1 of Monsanto's patent for purposes of the interference, stating that

Failure to do so will be considered a disclaimer of the subject matter involved.

Accordingly, it is respectfully submitted that the facts and analysis set forth above clearly bring the instant situation within the realm of those "unusual cases" in which the second patent should be granted.

Under the circumstances, it is respectfully requested that a re-hearing and oral re-argument in banc be granted to appellees Kamp et al since the opinion of the majority of the Court, as applied to the facts of the instant situation, is clearly in conflict with the principles laid down in the decision by this Court in *Monaco v. Watson*.

Respectfully submitted,

Paul M. Craig, Jr.
Pennsylvania Building
Washington, D. C.

Attorney for Kamp and Jahn

Date: August 6, 1965

¹⁷ 35 U.S.C. para. 119 (1958 ed.)

CERTIFICATE OF COUNSEL

Paul M. Craig, Jr., counsel for appellees Kamp et al, hereby states that the Petition for Rehearing filed on even date herewith is submitted in good faith and not for delay.

This Certificate is submitted without prejudice to the questions raised below by defendants-appellees' motion under Rule 12(b), F. R. C. P.

Respectfully submitted,

Paul M. Craig, Jr.
Attorney for Kamp and Jahn

PROOF OF SERVICE

I hereby certify that two copies of the printed Petition for Rehearing were mailed today to the attorney for the Appellants, Monsanto et al, W. L. Benedict, Esq., 815 Connecticut Avenue, N.W., Washington, D. C., and to Mr. C. W. Moore, Solicitor, U. S. Patent Office, Washington 25, D. C., attorney for the other appellee.

By

Paul M. Craig, Jr.
Attorney for Kamp and Jahn

Date: Aug. 6, 1965

APPELLANTS' ANSWER TO APPELLEES'
PETITION FOR REHEARING

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 19,171

United States Court of Appeals
for the District of Columbia Circuit

FILED AUG 12 1965

Nathan J. Paulson
CLERK

MONSANTO COMPANY, *et al.*,

Appellants,

v.

ERNST KAMP, *et al.*,

Appellees.

*Appeal From the United States District Court
for the District of Columbia*

W. L. BENEDICT

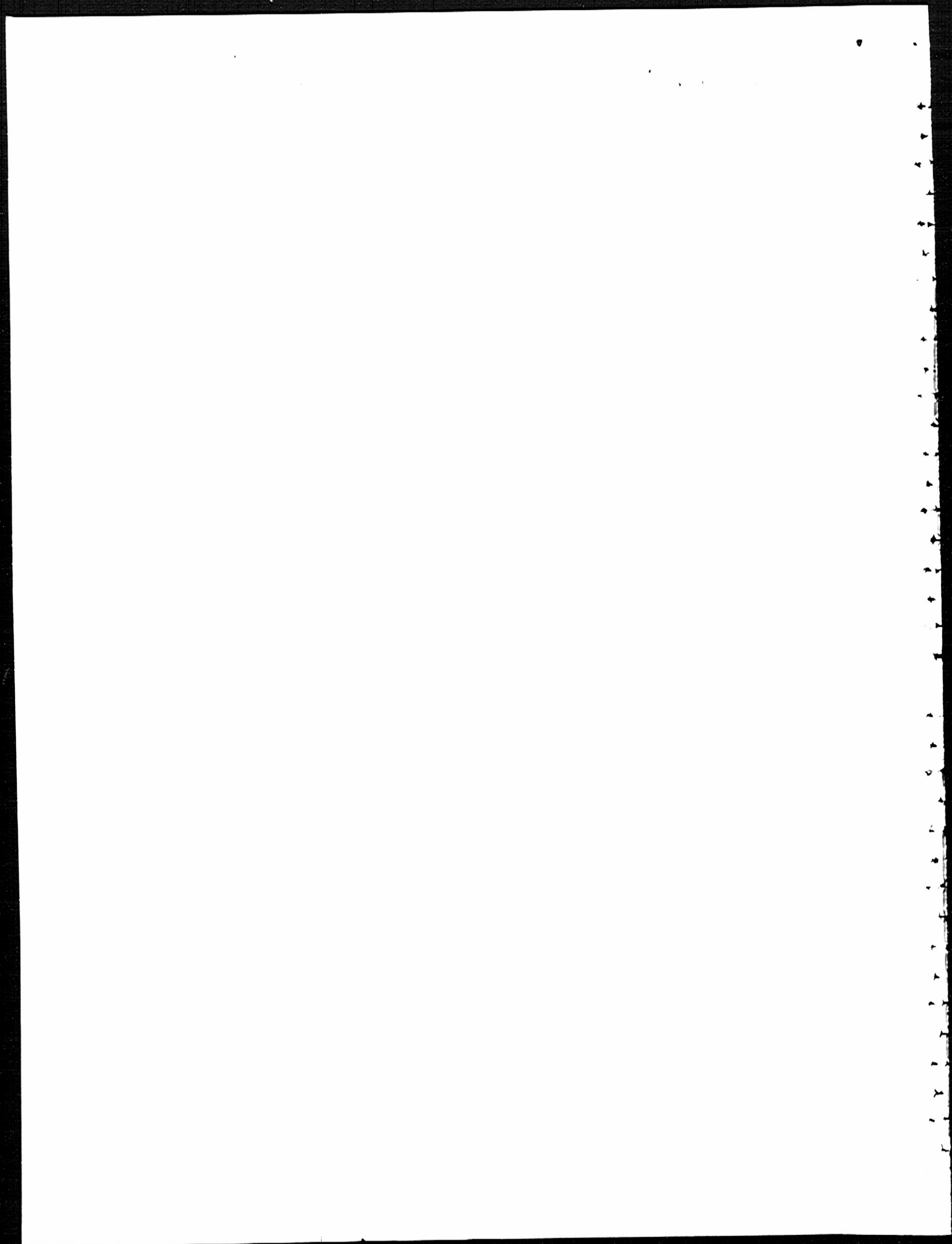
BURNS, DOANE, BENEDICT,
SWECKER & MATHIS

850 Munsey Building
Washington 4, D. C.

Attorneys for Appellants

Of Counsel:

James P. Burns
Herbert B. Roberts
Peter H. Smolka



United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 19,171

MONSANTO COMPANY, *et al.*,

Appellants,

v.

ERNST KAMP, *et al.*,

Appellees.

*Appeal From the United States District Court
for the District of Columbia*

APPELLANTS' ANSWER TO APPELLEES' PETITION FOR REHEARING

This answer is filed in accordance with Rule 26(b) of the general rules of the United States Court of Appeals for the District of Columbia Circuit.

The Petition by Kamp et al. presupposes that the facts upon which the allegations are made are true and that the Board of Patent Interferences will be upheld in a final judgment on the merits.

The Petition also presupposes that it is not in the public interest to withhold the issuance of a second patent pending the final outcome of litigation testing the very right of Kamp et al. to a second patent.

The Fact Issues Are Yet To Be Resolved

The assumed facts have not been tried. Everyone of them as alleged by Kamp et al. is in active dispute before the District Court. Nevertheless Kamp et al. ask this Court to grant —

"... a rehearing including an oral re-argument
... to establish the correct facts of the instant
situation." [Emphasis Added]

—Quoting Page 8 of the Petition

It is elementary that Courts of Appeals will not usurp the fact finding function of the District Courts nor will an appellate court assume or presume that one set of facts are true as opposed to another set of facts, until the evidence is in and the lower court has performed its function. The Kamp et al. petition is founded on a mistaken concept of the function of a Court of Appeals.

The Legal Issue and The Public Interest

While it is true that the public interest may sometimes be served by an early issuance, and hence early expiration, of a patent, that interest must yield to the dominant interest that the patent be valid. The public interest is not and cannot be served by issuance of a second patent pending the outcome of litigation which will be determinative of the basic question as to whether a second patent should ever be granted. The majority opinion herein is sound law on the point, —

"... since the Commissioner of Patents has issued a patent valid on its face he is not free to take action adverse to the validity of that patent while its validity is being litigated in the U.S. courts." [Emphasis added]

The majority opinion carefully analyzed and distinguished between the effect of 35 USC 135 on the present case and on the *Monaco* case. This analysis in no way runs contrary to Congressional intent.

The Congress which enacted 35 USC 135 at the same time enacted 35 USC 146. Section 146 provides for a review by way of civil action in the District Court. The Section ends with the following directive: —

"Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent Office of a certified copy of the judgment and on compliance with the requirements of law."

—Quoting 35 USC 146

If the Congress had intended to permit the Commissioner to issue a second patent at his discretion under the provisions of Section 135 (as the Appellees would have it construed), why was it deemed necessary to expressly provide, in Section 146, for authorization to issue the patent only if three conditions are first satisfied;

- (1) that there be a judgment of the Court in favor of the right of the applicant to a patent;
- (2) that a certified copy of such judgment be filed in the Patent Office, and
- (3) upon compliance otherwise with the requirements of law.

It is respectfully submitted that the Petition for Rehearing should be denied.

W. L. BENEDICT

BURNS, DOANE, BENEDICT,
SWECKER & MATHIS

850 Munsey Building
Washington 4, D. C.

Attorneys for Appellants

Of Counsel:

James P. Burns
Herbert B. Roberts
Peter H. Smolka

PROOF OF SERVICE

I hereby certify that two copies of the printed Appellants' Answer to Appellees' Petition for Rehearing were mailed to the attorney for the Appellees, Kamp et al., Paul M. Craig, Jr., 425 13th Street, N. W., Washington 4, D. C., and to Mr. C. W. Moore, Solicitor, U.S. Patent Office, Washington 25, D. C., attorney for the Commissioner of Patents.

W. L. Benedict
W. L. Benedict

August ¹²13, 1965

609

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

MONSANTO COMPANY ET AL

Appellants,

v.

ERNST KAMP, KARL JAHN, and
EDWARD J. BRENNER,
COMMISSIONER OF PATENTS

Appellees

APPEAL No. 19,171

*To The Honorable Judges of the United States Court of Appeals
for the District of Columbia Circuit:*

REPLY OF APPELLEES KAMP ET AL TO APPELLANTS' ANSWER TO PETITION FOR REHEARING

The following brief remarks are made in reply to appellants' Answer to point out some inaccuracies and dissell any possible erroneous inferences.

On page 2, appellants argue that the

assumed facts have not been tried. Everyone of them as alleged by Kamp et al is in active dispute before the District Court.

The incorrectness of such generalized arguments is believed obvious since the basic underlying facts set forth in the Petition for Rehearing are uncontroverted and undisputed facts of record. Certainly, the U.S. filing date of Monsanto's patent application, the U.S. filing date as well as the filing dates of the first-filed German applications

of Kamp et al, the two year copendency of the two applications as well as the Examiner's action compelling Kamp et al to copy the claims from the Monsanto patent are matters of record which are not in active dispute before the District Court. Additionally, the admission of the Commissioner of Patents as to the inadvertence of granting the Monsanto patent is not in active dispute before the District Court. Furthermore, since a presumption of correctness attaches to decisions of the Board of Patent Interferences, the presumption of invalidity of Monsanto's patent is not in issue.

Appellants' references to 35 U.S.C. 146 and the arguments presented in relation thereto raise precisely the same issues as were raised and decided adversely to appellants in the *Monaco* case. It is significant that Section 146 merely deals with civil actions in case of interferences, generally speaking, but makes absolutely no distinction between interferences involving only applications and interferences involving an application and a patent. The attention of the Court is respectfully directed to the exhaustive briefs filed in the *Monaco* case on this point. If the decision in the *Monaco* case still is the law, then there are no logical or compelling reasons why this decision should not apply in the instant case.

Though its patent is presumably invalid, Monsanto insists in exercising the exclusive rights under the patent pending final outcome of this litigation. Yet it seeks to prevent by injunction that similar rights be accorded to appellees Kamp et al, though presumably the first inventors. Since during the pendency of this litigation, the public is already barred from using the invention claimed in Monsanto's patent, no harm would arise if during the pendency of this litigation a second patent were to issue to appellees Kamp et al. On the other hand, if the decision of the Board of Patent Interferences is sustained, concurrent existence of the two patents during the present litigation would cut short the total time during which the public is barred from the invention as a result of the inadvertent granting of Monsanto's patent.

Finally, notwithstanding the direct financial interests in the outcome of the instant appeal by appellees Kamp et al, it must be remembered that the Motion for the Injunctive Relief in the instant case seeks to enjoin a discretionary act of a U.S. Government Agency to correct an inadvertence, and which discretionary act is, in the opinion of such Government Agency in the interests of the public. In the absence of a showing of irreparable injury either to appellants or to the public as a result of such act, such injunctive relief should not be granted at the request of a private party merely to be able to continue to enjoy alone the exclusive rights to an invention under an inadvertently granted patent and to continue to practice the same without liability to the presumably first inventors, even in case the decision of the Board of Interference Examiners is ultimately sustained.

It is respectfully submitted that the Petition for Rehearing should be granted.

Respectfully submitted,

Paul M. Craig, Jr.
Pennsylvania Building
Washington, D. C.

August 13, 1965

Attorney for Kamp and Jahn

PROOF OF SERVICE

I hereby certify that two copies of the printed Reply of Appellees Kamp et al to Appellants' Answer to Petition for Rehearing were mailed today to the attorney for the Appellants, Monsanto et al, W. L. Benedict, Esq., 815 Connecticut Avenue, N.W., Washington, D.C., and to Mr. C. W. Moore, Solicitor, U.S. Patent Office, Washington 25, D.C., attorney for the other appellee.

By

• Paul M. Craig, Jr.
Attorney for Kamp and Jahn

August 13, 1965

